TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1907.

No. [redacted].9

RUMFORD CHEMICAL WORKS, PETITIONER,

vs.

HYGIENIC CHEMICAL COMPANY.

ON WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE THIRD CIRCUIT.

PETITION FOR CERTIORARI FILED JULY 26, 1907.
CERTIORARI AND RETURN FILED JUNE 19, 1908.

(20,815.)

(20,815.)

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1908.

No. 149.

RUMFORD CHEMICAL WORKS, PETITIONER,

vs.

HYGIENIC CHEMICAL COMPANY.

ON WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE THIRD CIRCUIT.

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a TRANSCRIPT OF RECORD.

United States Circuit Court of Appeals for the Third Circuit, March Term, 1907.

No. —.

RUMFORD CHEMICAL WORKS, Appellant,
vs.
HYGIENIC CHEMICAL COMPANY.

On Appeal from the Circuit Court of the United States for the District of New Jersey.

1 In the Circuit Court of the United States for the District of New Jersey. In Equity.

RUMFORD CHEMICAL WORKS
vs.
HYGIENIC CHEMICAL COMPANY.

Bill of Complaint.

(Filed October 27, 1904.)

To the Honorable the Judges of the Circuit Court of the United States for the District of New Jersey:

The Rumford Chemical Works, a corporation duly created and existing under and by virtue of the laws of the State of Rhode Island, and having its principal office and place of business at the City of Providence in said State, brings this its Bill of Complaint against the Hygienic Chemical Company, a corporation of the State of New Jersey, having a regular and established place of business at Elizabethport, New Jersey, within the District of New Jersey, and thereupon your orator complains and says:

1. That Charles A. Catlin, at that time a resident of the City of Providence, State of Rhode Island, was the original, first and sole inventor of certain new and useful improvements in baking powders which were not known or used by others in this country
2 before his invention thereof, and not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof, and not in public use or on sale in the United States for more than two years prior to his application for Letters-patent therefor, and which had not been abandoned.

2. That thereafter on the 12th day of October, 1891, the said Charles A. Catlin made application in due form of law for letters-patent of the United States for said invention, and then and there fully complied in all respects with the provisions and requirements of the laws of the United States in such case made and provided;

and that by an instrument in writing, dated October 14, 1891, and duly executed and delivered, and recorded in the United States Patent Office on October 16, 1891, said Charles A. Catlin assigned and conveyed to your orator the entire right, title and interest in and to said invention, and in and to the letters-patent of the United States to be issued therefor; that thereupon, due proceedings being had upon said application, letters-patent of the United States, in due form of law, were issued and delivered to your orator, the Rumford Chemical Works, in the name of the United States of America, under the seal of the Patent Office, and signed and countersigned respectively by the proper officers of the United States, number 474,811, and dated May 17, 1892; and that said letters-patent did grant to your orator, the Rumford Chemical Works, its successors or assigns, for the term of seventeen years from the said 17th day of May, 1892, the exclusive right and liberty to make, use and vend the said invention or discovery throughout the United States and the territories thereof, as by reference to said letters-patent or a duly authenticated copy theeof, here in Court to be produced, will more fully appear.

3. Your orator further shows, that by virtue of the premises it became, has been, now is, and was at the time of the acts
3 herein complained of, the sole and exclusive owner of the said letters-patent and the invention or improvements described therein, and all of the rights and privileges granted and secured, or intended to be granted and secured thereby; and that your orator has been and is, save for the doings of said defendant and others acting in concert with it, in the exclusive possession of said rights and privileges, and is entitled to the exclusive use, benefits and advantages of the said invention and improvements, and to sue for the recovery in its own name for the infringement and violation thereof.

4. Your orator further shows that the said invention is of great value and benefit to it, and of great value and use to the public, and that your orator has been to great expense and trouble in preparing for the manufacture of, in manufacturing, in placing upon the market and introducing into use, and making profitable to itself, baking preparations manufactured in accordance with and embodying the invention set forth in the said letters-patent; that the baking preparations so made and introduced and embodying said invention have attained a general and wide-spread popularity and are universally recognized as possessing superior qualities; that a large demand has been created for the same, which demand your orator is ready, able and willing to supply; that your orator has built up and established a large, profitable business in said baking preparations, and has filled, is now filling and is about to fill many hundreds of orders for the same; that the public generally and manufacturers and dealers in all parts of the United States have recognized and acquiesced in the exclusive rights of your orator as aforesaid, and that, but for the infringement and wrongs herein complained of, your orator would now be in peaceful possession and enjoyment of all the rights and privileges granted under said letters-patent and invention, and of the income derivable therefrom.

4 5. And your orator further shows, upon information and belief, that the defendant and others acting in conjunction with it, well knowing the premises, has since the grant of said letters-patent, within the said District of New Jersey and elsewhere in the United States, wrongfully and unlawfully, and wilfully contriving to injure your orator and to deprive it of the just profits resulting from said invention, which profits would otherwise accrue to your orator by reason of said invention and letters-patent, and without the license or consent of your orator, made and used and vended, and has caused to be made and used and vended, baking powder substantially as described in said letters-patent numbered 474,811, and embodying the invention therein set forth, and that the defendant still continues so to do, and threatens to continue the aforesaid unlawful acts to a large extent, all in defiance of the rights acquired by and secured to your orator as aforesaid, and to its great and irreparable loss and injury, by reason of which your orator has been and still is being deprived of large gains and profits which it would otherwise obtain; and your orator further shows that the defendant has derived and received, and still is deriving and receiving, large gains and profits by reason of said unlawful acts, but to what extent your orator is ignorant and cannot set forth and therefore prays a discovery thereof.

6. And your orator further shows, on information and belief, that your orator, and all persons making, under authority of your orator, baking powder embodying or made in accordance with the invention described and claimed in the letters-patent aforesaid, have given notice to the public that the same is patented, and have affixed thereto, or to packages or receptacles containing the same, the word "patented," together with the day and year said patent was granted.

5 7. Your orator further shows that on or about June 13, 1900, it brought its bill of complaint in the Circuit Court of the United States for the Southern District of New York against the New York Baking Powder Company *et al.* charging infringement of the said Catlin patent here in suit, the said cause being docketed as number 7532; that thereafter, the defendants having duly appeared and filed their answer, voluminous testimony was taken on each side at great expense, and the cause came on to final hearing on full proofs before his Honor Judge Lacombe; that thereafter, the Circuit Court holding the patent in suit invalid, an appeal was taken to the United States Circuit Court of Appeals for the Second Circuit; and that, on or about July 7, 1904, an opinion was handed down sustaining the validity of the said Catlin patent here in suit and your orator's title thereto, adjudicating that the said patent had been infringed by the said New York Baking Powder Company, and awarding an injunction and an accounting, that in accordance with said opinion a mandate was handed down and thereupon a final decree was entered and a perpetual injunction issued, which was duly served on said defendants, as by reference to the said opinion or a duly certified copy thereof here in Court to be produced, will more fully appear; and that the said final decree and injunction still remain in full force and effect.

8. That this defendant and others participated in the defense of the above mentioned suit against the New York Baking Powder Company, both financially and otherwise, and was itself engaged at that time and subsequently in manufacturing and selling Granular Acid Phosphate like or substantially like the article put out by the said New York Baking Powder Company and held by the Court of Appeals to be an infringement of the Catlin patent in suit.

9. And your orator further shows that on or about Aug. 2, 1904, it brought a Bill of Complaint in the Circuit Court of the
6 United States for the Southern District of New York, against this defendant and others, including a New York corporation known as the Hygienic Chemical Company, charging infringement of the said Catlin-patent here in suit; that on or about September 3, 1904, Fritz von Briesen, Esq., entered his appearance therein as solicitor for the Hygienic Chemical Company (of New Jersey, the defendant herein) to object to the jurisdiction of the Circuit Court of the United States for the Southern District of New York over the said defendant corporation Hygienic Chemical Company (of New Jersey); that a motion for preliminary injunction against all of the defendants in the said New York suit was argued and a memorandum opinion therein was handed down by his Honor Judge Lacombe granting unto your orator an injunction *pendente lite* against the Hygienic Chemical Company (of New York), but upon the expressed ground of insufficient proof of a sale within the Southern District of New York of the infringing article herein complained of, an injunction against the defendant corporation herein was refused; and that an injunction order in accordance therewith was duly entered and served on the said Hygienic Chemical Company on Sept. 12th, 1904, and is still in full force and effect; and that an order was entered in the said New York suit on October 26, 1904, dismissing the said bill in the Southern District of New York against the Hygienic Chemical Company (of New Jersey), but without prejudice to the rights of your orator therein and herein,—as by reference to the said order here in Court to be produced, or a duly certified copy thereof, will more fully and at large appear.

And forasmuch as your orator can have no relief save in this Honorable Court, your orator prays as follows:

1. That the defendant and its associates, attorneys, servants, clerks, agents and workmen, may be perpetually enjoined and re-
7 strained by writ of injunction issuing out of and under the seal of this Honorable Court, from directly or indirectly making or causing to be made, using or causing to be used, selling or causing to be sold, baking preparation manufactured in accordance with or embodying the invention or improvements set forth in said letters-patent, or in any wise counterfeiting, imitating or simulating the said invention.

2. That your Honors will grant unto your orator a preliminary injunction issuing out of and under the seal of this Honorable Court, enjoining the said defendant and its associates, attorneys, servants, clerks, agents, and workmen, to the same purport, tenor and effect as hereinbefore prayed for with regard to said perpetual injunction.

3. That said defendant may be required by a decree of this Honorable Court to account for and pay over to your orator such gains and profits as have accrued or arisen or been earned or received by said defendant and all of such gains and profits as would have accrued to your orator but for the unlawful doings of said defendants and the damages your orator has sustained thereby, and that on account of the willful nature of said infringement the damages be increased threefold.

4. That the defendant may be compelled, by the order of this Honorable Court, to deliver up to its judicial custody for destruction, in a manner to be provided for in said order, all infringing articles in the possession of, or under the control of, said defendant.

5. That the defendant be decreed to pay the costs of this suit.

6. That your orator may have such other and further relief as the Equity of the case may require.

8 To the end that the said defendant may, if it can, show why your orator should not have the relief hereby prayed, and may full and direct answer make,—but not under oath, answer under oath being expressly waived—according to the best and utmost of its knowledge, information, remembrance and belief, to the several matters hereinbefore averred and set forth, as fully and particularly as if the same were repeated paragraph by paragraph, and said defendant thereto severally and specifically interrogated, may it please your Honors to grant unto your orator a writ of *subpœna ad respondendum* issuing out of and under the seal of this Honorable Court, directed to the said defendant, the Hygienic Chemical Company, commanding it to appear and make answer to this bill of complaint and to perform and abide by such order and decree as to this Court may seem just.

And your orator will ever pray.

RUMFORD CHEMICAL WORKS,
By NEWTON D. ARNOLD, *Treas.*
C. A. L. MASSIE,
Solicitor and of Counsel for Complainant,
277 *Broadway, New York City.*

PHILIP MAURO,
Of Counsel for Complainant.

9 STATE OF NEW YORK,
County of New York, ss:

Newton D. Arnold being duly sworn, deposes and says: That he is the Treasurer of the Rumford Chemical Works, named as complainant in the foregoing bill, that he has read the same and knows the contents thereof, and that the same is true of his own knowledge, save of the matters therein stated to be alleged upon information and belief, and that as to those matters he believes it to be true.

(Signed) NEWTON D. ARNOLD.

Subscribed and sworn to before me this 26th day of October, 1904.

(Signed) ELISHA K. CAMP,
[SEAL.] *Notary Public, New York County.*

10 At a Stated Term of the Circuit Court of the United States for the Southern District of New York, held in the Court Rooms thereof, in the Post-Office Building in the City of New York, in the State of New York, on the 26th day of October, 1904.

Present: Hon. E. Henry Lacombe, U. S. C. Judge.

In Equity. No. 8812.

RUMFORD CHEMICAL WORKS
vs.
HYGIENIC CHEMICAL COMPANY (of New York), HYGIENIC CHEMICAL COMPANY (of New Jersey), JAMES E. HELLER, and ADOLPH HIRSH.

Order to Dismiss Bill of Complaint as Against One of the Defendants.

(Filed Oct. 26, 1904.)

Upon the Bill of Complaint and the Plea to the jurisdiction filed herein on behalf of the Hygienic Chemical Company (of New Jersey), the solicitor for the said defendant consenting thereto, and upon motion of Elisha K. Camp, Esq., solicitor for complainant herein, it is

Ordered that the Bill of Complaint herein be and the same hereby is dismissed, with costs, as against the Hygienic Chemical Company (of New Jersey), without prejudice.

(Signed) E. H. LACOMBE,
U. S. C. J.

I hereby consent to the form of the foregoing order.

(Signed) FRITZ v. BRIESEN,
Solicitor for Defendant.

11 Circuit Court of the United States for the District of New Jersey. In Equity.

RUMFORD CHEMICAL WORKS, Complainant,
vs.
HYGIENIC CHEMICAL CO. (of New Jersey), Defendant.

Answer.

(Filed January 2, 1905.)

The answer of the Hygienic Chemical Company (of New Jersey), defendant to the bill of complaint of the Rumford Chemical Works, complainant.

The defendant answering the said complainant's said bill of complaint, says on information and belief that it admits the issue of

certain Letters Patent, numbered 474,811, on the 17th day of May, 1892; but denies that the grant and issue of said Letters Patent secured any exclusive rights whatsoever; and denies that Charles A. Catlin was the true, original and first inventor or discoverer of the alleged invention or discovery patented in and by said Letters Patent.

And this defendant denies that the alleged improvement described in said Letters Patent was not abandoned by the said Charles A. Catlin, but alleges that the said Charles A. Catlin abandoned the said alleged invention by disclosing and delivering the same to the officers and employees of the Rumford Chemical Works without
12 reservation or restriction, and without making application therefor in the United States Patent Office fully seven years before the said application was filed; whereby and by reason of which abandonment and neglect the public was deprived of the free use of the said invention at the present time and this defendant alleges that this neglect, delay and abandonment, followed by an application for patent seven years later, makes the patent a fraud on the public and a means of exacting royalties from the public at the present time when the patent would have been public property had the inventor been reasonably diligent and had he not abandoned the said invention.

And this defendant answering the fourth paragraph of the bill of complaint denies that the alleged invention is of great value and use to the public, but on the contrary by reason of the aforesaid fraudulent acts of the complainant and of Charles A. Catlin, this defendant alleges that the alleged invention has been and is being used as a means of oppression and extortion from the public.

And this defendant, further answering, admits that the complainant is the owner of said Letters Patent, No. 474,811.

And this defendant, further answering, upon information and belief, says that said Letters Patent, No. 474,811, are void by reason of the following special matters:

First. That for the purpose of deceiving the public, the description and specification filed by the said Charles A. Catlin, in the Patent Office was made to contain less than the whole truth relative to his alleged invention or discovery, or more than is necessary to produce the desired effect, and that such latter fact has been affirmatively found to be true by the United States Circuit Court for this Circuit and by the United States Circuit Court of Appeals of the Second Circuit.

13 Second. That said Letters Patent were surreptitiously and unjustly obtained for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; to wit by Walter E. Wadman, and that the same was suggested to the said Charles A. Catlin by the said Walter E. Wadman.

Third. That said Charles A. Catlin was not the original and first inventor or discoverer of any material and substantial part of the thing patented, and that the following are the names and residences of the persons who have had knowledge and made use of the thing patented, and of every material and substantial part thereof, prior

to the alleged invention thereof by said Charles A. Catlin, and the names of the places where such use was had and known.

Eben N. Horsford, of and at Cambridge, Massachusetts, and at other places;

The officers and employees of the Rumford Chemical Works, of and at Providence, R. I., and at other places;

Edwin B. Bangh, of and at Philadelphia, Pa., and at other places;

George F. Wilson, of and at East Providence, R. I., and at other places;

John E. Lauer, of and at New York, N. Y., and at other places;

William P. Clotworthy, of and at Baltimore, Md., and at other places;

Charles E. Catlin, of and at Providence, R. I., and at other places;

Carl V. Petreens, of and at Camden, New Jersey, and at other places;

Adolph Ciesecke, of and at Buffalo, New York, and at other places;

James W. Carson, of and at Philadelphia, Pa., and at other places;

Francis P. Harned, of and at Camden, N. J., and at other places;

14 John M. Hughes, of and at Brooklyn, N. Y., and at other places;

Edward N. Dickerson, Jr., of and at New York, N. Y., and at other places;

Charles Glaser and Charles F. W. Dambmann, both of and at Baltimore, Maryland, and at other places;

Nathaniel B. Powter, of and at New York, N. Y., and at other places;

John Orrett of and at Kingston, Jamaica, and at other places;

Herbert E. Dennett, of and at Boston, Massachusetts, and at other places;

The officers and employees of the New York Baking Powder Co., of and at New York, N. Y., and at other places;

The officers and employees of the Provident Chemical Co., of and at St. Louis, Mo., and at other places;

The officers and employees of the Emerson Drug Co., of and at Baltimore, Md., and at other places;

The officers and employees of the Royal Baking Powder Co., of and at New York, N. Y., and Brooklyn, N. Y., and at other places;

John G. Finke, of and at New York, N. Y., and at other places;

Louis Hennomeier, Jr., of and at Jersey City, New Jersey, and at other places;

S. Elwood May of and at New York, N. Y., and at other places;

Leopold Schepp, of and at New York, N. Y., and at other places;

Casper B. Shafer, of and at Washington, D. C., and at other places;

William S. Sampson, of and at New York, N. Y., and at other places;

John C. Schuman, of and at Akron, Ohio, and at other places;

William T. Jebb, of and at Buffalo, New York, and at other places;

Joseph F. Gent, of and at Columbus, Indiana, and at other places;

Charles N. W. Foster, of and at Brookline, Mass., and at other places;

Russell S. Pennimann, of and at Jenkintown, Pa., and at other places;

John C. Schrader, of and at McCainsville, N. J., and at other places;

Newton M. Bell, of and at San Francisco, Cal., and at other places;

William R. Quinan, of and at San Francisco, Cal., and at other places;

John G. Kopping, John Weideman, and Archibald B. Henry, all of and at Clinton, Iowa, and at other places;

James B. Herreshoff, now residing at Coronado Beach, San Diego County, California, at Pleasant Valley, North Providence, Rhode Island, and at East Providence, Rhode Island, and other places;

James E. Heller, of New York, N. Y., at Elizabethport, New Jersey, and New York, N. Y., and at other places;

The employees and members of the firm of Heller, Hirsch & Co., of and at New York, N. Y., and at other places;

Vincent C. Rice, of Waukegon, Illinois, at Chicago, Illinois, and at other places;

The officers and employees of the Price Baking Powder Company, of and at Chicago, Illinois, and at other places;

Morris N. Hirsch, of and at Chicago, Illinois, and at other places;

The members of the firm and employees of Stein Hirsch & Co. of and at Chicago, Illinois, and at other places;

The employees and members of the firm of Martin Kalbfleish & Sons, of and at Brooklyn, N. Y., and at other places;

Charles A. Derre, of and at Passaic, N. J., and at other places;

John E. Laner, of and at Jersey City, N. J., and at other places;

The officers and employees of Keasby & Mattison Co., of and at Philadelphia, Pa., and Amber, Pa., and at other places;

Edwin H. Hammer, of and at Passaic, New Jersey, and at other places;

The members of the firm and employees of Lehr and Fink, of and at New York, N. Y., and at other places;

W. J. Gesell, of and at New York, N. Y., and at other places;

The members of the firm and employees of Power & Weightman, of and at Philadelphia, Pa., and at other places;

William J. Baird, of and at New York, N. Y., and at other places;

Albert Plant, of and at New York, N. Y., and at other places;

Walter E. Wadman, of and at Bayonne, N. J., and at other places;

Henry Heuer and Frank Wilson, of and at Elizabethport, N. J., and at other places;

Charles F. Herreshoff, of and at Bristol, R. I., and at other places;

John Wilson, of and at Elizabethport, N. J., and at other places;

Thomas Boyle, of and at Elizabethport, N. J., and at other places;

William Smith, of and at Elizabethport, N. J., and at other places;

Mary Boyle, of and at Elizabethport, N. J., and at other places;

James E. Barney, of Dorchester, Mass., at Pleasant Valley, North Providence and East Providence, R. I., and at other places;

David F. Whitaker, of and at Seekonk, R. I., and at other places;
Patrick Brady, now of Providence, R. I., of and at Pleasant Valley, R. I., and East Providence, R. I., and at other places;
Henry McElroy, now of Pawtucket, R. I., of and at East Providence, R. I., and at other places;
17 Hannah Morton, of and at East Providence, Rhode Island, and at other places;

and many others, whose names this defendant has not yet ascertained, but which it craves leave to insert in this answer as soon as ascertained.

Fourth. That the thing patented in said Letters Patent has been patented and described prior to said Charles A. Catlin's supposed invention or discovery thereof, in and by the following Letters Patent granted to the following-named persons, to wit:

Reissue No. 2979 issued June 9, 1868, for improvement in Pulverulent Acid for use in the Preparation of Soda Powders, Farinaceous Food and for other purposes, to The Rumford Chemical Works;

Reissue No. 2597 issued May 7, 1867, for Improvement in the Manufacture of Phosphoric Acid and Phosphates for use in the preparation of Food and for other purposes, to The Rumford Chemical Works;

No. 14,722 issued April 22, 1856, to E. N. Horsford;
No. 41,815 issued March 1, 1864, to E. N. Horsford;
No. 42,140 issued March 29, 1864, to E. N. Horsford;
No. 45,631 issued December 27, 1864, to Potts & Klett;
No. 45,961 issued January 17, 1865, to Liebig & Cooper;
No. 47,610 issued May 9, 1865, for Improved Mode of Manufacturing Superphosphate of Lime, to Edwin P. Bangh;
No. 75,271 issued March 10, 1868, to E. N. Horsford;
No. 75,272 issued March 10, 1868, to E. N. Horsford;
No. 75,326 issued March 10, 1868, to George F. Wilson, for improvement in the preparation of Bones for the Manufacture of Phosphoric Acid and Phosphates;
No. 75,327 issued March 10, 1868, to George F. Wilson;
No. 75,328 issued March 10, 1868, to George F. Wilson,
18 for Improvement in the Manufacture of Acid Phosphates;
No. 75,329 issued March 10, 1868, to George F. Wilson;
No. 75,330 issued March 10, 1868, to George F. Wilson, for Improvement in Drying Acid Phosphates;
No. 75,331 issued March 10, 1868, to George F. Wilson, for Improved Process and Apparatus for the Manufacture of Acid Phosphates;
No. 75,332 issued March 10, 1868, to George F. Wilson;
No. 75,333 issued to George F. Wilson, March 10, 1868, for Improvement in Grinding and Pulverizing Acid Phosphates;
No. 75,334 issued to George F. Wilson, March 10, 1868, for Improvement in Granulating Acid Phosphates;
No. 75,335 issued March 10, 1868, to George F. Wilson;
No. 75,336 issued to George F. Wilson, March 10, 1868, for

Improvement in the Manufacture of Phosphates and Extracting Phosphoric Acid from Bones;

No. 75,337 issued to George F. Wilson and Eben N. Horsford, March 10, 1868, for Improvement in Treating the Mixture of Acid Phosphate of Lime and Farinaceous matters in order to granulate them;

No. 75,338 issued to George F. Wilson and Eben N. Horsford, March 10, 1868, for Improved Process of Treating Acid Phosphates in the Manufacture of Yeast, Powder, etc.

No. 75,339 issued March 10, 1868, to George F. Wilson;

No. 86,275 issued January 26, 1869, to Henry Bower;

No. 86,594 issued February 2, 1869, to O. A. Moses;

No. 104,034 issued June 7, 1870, to E. N. Horsford;

No. 105,319 issued July 12, 1870, to Alfred Du Vall;

No. 106,147 issued August 9, 1870, to Frank & Adt;

No. 114,304 issued May 2nd, 1871, to F. J. Kimball;

19 No. 114,693 issued May 9, 1871, to George T. Lewis;

No. 128,752 issued July 9, 1872, to Pratt & Lewis;

No. 130,298 issued to Eben N. Horsford, August 6, 1892, for Improvement in the Manufacture of Phosphate of Lime and Yeast Powders;

No. 137,635 issued April 8, 1873, to Storck & Lyte;

No. 140,051 issued to John E. Lauer, June 17, 1873, for Improvement in Manufacturing Crystaline Acid Phosphate of Lime for Yeast Powders;

No. 143,580 issued to John G. Kopping and John Weidemann, Oct. 14, 1873, for Baking Powder for Bread;

No. 195,142 issued Sept. 11, 1877, to James Mactean;

No. 206,930 issued to William H. Clotworthy, Aug. 13, 1878, for Improvement in Baking Powders;

No. 223,847 issued January 27, 1880, to J. F. Gent;

No. 229,518 issued to Charles A. Catlin, July 6, 1880, for Acid Phosphate for Baking Powders;

No. 238,570 issued to Charles A. Catlin, March 8, 1881, for Baking Powder;

No. 239,802 issued to Charles A. Catlin, April 5, 1881, for Baking Powder;

No. 256,832 issued to Adolph Giesecke, April 25, 1882, for manufacture of Baking Powder;

No. 294,592 issued to Franz Dietrich, March 4, 1884, for manufacture of Cream of Tartar;

No. 338,934 issued to James W. Carson and Francis P. Harned, March 30, 1886, for Manufacture of Blocks of Bicarbonate of Soda;

No. 352,465 issued to John N. Hughes, Nov. 9, 1886, for Compound Table Salt or Condiment;

No. 374,201 issued to Carl N. Petraens, Dec. 6, 1887, for Process of Making Acid Potassium Phosphates;

No. 389,566 issued Sept. 18, 1888, to Charles Glaser for Process of Making Acid Phosphate;

No. 407,241 issued July 16, 1880, to Nathaniel B. Powter, for Phosphatic Fertilizer;

No. 417,710 issued Dec. 24, 1889, to Herbert E. Dennett, for Food Compound;

20 No. 215,341 issued to John G. Finke, May 13, 1879, for Granulated Chocolate;

No. 391,630 issued to Louis Hennemeier, Jr., October 23, 1888, for Coconut Compound;

No. 398,982 issued to Leopold Schepp, Feb. 19, 1889, for Coconut Compound;

No. 398,983 issued to Leopold Schepp, Feb. 19, 1889, for Coconut Compound;

No. 287,781 issued to Casper B. Shafer, Oct. 30, 1883, for Medicated Effervescent Salts;

No. 155,043 issued to William S. Sampson, Sept. 15, 1874, for Methods of Preserving Lime;

No. 320,401 issued to John C. Schuman, June 16, 1885, for Method of Preparing and Treating Starch;

No. 304,722 issued to Joseph F. Gent, Sept. 9, 1884, for Art of Making a Product from Indian Corn known as Cerealine;

No. 350,532 issued to Charles H. W. Foster, Octo. 12, 1886, for Apparatus for Sifting Sugar;

No. 316,277 issued to James MacTear, April 21, 1885, for Apparatus for Making Granulated Crystaline Carbonate of Soda;

No. 312,010 issued to Rusell S. Penniman, Feb. 10, 1885, for Protected Nitrate of Ammonia for use in Explosive Compounds;

No. 476,592 issued to Jesse Ascough, June 7, 1892, for Process of Making Borax;

No. 364,587 issued to Thomas Higgin, June 7, 1887, for Process of Separating Sand Scale, Hard Pan scale and other Impurities from Salt;

No. 333,348 issued to John C. Schrader, Dec. 29, 1885, for Dynamite and Process of Making the Same;

No. 333,346 issued to John C. Schrader, Dec. 29, 1885, for Dynamite;

No. 449,064 issued to Newton M. Bell, Mch. 24, 1891, for Art of Manufacturing Borax;

No. 244,575 issued to Camille A. Faure, July 19, 1881, for Explosive Blasting Material;

No. 458,663 issued to Francis Ellershansen, Sept. 1, 1891, for Process of Making Caustic Alkali;

21 No. 260,786 issued to William E. Quinan, July 11, 1882, for Explosive Powder;

No. 300,281 issued to William R. Quinan, June 10, 1884, for Explosive Compound.

British Patents.

No. 9977 of 1843;
No. 466 of 1852;
No. 910 of 1852;
No. 189 of 1855;
No. 2161 of 1855;
No. 568 of 1860;

No. 2,082 of 1862;
No. 713 of 1864;
No. 320 of 1865;
No. 1,267 of 1868;
No. 924 of 1869;
No. 3,645 of 1869;
No. 514 of 1871;
No. 3,022 of 1871;
No. 3,160 of 1872;
No. 1,455 of 1875;
No. 1,249 of 1879;
No. 2,875 of 1880;
No. 5,115 of 1880;
No. 2,725 of 1882;
No. 6,208 of 1882;
No. 8,658 of 1884;
No. 984 of 1890;

French Patents.

No. 58,807 of 1863, Dufourmental & Poire;
No. 59,527 of 1863, LePerdriel;

and in many others which this defendant has not yet ascertained, but which it craves leave to insert in this answer as soon as ascertained.

22 Fourth. That the thing patented in said Letters Patent had been described prior to said Charles A. Catlin's supposed invention or discovery thereof, in the following-named printed publications, all of which were publicly circulated in the United States prior to the said Charles A. Catlin's supposed invention, or discovery, to-wit;

In "Remington's Practice of Pharmacy" published at Philadelphia in the year 1885, by J. B. Lippincott Company, at Chapter XVI. page — thereof.

In "Mineral Phosphates and Pure Fertilizers," by Campbell Morfit, published at London, England in 1873 by —— at page 316, thereof, article entitled "Manufacture of Superphosphate of Lime"

In Donovan's "Domestic Economy" published at London, England in the year 1842, Volume I thereof, at page 102.

In Dingler's Polytechnic Journal. Published at Augsburg, Germany, in the year 1863, Volume 170, page 314.

In "Quantitive Analysis" by C. Freservius, published at —— in the year 1865, at page 37.

In "Quantitive Analysis" by Classen, Fourth Edition, published at —— in the year 1891, at page 4.

In Kamarsch & Heeren, Technical Dictionary, published at —— in the year 1880, Volume 4, page 465.

In National Dispensary, published at —— in the year 1887, at page 1257.

In Muspratt's Chemical Encyclopedia, published at —— in the year 1878, Third Edition, at page- 1566, and 1627.

In Wurtz Dictionaire de Chimie, published at —— in the year 1876, Volume 2, page 1167.

In Miller's Elements of Chemistry, published at —— in the year 1868, part 2, page- 815-816.

23 In Mendelies' Principles of Chemistry, published at —— —— in the year 1870, Volume 1, pages 38 and 39;

and in many others which this defendant has not yet ascertained but which it craves leave to insert in this answer as soon as ascertained.

Fifth. That the thing patented in said Letters Patent had been in public use and on sale in this country for more than two years before the said Charles A. Catlin's application for a patent, and that the persons hereinabove named as having had prior knowledge and use of the said alleged invention, and many others, knew of such prior public use and sale as did also said Charles A. Catlin.

And this defendant, further answering, upon information and belief, says that said Letters Patent do not disclose or show any invention whatsoever in view of the state of the art in the manufacture of Baking Powder, Soda, Cream of Tartar, Phosphoric Acid, Acid Phosphates, etc., and many other articles which existed at and long before the time when it is alleged in the complainant's said bill of complaint that said Charles A. Catlin made his alleged invention; and that in view of the state of the art the said Charles A. Catlin has not in his said Letters Patent disclosed any new or patentable invention whatsoever, but that the alleged invention involves, if anything, simply mechanical skill and judgment.

And this defendant denies that the complainant has gone to great or any expense and trouble in preparing for the manufacture of, in manufacturing, in placing it on the market and introducing into use baking preparations manufactured in accordance with and embodying the alleged invention set forth in said letters patent; that the baking preparations so made and introduced and embodying said alleged invention have attained a general and widespread popularity, and are universally recognized as possessing superior quali-

24 ties; that the public generally and manufacturers and dealers in all parts of the United States have recognized and acquiesced in the alleged exclusive rights of the complainant, and that but for the alleged infringement and wrongs specified in the bill of complaint, the complainant would now be in the peaceful possession and enjoyment of all the alleged rights and privileges granted under said letters patent and of the income derivable therefrom; and on the contrary this defendant alleges that the public generally, manufacturers and dealers throughout the United States are in arms against the unjust and inequitably secured monopoly represented by said letters patent, and are severally doing their utmost to establish the fraudulent character of such monopoly to the extent of contesting the said patent in all judicial districts in the United States wherever suit is brought against any of them.

And this defendant answering the fifth paragraph of the bill of complaint denies that it and others acting in conjunction with it, within the District of New Jersey, or anywhere, unlawfully and

wrongfully, made and used and vended, or caused to be made and used and vended, Baking Powder substantially as described in said letters patent; and denies further that it continues to do so or threatens to continue such alleged unlawful acts to a large or any extent.

And this defendant answering the seventh paragraph of the bill of complaint denies that in the suit of Rumford Chemical Works against New York Baking Powder Co. *et al.*, any final decree was ever entered except the final decree dismissing the bill of complaint therein.

And this defendant, answering the eighth paragraph of the bill of complaint denies that it participated in the defense of the suit of Rumford Chemical Works against New York Baking Powder Company, either financially or otherwise, and that it was at the time engaged in manufacturing and selling granular acid phosphate like or similar to the article put out by the said New York Baking Powder Company.

And this defendant alleges as a separate and distinct de-
25 fense that there is now pending undetermined in the United States Circuit Court for the District of New York a suit entitled Rumford Chemical Works against Hygienic Chemical Company of New Jersey and others, involving the same patent, the same issues, the same parties, and that the pendency of such a suit is a bar to the present suit except as to a Baking Powder made by this defendant prior to the institution of the old suit aforesaid.

And this defendant, further answering upon information and belief, alleges, and will prove, that the invention alleged to have been made by the said Charles A. Catlin, or disclosed in said letters patent, was old at the time of the alleged making thereof by said Charles A. Catlin, and was at that time a common and well known means of attaining the object sought to be attained by said Charles A. Catlin, and that the same was constantly being used in the manufacture of such articles as Baking Powder, Soda, Cream of Tartar, Phosphoric Acid, Acid Phosphates, and other articles, and that therefore said Letters Patent are void.

And this defendant denies all and all manner of unlawful acts wherewith it is by the said bill charged. All which matters and things this defendant is ready and willing to prove as this Honorable Court shall direct, and it humbly prays to be hence dismissed, with its reasonable costs and charges in this behalf most wrongfully sustained.

HYGIENIC CHEMICAL COMPANY
(OF N. J.), *Defendant*,
By BRIESEN & KNAUTH, *Its Solicitors*.

BRIESEN & KNAUTH,
Solicitors for Defendant.
ARTHUR v. BRIESEN,
Of Counsel.

26–112 Circuit Court of the United States for the District of New Jersey. In Equity.

RUMFORD CHEMICAL WORKS
vs.
HYGIENIC CHEMICAL CO. (of New Jersey).

Replication.

(Filed January 6, 1905.)

This repliant, saving and reserving to itself all and all manner of advantage of exception, which may be had and taken to the manifold errors, uncertainties, and insufficiencies of the Answer of the said defendant, for replication thereunto saith, that it doth and will aver, maintain, and prove its said bill to be true, certain and sufficient in the law to be answered unto by the said defendant, and that the Answer of the said defendant is very uncertain, evasive, and insufficient in law to be replied unto by this repliant; without this, that any other matter or thing in the said Answer contained, material or effectual in the law to be replied unto and not herein and hereby well and sufficiently replied unto, confessed or avoided, traversed or denied, is true: all which matters and things this repliant is ready to aver, maintain, and prove as this Honorable Court shall direct, and humbly prays as in and by its said bill it hath already prayed.

(Sgd.) C. A. L. MASSIE,
Solicitor and of Counsel for Complainant,
277 *Broadway, New York City.*

Dated February 6, 1905.

[NOTE.—The notices, stipulations, testimony, exhibits, etc., contained in pages 27 to 112, inclusive, of this record are identical with the notices, stipulations, testimony, exhibits, etc., printed on pages 12 to 99, inclusive, in the Transcript of Record of the cause brought from the U. S. Circuit Court of Appeals for the Second Circuit (No. 339),—the only difference being that in this record the papers are entitled in the Circuit Court for the District of New Jersey, while in the Transcript of the Second Circuit cause they are entitled in the Circuit Court for the Southern District of New York and were taken before another Examiner; and are omitted here in printing per stipulation of counsel. See side page 150.]

113 Circuit Court of the United States for the District of New Jersey. In Equity.

RUMFORD CHEMICAL WORKS
vs.
HYGIENIC CHEMICAL COMPANY.

Opinion.

(Filed December 7, 1906.)

C. A. L. Massie, and Philip Mauro, of Counsel with Complainant.
Whitridge, Butler & Rice, Solicitors and of Counsel, and Willard Parker Butler, and John French, of Counsel for Defendant.

CROSS, *District Judge:*

The bill of complaint seeks to hold the defendant liable for contributory infringement of Letters Patent No. 474,811, for a Baking-powder, dated May 17, 1892, issued to one Charles A. Catlin, and duly assigned to the complainant. The validity of the patent has been established by the Circuit Court of Appeals for the Second Circuit, Rumford Chemical Works *vs.* New York Baking Powder Company *et al.*, 134 Fed. 385. It appears in the case that there are two corporations bearing the name Hygienic Chemical Company; that one is a New York corporation and the other, the defendant, a corporation of this state; that the New Jersey corporation is a manufacturing corporation chiefly, and the New York corporation its selling agent, although it also sells the product of other manufacturers. A suit was begun in the year 1904, in the Circuit Court of the United States for the Southern District of New York, against both of said corporations, and others charging infringement of the above mentioned patent, and a preliminary injunction was issued against all of the defendants, except the Hygienic Chemical Company of New Jersey, as to which defendant, the bill was dismissed without prejudice, for the reason that no evidence of a sale of the infringing article made by that corporation within the Southern District of New York, appeared in the case. In the case at bar the defendant has introduced no testimony, and claims that the evidence offered by the complainant is insufficient to support the material allegations of the bill. The complainant insists in the first place that this defendant is bound by the decree entered in Rumford Chemical Works *vs.* New York Baking Powder Company,
114 *et al., supra*, for the reason that the defendant herein contributed financially to, and otherwise aided in the defence of that suit, and that consequently it was a privy thereto and is bound thereby. It is true that Mr. Heller, who is the president of and interested as a stockholder in both of the Hygienic Chemical Companies, gave testimony in that suit, but how, for what purpose, in what character or under what circumstances, does not appear. There is no evidence whatever that he sought to control, had the

power to control or did in anywise control that litigation; the mere fact that he was president of the Hygienic Chemical Company of New Jersey, and a witness in the suit, certainly shows no control over the suit, or any such interest as would make the corporation of which he was president, a privy thereto. As to proof of any financial contribution by the defendant herein, to the expenses of the New York litigation in which complainant's patent was sustained, I find none that is convincing. The weight of the testimony is that such contribution as was made, was made, not by the defendant, but by the Hygienic Chemical Company of New York. Certainly the defendant herein cannot be concluded as a privy to that suit, without satisfactory evidence appears of such facts as the law deems necessary to establish privity. For the purpose obviously of showing that the contribution to the defence of the primary suit alleged to have been made by the New York Corporation was to all intents and purposes made by the defendant herein, evidence was adduced intended to show that the defendant and the Hygienic Chemical Company of New York, were one and the same corporation, and were practically controlled by the witness Heller, already referred to, and a Mr. Hirsh. It appears that these two men were largely instrumental in the organization of both corporations, and at that time controlled substantially all of the stock thereof, and this situation might have been presumed to continue, had not Heller, while under examination as a witness for the complainant, testified that it was not a fact that he and Hirsh at the time of the examination, owned practically all of the stock of the two corporations. Later in reply to a question asking what proportion of the capital shares of the Hygienic Chemical Company of New Jersey the witness and Mr. Hirsh owned, the witness replied that he could not answer without examination, whereupon complainant's counsel requested the information for a later session, and the defendant's counsel expressed a willingness to produce the facts at a subsequent hearing, the matter, however, seems to have been dropped,
115 as nothing further in that connection appears in the case.

As already stated, the testimony shows that the New York corporation is the selling agent for the New Jersey corporation, but it also shows that the latter corporation does not own or control a single share of the stock of the former. The fact that the witness Heller is president of both corporations, has already been adverted to. These are all the facts tending to show that the corporations are identical. At the time of their organization they seem to have been controlled by two men, but that situation was subsequently changed as appears from the testimony of Heller above given, but to what extent or when, is not made clear, through the failure of the complainants to prosecute the examination of the witness to a definite result. I think the testimony insufficient to show the oneness of the two corporations. There is no evidence of any agreement between the defendant herein and the defendants in the New York litigation (which establish*ment* complainant's patent), as to a joint defence of the suit; nor does it appear that this defendant, or indeed the New York corporation, had the right to control the proceedings,

assume any active part therein, cross-examine the witnesses, or appeal from the judgment. I have found no case which goes to the length of saying that one who merely contributes to the defence of a suit, is bound as a privy by the result thereof. Such a contribution might well be made from charitable or other good and sufficient reasons. The rule invoked is only applicable to cases where by agreement a joint defence is made or a principal defends his agent, or a licensor his licensee, or other like relations contractual or representative exist. As said by Hawley, J., in Theller *v.* Hershey, 89 Fed. 575, "the law is well settled that parties and privies include all who are directly interested in the subject matter, and who had the right to make defence, control the proceedings, examine and cross-examine witnesses, and appeal from the judgment." To the same effect is the case of Miller *et al. v.* The Liggett and Myers Tobacco Company, 7 Fed. 91. In Penfield *v.* C. & A. Potts & Co., 126 Fed. 475, it appears that earlier suits which were set up as a bar, had been defended by an agreement between the parties, to which they had contributed equally, under a stipulation that the same counsel should be employed in all the suits and a common agent appointed to assist the counsel, and that the evidence, so far as relevant, should be used in all the cases, manifestly a totally different situation from the one now presented. The case of David Bradley Manufacturing Company *v.* Eagle Manufacturing Company, 57 Fed. 980, was specially relied upon by counsel of
116 complainant, upon the argument, but the facts disclosed in that case are also totally unlike anything disclosed by the evidence in this case. The suit was brought for an infringement of a patent against a firm that was a branch of the Company that manufactured the infringing devices, which manufacturing company conducted the defence to the suit and raised the question of the validity of the patent. It was held under those circumstances that the decree for the complainant, establishing the validity of the patent concluded the company conducting the defence. An admission appears in the case substantially showing that the company held to be estopped by the decree therein, employed counsel, took charge of, and conducted the defence in the name of the defendant, paid the expenses thereof, and that this was done by the Company the same as it would have been done for any agent, branch house or customer engaged in selling its manufactures. In the case of Morse *v.* Knapp *et al.*, 37 Fed. 351, the defendants were held estopped by a prior decree because it appeared that they were the real defendants in the earlier suit, and that the nominal defendant was their agent. See also Australian Knitting Company *v.* Gormly, 138 Fed. 92.

I am compelled to conclude that the defendant herein was not a privy to the litigation in the southern district of New York, and was consequently not concluded thereby.

Nor do I find any evidence of infringement of the complainant's patent by the defendant. The only evidence offered upon that point worthy of review, was the introduction under objection of the evidence of a deceased witness, one Clotworthy, who was examined in Rumford Chemical Works *v.* New York Baking Powder Com-

pany, *supra*. Assuming that the issues in the two cases are substantially the same, although the record was not offered and there is no evidence that they are, still the evidence would only be admissible in a subsequent suit between the same parties or their privies, a situation which we have found does not exist, but waiving that and assuming that my conclusion in that respect is unwarranted, the testimony was not admissible in the form in which it was offered. The witness produced to prove the testimony of the deceased witness, did not attempt to give all of his testimony, or all of his testimony upon any given point. He testified that the printed record in the New York case which he had read or examined, was a correct transcript of what the deceased witness testified to in his presence, whereupon counsel for the complainant, without
117 offering the record, if indeed, it were admissible, or having the witness testify to its contents at length, gave notice that he could print as a part of the complainant's record herein, the deposition referred to, or at least so much thereof as related to the point at issue; and in the record herein, two or three pages of the testimony of the deceased witness taken from the printed record, appear. I think the introduction of the testimony into the record in this manner was improper, and as objection was made thereto, it should be stricken out. The witness should himself have testified into the record what the deceased witness swore to, or the substance thereof, and it should not have been left to counsel to pick out and introduce such portions only as he might deem relevant or important to his case. It is for the court to say whether the testimony or any part of it, was relevant. Counsel has evidently incorporated in this record as appears by the numbered questions and cross-questions only fragmentary and disjoined selections from the testimony of the deceased witness. Furthermore, if we consider the bill rendered for the alleged infringing article, which appears by the Clotworthy testimony to have been sold to his company, the receipt therefor and the testimony of Heller pertinent thereto, it is not certainly shown whether the sale was made by the New York or the New Jersey corporation. A *prima facie* case has not been made. Infringement must be proved and cannot be based upon conjectural testimony. The specific sale sought to be proven by the above testimony, was of a barrel of acid phosphate, a constituent element in the manufacture of baking powder, and the claim is made that it was knowingly sold for the purpose of being used in the manufacture of baking powder; that it was designed and intended for that use solely, and that consequently the defendant by the sale became guilty of contributory infringement. Assuming that the article in question was sold by the defendant to Clotworthy or others, there is no evidence showing for what purpose it was sold or used, or that it was only useful when, combined in the manner provided in the patent in suit, on the contrary, there is evidence that it was an article of commerce in general and common use for a number of specific purposes; it is true it could be combined and used as claimed in the patent, but it could likewise be used, and was sold and used for a variety of other purposes, and I find no evidence in the case to show that there was any agreement, knowledge or understanding that any acid phosphate

sold by the defendant was to be combined with other articles to infringe the complainant's patent. The complainant made
118 Heller his own witness and his testimony corroborated by Wadman to some extent as to the variety of uses for which acid phosphate is manufactured, adapted and sold, is uncontradicted. In order to establish contributory infringement, it should be convincingly shown that a granular acid phosphate manufactured by the defendant went into a baking-powder, which infringed the patent in suit, and that the defendant manufactured and sold said phosphate knowing, or having reasonable cause to know, that it was to be used in an infringing baking powder. I find this doctrine supported by numerous cases; in Edison Electric Light Company *et al. v.* Peninsular Light, Power and Heat Co. *et al.*, 95 Fed., at page 673, it is said:

"The doctrine of contributory infringement has never been ap-
" plied to a case where the thing alleged to be contributed is one of
" general use, saitable to a great variety of other methods of use,
" and especially where there is no agreement or definite purpose
" that the thing sold shall be employed with other things so as to
" infringe a patent right. The cases which are cited (Thomson-
" Houston Electric Co. *v.* Kelsey Electric Ry. Specialty Co., 72 Fed.
" 1016; Heaton-Peninsular Button-Fastener Co. *v.* Eureka Specialty
" Co., 25 C. C. A. 267, 77 Fed. 297) do not support the position
" taken; for in those cases not only was the thing furnished pecu-
" liarly adapted to the infringing use, but the court found, as matter
" of fact, that there was a wrongful purpose on the part of the con-
" tributing defendant that the article supplied should be so used.
" These are the characteristics of a case for making one liable as a
" contributory infringer."

In Bullock Electric & Mfg. Co. *v.* Westinghouse Electric & Mfg. Co., 129 Fed. 105,111, the principal is laid down as follows: "The intent and purpose that the element made and sold shall be used in a way that shall infringe the combination in which it is an element, constitutes the necessary concert of action between him who furnished the single part and he who actually does the injury by the assembling and using of all the parts in such a way as to be an infringement." Citing cases. See also Thompson-Hounton Electric Company *v.* Ohio Brass Co., 80 Fed. 712, 721; Standard Computing Scale Company *v.* Computing Scale Co., 126 Fed. 639; Snyder *et al v.* Bunnell *et al.*, 29 Fed. 47.

Upon the evidence adduced, it would be inequitable to hold the defendant guilty of contributory infringement. Taking into account all the competent evidence offered and giving to it full
119 probative force and effect, it falls short of making a *prima facie* case against the defendant. I reach this decision with less hesitation for the reason that if the defendant were seriously encroaching upon the complainant's rights, it would seem reasonable to suppose that some evidence of the fact might have been produced other than that of an alleged sale made in 1901, supported only by incompetent or inconclusive proof.

The bill will be dismissed with costs.

JOSEPH CROSS, *Judge.*

In the Circuit Court of the United States for the District of New Jersey. In Equity.

RUMFORD CHEMICAL WORKS
vs.
HYGIENIC CHEMICAL COMPANY.

On Catlin Patent.

Petition for Rehearing.

(Filed December 28, 1906.)

Now comes the Rumford Chemical Works, the complainant herein, and respectfully presents its Petition for Rehearing of this cause, and for ground of said Petition alleges that the determination of this cause involves technical questions of patent law and of evidence, and the construing of evidence relating thereto; and that in the Opinion of the Court filed herein on Dec. 7, 1906, are certain material errors or misapprehensions in regard to material and important questions both of law and of fact; and that, in the complainant's opinion, these misapprehensions and errors can readily be pointed out and corrected by this Court at this time.

I.

On typewritten page 2 of the said Opinion the line of reasoning of the Court begins as follows:

"It is true that Mr. Heller, who is the president of and interested as a stockholder in both of the Hygienic Chemical Companies, gave testimony in that suit [meaning the former suit in New York, 134 F. R. 385], but how, for what purpose, in what character or under what circumstances, does not appear."

120 The facts in this regard are, and it so appears affirmatively in the evidence, that Heller gave testimony *as a witness for the defense* (p. 49, Q. 53); that he appeared *voluntarily* (p. 71, R. D. Q. 134), and, moreover, gave his personal assistance throughout to the defense, because he had promised the defendant to do so (p. 71, R. D. Q. 132).

It further appears that when Mr. Heller was asked the question "In what manner he was interested in that suit," he answered:

"We are manufacturers of granulated acid phosphate and are selling it to the trade in the same way as the parties who are sued in this case, the Provident Chemical Works of St. Louis" (fols. 196-7). That is to say "*I* am interested because I am President of the Hygienic Chemical Company and it is doing the same acts for which the Provident Works are being sued; and for that reason I and my Company have most surely undertaken to assist in bearing the burdens of this defense financially and otherwise."

In Q. 55 in the present suit, he was asked if these former answers were *true*. Instead of denying the correctness of his sworn testimony in the former case, he merely attempts to differentiate the

two Hygienic Companies—saying it was the New Jersey concern that did the manufacturing and the New York Company that did the assisting. This is no denial of the fact that the Company with which Heller was concerned was doing the same acts for which the Provident Company was being sued, and that, therefore, "we" were interested in the suit and had promised to help defend it.

Therefore, it does clearly appear that Heller gave testimony in the former suit, (*a*—how) as a voluntary witness for defendant, (*b*—for what purpose) in order to defeat our Catlin patent here sued on, because his Company was doing the same acts there complained of, (*c*—in what character) because he was President of, and a stockholder in, the Hygienic Companies, and (*d*—under what circumstances) because he and his Companies had "undertaken"—that is, *agreed* or *contracted* or *promised*—"most surely" to do so, and he himself had "personally promised" to be present whenever he could, and had done so. Why, for what earthly reason, would a business man like Mr. Heller give up day after day of his time in attendance on the monotony of taking testimony in an Equity suit, in which the record fills some 1500 printed pages (see Wadman, Q.'s 6 and 7, whose testimony in the other case was on p. 1290 thereof)?

121 And why would the Hygienic Company promise to contribute, and actually contribute, to the defense? The Opinion of the Court suggests "such a contribution might well be made from *charitable* or other good and sufficient reasons."

To assume that this agreement to assist, and this financial assistance, and the other assistance, and Dr. Heller's personal attention, were all given from purely charitable reasons, is contrary to all the known laws of human conduct, and is a most unreasonable assumption. Whereas, on the other hand, the contribution was in fact made "for other good and sufficient reasons," namely, that given in Mr. Heller's former testimony (set out in Q. 55), and tacitly admitted by him in answer to Q. 55.

We have dwelt on this particular point, which would be immaterial in itself, except (we respectfully submit) in that it indicates that the Court, in approaching the discussion of the case, starting out with the wrong impression. It is manifest that Heller, though produced as a witness for complainant, was taken from a hostile camp, and his answers are very evasive to say the least; so that all *ambiguities* or *incompletenesses* of answer should be assumed to be *admissions.*

II.

On typewritten page 6 of the Opinion, it is said that:

"The witness produced to prove the testimony of the deceased witness, did not attempt to give all of his testimony, *or all of his testimony upon any given point.*"

The error lies in the italicized portion. Mr. Arnold testified in answer to Q. 6 (p. 94):

"I remember that Mr. Clotworthy testified that he received one or more barrels of granular acid phosphate from the Hygienic Chemical Company and from the Provident Chemical Works, and that he had shipped one or more of these barrels to me."

And in answer to Q.'s 7 and 8:

"He testified that he had received bills, either receipted or a separate receipt for them." And

"That they were sent to me."

Greenleaf on Evidence (15th Ed., p. 239) says:

"It seems, therefore, to be generally considered sufficient, if the witness is able to state the substance of what was sworn on the former trial. But he must state, in substance, the whole of what
122 was said on the particular subject which he is called to prove. If he can state only what was said on that subject by the deceased, on his examination in chief, without also giving the substance of what he said upon it in his cross-examination, it is inadmissible."

Mr. Arnold did testify *all* that Mr. Clotworthy said with regard to the particular subject, viz., the purchase by Clotworthy of the barrel of Hygienic Special; therefore his testimony is admissible. Had Mr. Arnold been asked by defendant's counsel here to state what Mr. Clotworthy said in cross-examination, and had Mr. Arnold been unable to do so, then Mr. Arnold's testimony would not have been admissible; but defendant's counsel refrained from cross-examining him. We did print, under our notice (fol. 382) *all* of the Clotworthy deposition that relates to the barrel of Hygienic Special Phosphate; and we asserted this as a fact, so that, had any part of the same been omitted, defendant might either have adduced this as a reason for suppressing our exhibit, or might have introduced the whole deposition.

III.

The Court has found correctly that, at the date of incorporation of the two Hygienic Companies, these two concerns were identical in interests, and they with Mr. Heller were all three privies; "at the time of their organization they seemed to have been controlled by two men" (top of p. 4 of the Opinion). The Court also notes that Heller is the President of and interested as a stockholder in both of the Companies (middle of p. 2 of the Opinion). But, says the Opinion, on the top of p. 4:

"These are *all* the facts tending to show that the corporations are identical."

The proofs show that Heller and Hirsh (particularly the former) are still in absolute control of both Companies:

1. The Manager of this defendant, Mr. Wadman, worked under Mr. Heller's directions (Q. 78), and continues to consult with Mr. Heller on matters of importance (Q. 79). Mr. Wadman frequently consults Mr. Heller (Heller, Q. 19) and sometimes might consult Mr. Hirsh (Q. 21), and in a general way *all* of Mr. Wadman's industry is by direction of Mr. Heller (Wadman, Q. 43).

2. Mr. Heller tells us (fols. 239-240) that *he* it was who was President of the Hygienic Chemical Company, and that *he*
123 it was who, as President, kept posted as to the requirements of the baking powder manufacturers, and that *he* it was who, as President, endeavored as near as it possibly could be done to meet the requirements of the trade.

3. Mr. Heller was the man who was conducting negotiations with their competitors in the furnishing of acid phosphate to baking powder manufacturers (fols. 227-231); and it was Mr. Heller who undertook to give his personal assistance to the Provident Chemical Works, because he was the man largely interested in, and in control of, the Hygienic Company which was doing the same acts as the Provident Chemical Works.

4. Mr. Wadman, Superintendent of defendant, has no authority to produce a sample of defendant's product "except as directed by the officers of the Company" (Wadman, Q. 19), that is, by Heller and Hirsh. With regard to putting out new brands or altering the character of the product, Heller and Hirsh "instruct" while Wadman can only "suggest" (Wadman, Q.'s 20-21). Mr. Wadman was "*instructed* to discontinue the manufacture" of certain products, of course, by those same officers Heller and Hirsh (Wadman, Q. 29).

The Court comments on complainant's failure to inquire further from defendant as to the present holding of shares. Upon second thought, the Court can conceive that the stock lists of the two corporations would, straightway, be filled with the names of dummy share holders.

When we remember that the two corporations and Heller and Hirsh *were originally* identical in interests; when we note that Heller and Hirsh have continued down to this day in absolute control; when we note further the evasive nature of Heller's replies; and when we consider the fact that if privity had ceased to exist before the filing of our Bill and before the previous period during which we charged infringement, Heller not only would have said so, but would have said so eagerly; and when we recall that this is a matter peculiarly within the knowledge of the defendants, so that upon their failure to clear up the point it must be resolved against them; and when we remember that the presumption of law is that the privity has continued down to the present day; we say that it is sufficient proof that the privity still continues, and that the acts of any one of the four bind this defendant.

IV.

We respectfully submit that under the discussion of "privity" the Court has misapprehended the facts proved in this case, and has thereby reached erroneous conclusions of law.

124 As to the first point, it is not true that the only fact proved is that somebody not connected with this defendant contributed to the defense of the former suit. In this suit Heller admits that the New York Company did contribute financially; and he also admits that "we" had "undertaken" to contribute. This is the "agreement" which this Court possibly overlooked. More than this, "we" (admitted to be the New York Company) had agreed to contribute and did contribute "otherwise" than financially. In the third place, Mr. Heller is by no means sure that *this defendant also* did not contribute:

"As near as I remember, [note the convenient memory] I don't

think they did financially, and I don't remember (!) whether they did otherwise" (Heller, Q. 57).

In the fourth place, Heller himself "contributed" by giving his personal attendance. Why was Mr. Heller sitting in the examination room, day after day? What was he there for? Merely as a spectator, "the innocent bystander"? The only answer can be that Mr. Heller was there for the very purpose of assisting counsel for the defense, in advising him what line of cross-examination to follow, and, in fact, that he was in the position where he had the *right* to control the defense, or to take part in its control. In fact, we say the conclusion is inevitable that Mr. Heller had greater control of the conduct of the defense than Mr. Udell himself, the President of the nominal defendant Provident Chemical Works (Heller, *R-d s.* 131-132).

See first and second syllabus of Miller *v.* Tobacco Co., 7 F. R. 91.

See also Theller *v.* Hershey, 89 F. R. on page 576, middle paragraph.

As to the law of the case, the Opinion says:

"I have found no case which goes to the length of saying that one who merely contributes to the defense of a suit, is bound as a privy by the result thereof."

1. Robinson on Patents, § 1176, p. 566, says:

"All others who participate in the litigation by employing counsel, *or by contributing towards expenses,* or who *in any manner* direct the course of the proceedings" (as Mr. Heller did while attending the taking of testimony in the former suit) are privies.

2. Walker on Patents (§ 468, p. 382, and foot-note 4) says that one who contributes money to the defense of the former suit, if the fact be known at the time to the complainant, becomes a privy.

3. Miller *v.* Tobacco Co. (7 F. R. 91) says one who con-
125 tributes money for the defense "has the *right* to take such action in the case as will protect his interests in such litigation," and, therefore, "he has had all the ordinary rights of a litigant," and consequently he is bound by the results.

4. Theller *v.* Hershey (89 F. R. 576) says that it is sufficient if the party alleged to be a privy to the former suit had had the *right* to control the litigation therein, whether in fact he actually exercised his rights or not (pp. 575-6).

On page 576, the Court said:

"Parties include * * * all others who participate in the litigation by employing counsel, *or by contributing towards the expenses thereof, or* who, *in any manner,* have such control thereof as to be *entitled* to direct the course of proceedings therein."

Note the separate grounds: (*a*) contributing towards the expenses, *or,* as a separate ground (*b*) being entitled to direct the course of proceedings, as Mr. Heller became when he agreed with Mr. Udell, the president of the former defendant, to attend the taking of testimony.

5. In Knitting Co. *v.* Gormly (138 F. R. 96), speaking of the party charged to have been a privy to the former suit the Court says:

"It does not appear that he put himself in such a position that he could control or direct the defense, or appeal in the event of a holding in favor of the validity of the patent."

Nevertheless, on p. 99, the Court found that he was a privy, but held that (inasmuch as the former decree was merely interlocutory) Gormly was not precluded from presenting new defenses.

6. In Penfield *v.* Potts, it is said that a person is concluded by the judgment provided he joined in the defense of the suit for his own interest, and provided his conduct was open and avowed to the opposite party (p. 480). He does not have to be in control, it is sufficient if he merely *joins* in the defense, and if it be for his own interest. Mr. Heller certainly *joined* in the defense of the former suit, and he did so because "we" were interested in that suit since "we" were manufacturing and selling to baking powder manufacturers the same thing that the Provident people were handling.

One other point: On referring to the reported case (134 F. R. 385), the Court will see that the defendants there were repre-
126 sented by Messrs. Briesen & Knauth, as solicitors, and Arthur *v.* Briesen, Esq., as of counsel. The answer in this suit (p. 25) shows the same solicitor and counsel originally appearing here for the defendant.

These facts we hold to be clear, even in spite of the poor memory of Mr. Heller, viz.: The defendant in New Jersey was manufacturing and the defendant in New York was selling, both of them under the absolute control of Heller and Hirsh, the same article that the Provident Company was manufacturing and selling; the Provident Company was sued by us, and the Hygienic people at once became "interested," and at once "undertook" to assist in the defense, and Heller himself "promised" the President of the Provident Works to give his personal attention. Further, the contributions were made, and Mr. Heller did appear at most of the sessions. Had the patent been held invalid, Heller and the two Hygienic Companies would then have benefited by it, and it was to their interest to defend the suit, and they did so. Now, it is indeed astonishing to be told that they were not *privies* to the former suit, and are not bound by its adjudications.

V.

Aside from the Arnold testimony and the Clotworthy deposition, the admissions of Messrs. Heller and Wadman prove infringement.

1. According to the testimony of Mr. Wadman, from the beginning of 1898 to as late as June, 1901 (Q.'s 6-8), and, in fact, down to July, 1904 (Q. 29), defendant was putting out a brand of granular acid phosphate which it called "Special." This "Special" acid phosphate contained a mixture of particles of various sizes (Q. 9). Though all of defendant's phosphates are said to contain a percentage of coarse particles, this "Special" contained a greater proportion of the coarse particles than defendant's regular products, and the

average size of those particles was larger in the "Special" than in their other brands (Q.'s 33-4). This peculiarity, viz., making the acid phosphate, or a large proportion of it, in the coarser form—"granular"—was given to the "Special" *for the express purpose of realizing and obtaining all the benefits of our patented invention* (Q.'s 37-8, Q. 25, etc.). That is to say, to prevent deterioration; to cause it to dissolve more slowly, and, consequently, to evolve more gas; and to augment leavening efficiency. Compare the language of the Court of Appeals in Volume 134 F. R., just
127 above the middle of page 386, with the Wadman letter found on page 84 of the Record.

2. Defendant's "Special," according to Mr. Wadman's recollection, manifested (to an even greater degree than our Exhibit Sample) the phenomenon of "flowing" instead of *packing* when tilted (Q. 12), which the Court can satisfy itself distinguishes *granular* substances from *pulverulent* ones. When we obtained in New York an injunction against defendant's product, Mr. Wadman was instructed to discontinue the manufacture of any material that might be construed as conflicting with our patent, and *did* accordingly make a change, reducing the size and proportions of the coarse material (Q. 29, taken with Q. 25). This also seems to us a reluctant, but clear, admission that, in addition to defendant's regular products, they were during that period putting out an essentially *granular* acid phosphate.

3. Recalling that during the same period (1898-1904), to wit, in March, 1901, complainant obtained a barrel of granular acid phosphate accompanied by a bill identifying it as "Special," and also a receipt; that the bill and receipt was *prima facie* the bill head of defendant; and that Heller, when twice given an opportunity to deny that fact, did not do so (Heller, Q.'s 67-8)—the inference is very strong indeed that the barrel came from defendant.

4. The homely proverb already quoted, "The galled jade winces," and another one—"Every foot knows where its own shoe pinches," apply here. These crystallized bits of wisdom declare tersely the "known rules of human conduct." If the defendants were manufacturing and selling any form of product which resembled the acid phosphate of the Provident Works sufficiently to cause defendant to feel alarm and therefore to assume a share in the Provident defense in the former suit, such product resembled the Provident phosphate sufficiently to be likewise "essentially *granular*"—and the inference that the barrel came from defendant and was an infringement becomes almost irresistible.

The "Hygienic Bill" and the "Hygienic Receipt" were duly proved and offered in evidence in the other suit, and when the record was taken to the Court of Appeals, these papers were photolithographed for that purpose. In this suit we showed Mr. Heller one of these lithographic copies, and asked him whether he could identify them. His reply (to Q. 67) was:

"It is hard for me to tell."

Had the original *not* been the genuine bill of his Company, he would certainly have taken this opportunity to say so.

128 We then asked him as to *which* of the two Hygienic Companies appeared to have made the sale. He was content to answer merely:

"As near as I can see now there isn't anything on the two instruments which would lead me to know whether it was from the Hygienic Chemical Company of New York or the Hygienic Chemical Company of New Jersey."

It really inculpates both Hygienic Companies.

The significance of defendant's silence is set out on pages 16-17 of our printed "Supplemental Brief for Complainant."

VI.

The Opinion of the Court asserts that, assuming that the barrel of Hygienic Special Acid Phosphate was actually sold by defendent to Clotworthy, yet "there is no evidence showing for what purpose it was sold or used, or that it was only useful when combined in the manner provided in the patent in suit." Whereas, "on the contrary there is evidence that it was an article of commerce in general and in common use for a number of specific purposes;" * * * and the Court finds "no evidence in the case to show that there was any agreement, knowledge or understanding that any acid phosphate sold by the defendant was to be combined with any other articles to infringe the complainant's patent,"—which we understand to mean,—"to be combined with any other article to constitute a baking powder."

We will show that the Court misapprehended the evidence in concluding that the article in question was in general and in common use for a number of specific purposes; that the Court was in error in concluding that there is no evidence that this particular article was put out for the express purpose of being used as a baking powder ingredient; and that the Court erred as a matter of law in assuming that one cannot be held guilty of contributory infringement when he knowingly furnishes one of the elements of a patented combination with the intent that it shall be used in that combination, unless in that particular instance the infringement has been consummated.

The source of the Court's misapprehension lies in confusing *granular* acid phosphate with acid phosphate in general. Acid phosphates are (*a*) liquid, (*b*) finely powdered or "pulverulent," and (*c*) coarse or "granular." Now it is perfectly true, as
129 stated by the Opinion of this Court, that acid phosphates in general are sold and used for a variety of purposes. But it is absolutely untrue that *granular* acid phosphate is sold or used for any purpose whatever except as an ingredient of a baking powder.

The testimony is full of answers by Heller and Wadman showing that their "Special" brand of acid phosphate was made granular for the very *purpose of its use in baking preparations* (Heller, Q.'s 59-60, p. 51). Wadman says the Special, containing a larger percentage of the coarser material, was developed for the express purpose of baking powder preparations: "* * * I had steadily and continuously increased the size of the particles. Unquestionably

the reasons as given in this letter (found on page 85) * * * were among those that led me to make the changes referred to" (Wadman, fol. 312). These are only samples of the evidence, and there is much more which shows conclusively that defendant's product was given this peculiar characteristic for the sole and only purpose of adapting it as a baking powder ingredient. The *intent* to furnish one element of a baking powder ingredient could not be more clearly made out.

The Court of Appeals has found (134 F. R. 389) that the granular acid phosphate commands a much higher price than the powdered article. The situation should be regarded from the standpoint of common sense: granular article has no advantage over the other two forms (liquid or pulverulent) for any purpose whatever—except as a baking ingredient. Why on earth would anybody pay a higher price for acid phosphate if they could get the same benefit at a cheaper price? Defendants well *knew*, and their customers well *knew*, that this granular acid phosphate was made granular—was brought into existence in its own peculiar form—solely and exclusively for the purpose of a baking powder ingredient. Defendants well knew that it was being used for that purpose; no one can read the testimony of Mr. Heller and of Mr. Wadman without reaching this conclusion. It is beyond credence that defendant, having produced an article which has no earthly reasons for its existence except as a baking powder ingredient, and having been carefully feeling the pulse of the baking powder trade, and then selling this article to the baking powder trade,—we say it is incredible to assert that they did not know that the article was therefore being used in baking powders.

If the Court will bear in mind the distinction between *granular* acid phosphate on one hand, and on the other hand acid phosphates in general, the law of the case is clear: There is pres-
130 ent an article which was "peculiarly adapted to the infringing use," and there was present the intent or "purpose on the part of the contributing defendant that the article supplied should be so used. These are the characteristics of a case for making one liable as a contributory infringer."

Edison *v.* Peninsular, 95 F. R., quoted on type-written page 9 of the Opinion in this case.

There is also present in the case at bar that "definite *purpose* that the thing sold shall be employed with other things so as to infringe a patent right," referred to in the same decision (bottom of page 8 of the present Opinion), which, in 95 Fed., was stated as an essential. For instance, says Heller,—

"Q. 59. What was the object in having*g* the acid phosphate, or any portion of it, 'granular'?

"A. As near as I can remember, it had to be granulated before it could be used for baking powder.

"Q. 60. Then the PURPOSE in making it 'granulated' was so as to adapt it for use in baking preparations?

"A. YES, that we have done since 1886" (p. 51).

See, also, decision of the Sixth Circuit Court of Appeals in Canada *v.* Michigan Iron Co., 124 F. R. 486, on p. 489:

"The form and characteristics [of the article held to be a contributory infringement] plainly indicated their purpose * * * It has been held that, even in that case [capability of a non-infringing use] if it were proved that the thing, although adapted to other uses, was nevertheless intended by the seller to go into, and to contribute to the infringement by another, the furnisher could not escape the consequences of the infringement."

VII.

The importance of this case has induced us to apply to this Court for a re-hearing instead of taking our appeal at once. It was in 1900 that our first bill of complaint was filed in New York, the infringements throughout the country having begun some time previously. The patent was extensively infringed by scores of concerns throughout the country, and infringement continued during the years the main suit was being contested. After that suit was disposed of, the other defendants, one by one, have settled with complainant,—these defendants only holding out. Their infringement must have
131 been extensive, in order to justify the spending of their money and time in attempting to defeat our patent. If the Court will again read that portion of Mr. Heller's testimony found in folios 195-198, the conclusion is irresistible that so long as there appeared hope of defeating our Catlin patent, these defendant- were glorying in their position as having lined up with the Provident Works to defeat the patent, and had the Provident Works been successful, these defendants would have been the very first to take advantage of the outcome. Is it fair for it to be contended now that these defendants must not equally abide the outcome if it prove unfavorable to them?

One word more: The Opinion of this Court concludes with saying "if these defendants were seriously encroaching upon our rights we should produce some other proof of it than the alleged sale made in 1901." The reply of this is easy: The Federal Courts have repeatedly condemned the practice of filling up the Record with cumulative instances of infringement. In the case of a chemical compound or "composition of matter," learned Judges have repeatedly said "It is sufficient if complainant proves the sale of a single ounce, the extent of sales being a matter for the subsequent accounting." In the second place, the Court will recall that these defendants have been under injunction (Wadman, Q. 29, p. 79), and their Superintendent refused to produce a sample of their present manufacture (Wadman, Q. 19).

In view of all of the foregoing, your petitioner respectfully requests a re-consideration, and (if it seems good to this Court) an oral hearing.

New York City, Dec. 20, 1906.

Respectfully submitted,

RUMFORD CHEMICAL WORKS,

By C. A. L. MASSIE,

Solicitor and of Counsel.

Certificate of Counsel.

I, C. A. L. Massie, solicitor and of counsel for the complainant herein, certify that I am familiar with the Record in this case and with the Opinion of the Court rendered herein on or about December 6, 1906; that I have been unable to present this petition earlier, owing to the pressure of other urgent matters (including cases in which my time for taking testimony had been limited); that I have prepared this Petition for Rehearing after a careful review of
132 the Record and Said Opinion, and that, in my opinion, the said Petition is well founded in law and in fact; and I further certify that the said Petition is made in good faith, because I verily believe the Court has erred in material facts in the case; and in conclusion that the said petition is not interposed for the purpose of delay, but is made in the interests of justice and to protect the rights of complainant.

C. A. L. MASSIE,
Of Counsel for Complainant.

At a Stated Term of the Circuit Court of the United States for the District of New Jersey, held in the Court-rooms thereof, in the Post Office Building, in the City of Trenton, in the State of New Jersey, on the 28th Day of December, 1906.

Present: Hon. Joseph Cross, U. S. District Judge.

RUMFORD CHEMICAL WORKS, Complainant,
vs.
HYGIENIC CHEMICAL COMPANY, Defendant.

Final Decree.

(Filed December 28, 1906.)

This cause having come on to be heard upon the pleadings and proofs, and C. A. L. Massie, Esq., having been heard on the part of the complainant, and Willard Parker Butler, Esq., on the part of the defendant, and due deliberation having been had.

Now upon motion of Whitridge, Butler & Rice, solicitors for the defendant, it is

Ordered, adjudged and decreed that the said bill of complaint herein be and the same hereby is dismissed with costs to the defendant to be taxed.

JOSEPH CROSS, *Judge.*

December 28, 1906.

133 In the Circuit Court of the United States for the District of New Jersey. In Equity.

RUMFORD CHEMICAL WORKS
vs.
HYGIENIC CHEMICAL COMPANY.

Notice of Appeal.

(Filed January 21, 1907.)

To Henry D. Oliphant, Esq., Clerk of the United States Circuit Court for the District of New Jersey.
To Messrs. Whitridge, Butler & Rice, Solicitors for Defendant, 59 Wall St., New York City.

SIRS:—Please take notice that the above-named complainant, Rumford Chemical Works, hereby appeals to the United States Circuit Court of Appeals for the Third Circuit from the final decree in the above-entitled cause entered in the Office of the Clerk of this Court on or about the 28th day of December, 1906, and from the whole and from each and every part thereof.

Dated, New York City, January 14, 1907.

Yours respectfully,
C. A. L. MASSIE,
Solicitor for Complainant.

In the Circuit Court of the United States for the District of New Jersey. In Equity.

RUMFORD CHEMICAL WORKS
vs.
HYGIENIC CHEMICAL COMPANY.

Appeal.

(Filed January 21, 1907.)

The above-named complainant, Rumford Chemical Works, considering itself aggrieved by the final decree of this Court, filed and entered herein on or about the 28th day of December, 1906, dismissing the bill of complaint herein, with costs, does hereby
134 appeal to the United States Circuit Court of Appeals for the Third Circuit, and prays that its appeal may be allowed and citation granted, directed to the above-named defendant, Hygienic Chemical Company, commanding it to appear before the said Court of Appeals, to do and receive what may appertain to justice to be done in the premises; and that a transcript of the pleadings and proofs, exhibits, evidence, records and proceedings in said cause, including the Petition for Rehearing, duly authenticated, may be

sent to the United States Circuit Court of Appeals for the Third Circuit.

Dated New York City, January 14, 1907.

C. A. L. MASSIE,
Solicitor for Complainant,
90 West Broadway, New York City.

Security for costs having been waived by Solicitors for Defendant, it is this day

Ordered that the foregoing appeal be and the same is hereby allowed.

Dated January 21, 1907.

JOSEPH CROSS, *U. S. J.*

The filing of a bond by Complainant-Appellant, as security for costs to Defendant-Appellee, is hereby waived; and it is stipulated that the settlement of costs in the Circuit Court may await the final decision of this case by the Court of Appeals.

January 14, 1907.

WHITRIDGE, BUTLER & RICE,
Solicitors for Defendant-Appellee.

In the Circuit Court of the United States for the District of New Jersey. In Equity.

RUMFORD CHEMICAL WORKS
vs.
HYGIENIC CHEMICAL COMPANY.

Assignment of Errors.

(Filed January 21, 1907.)

And now comes the above-named complainant, and says: That in the record and proceedings of this Court in the above-entitled
135 cause, and in the final decree made and entered therein on or about Dec. 28, 1906, dismissing the bill of complaint, with costs, there is manifest error; and for error the said complainant assigns the following, upon its appeal from the said final decree, to wit:

1. The Court erred in dismissing the Bill of Complaint with costs.

2. The Court erred in not sustaining the Bill of Complaint and granting an injunction and an accounting with costs as prayed.

3. The Court erred in not granting three-fold damages as prayed.

4. The Court erred in not holding the defendant privy to the defense in the former suit entitled Rumford Chemical Works *vs.* New York Baking Powder Company *et al.,* decided by the Circuit Court of Appeals of the Second Circuit, and reported in 134 F. R. 385.

5. The Court erred in not holding this defendant, and the Hygienic Chemical Company (the New York corporation), James E. Heller, and Adolph Hirsh, as privies to the former litigation and to the subject-matter at issue herein.

6. The Court erred in not holding that the said Heller and Hirsh are now and at all times have been in absolute control of this defendant and of the Hygienic Chemical Company (the New York corporation).

7. The Court erred in not holding as a matter of law that one who has contributed openly and avowedly to the defense of a former suit has the right to make defense therein, and is a privy to that former suit.

8. The Court erred in not holding that James E. Heller, President of this defendant, assisted on behalf of this defendant in the defense of the former suit, and that this defendant had the right to control and did control said former suit.

9. The Court erred in holding that there is no evidence of infringement of the patent in suit by this defendant; and in not holding that there is ample proof of such infringement.

10. The Court erred in holding that the testimony of Mr. Arnold stating the testimony of the deceased witness Clotworthy is inadmissible and should be stricken out.

11. The Court erred in holding that the said Arnold did not attempt to give and did not give all the testimony of the said Clotworthy upon the matter in question.

12. The Court erred in holding that the said Arnold did not testify into the record what the deceased witness Clotworthy swore to, or the substance thereof.

136 13. The Court erred in holding that "it is not certainly shown whether the sale was made by the New York or the New Jersey corporation"; and in not holding that both the New Jersey corporation (the defendant herein) and the New York corporation were responsible for the said sale.

14. The Court erred in not holding that, upon the *prima facie* proofs made out, the burden of proof was shifted to defendant, and upon its failure to take proof that the question of infringement should be resolved against defendant.

15. The Court erred in holding that there is no contributory infringement.

16. The Court erred in not perceiving and appreciating the difference between a *granular* acid phosphate and acid phosphates in general.

17. The Court erred in holding that granular acid phosphate is an article of commerce in general and in common use for a number of specific purposes.

18. The Court erred in holding that granular acid phosphate was ever used or sold for any other purpose except for an ingredient of baking powder in infringement of the patent in suit.

19. The Court erred in finding that there was no evidence in the case to show that there was any agreement, knowledge or understanding on the part of defendant that any acid phosphate or any gran-

ular acid phosphate sold by the defendant, was to be used as an ingredient of a baking preparation.

20. The Court erred in holding that the testimony of Heller and Wadman shows that granular acid phosphate is manufactured or sold or used by defendant for any purpose whatsoever, except as an ingredient for baking preparations.

21. The Court erred in holding that the defendant had no knowledge, and no "reasonable cause to know," that its granular acid phosphate was to be used in a baking powder.

22. The Court erred in not holding that one who intentionally furnishes one element of a patented combination, with the purpose and intent that it shall be combined with the other element or elements of the combination, to produce the patented article, is a contributory infringer, even though the other party has not consummated the complete infringement.

23. The Court erred in holding that complainant must furnish more than one instance of infringement, especially since the facts show that this suit was suspended pending the determination of the test suit in the Second Circuit, and that the defendant and its associates were under preliminary injunction.

137 Wherefore, and for divers other errors in the record of this cause appearing, the complainant, Rumford Chemical Works, prays that the final decree aforesaid may be reversed and annulled, and that the Circuit Court of the United States for the District of New Jersey be directed by Mandate of the Circuit Court of Appeal for the Third Circuit to enter a decree sustaining the validity of the claims of the Catlin patent here in suit, and complainant's title thereto, finding infringement thereof by the above-named defendant, and ordering the injunction and accounting and other relief prayed for in the bill of complaint, and vacating and setting aside said final decree of or about December 28, 1906.

C. A. L. MASSIE,
Solicitor for Complainant.

Citation.

(Filed January 25, 1907.)

UNITED STATES OF AMERICA, *ss:*

The President of the United States to the Hygienic Chemical Company, Greeting:

You are hereby cited and admonished to be and appear at the United States Circuit Court of Appeals for the Third Circuit, to be held at the City of Philadelphia, in the State of Pennsylvania, within thirty days from the date of this suit, pursuant to an appeal duly allowed and filed in the Office of the Clerk of the Circuit Court of the United States for the District of New Jersey, wherein the Rumford Chemical Works is Complainant-Appellant and you are the Defendant-Appellee, to show cause, if any there be, why the

final decree in said appeal mentioned should not be reversed or corrected, and speedy justice should not be done in that behalf.

Witness, the Honorable Melville W. Fuller, Chief Justice of the Supreme Court of the United States of America, this 21st day of January, A. D. 1907.

[SEAL.] JOSEPH CROSS,
United States Judge, District of New Jersey.

A copy of the within paper has been this day received at this office January 23, 1907.

WHITRIDGE, BUTLER & RICE.

138 *Clerk's Certificate.*

UNITED STATES OF AMERICA,
District of New Jersey, ss:

I, Henry D. Oliphant, Clerk of the Circuit Court of the United States for the District of New Jersey, do hereby certify that the foregoing is a full, true and complete transcript of the record in the case of Rumford Chemical Works, Complainant, against Hygienic Chemical Company, Defendant, as the same remains of record and on file in my office.

In Witness Whereof, I have hereunto subscribed my name and affixed the seal of said Court at Trenton, in said District, this eleventh day of February, nineteen hundred and seven.

[L. S.] H. D. OLIPHANT, *Clerk.*

139 And afterwards to wit: on the eighteenth day of March A. D. 1907, this cause being called for argument on the transcript of record from the Circuit Court of the United States for the District of New Jersey, before the Hon. George M. Dallas, Hon. George Gray and Hon. Joseph Buffington, Circuit Judges, and being argued by counsel for the respective parties, and the court not being fully advised in the premises takes further time for consideration thereof.

And afterwards to wit on the twenty-sixth day of April A. D., 1907, comes the parties aforesaid by their counsel aforesaid, and the court now being fully advised in the premises renders the following opinion, to wit:

In the United States Circuit Court of Appeals for the Third Circuit.

RUMFORD CHEMICAL WORKS, Complainant-Appellant,
vs.
HYGIENIC CHEMICAL COMPANY, Defendant-Appellee.

Appeal from the Circuit Court of the United States for the District of New Jersey.

Before Dallas, Gray, and Buffington, Circuit Judges.

BUFFINGTON, *Circuit Judge:*

This is an appeal from a decree entered by the Circuit Court for the District of New Jersey dismissing, for non-infringement, a bill in equity filed by the Rumford Chemical Works charging the Hygienic Chemical Company of New Jersey with infringement of a patent. The court below held there was no proof of infringement and there is no error in its so holding, if the testimony of one Clotworthy was rightfully excluded. This excluded deposition of Clotworthy, now deceased, was taken in a suit in the Circuit
140 Court for the Southern District of New York (125 Fed. Rep. 231 and 134 Fed. Rep. 385) wherein the Rumford Chemical Works, the present appellant, was complainant, and the New York Baking Powder Company, *et al.*, respondents. It is alleged the respondent in the present case aided in, and contributed to, the defence of that case. On that point, however, the proofs fail. There is no proof that the present respondent, The Hygienic Chemical Company of New Jersey, contributed to the expense of the New York suit or bore the relation of privy or party to that litigation. While the Hygienic Chemical Company of New York did contribute to the defence, and one Heller, who was President of both companies, was a witness in that case, there is no sufficient proof to connect the present respondent with the defence of that case. We are therefore of opinion the court below rightly excluded Clotworthy's testimony. The decree of the court is affirmed.

(Indorsed:) Rumford Chemical Works, *vs.* Hygienic Chemical Company. Opinion of the court by Buffington, Circuit Judge. Filed April 26. 1907.

141 In the United States Circuit Court of Appeals for the Third Circuit, March Term, 1907.

No. 18.

RUMFORD CHEMICAL WORKS, Appellant,
v.
HYGIENIC CHEMICAL COMPANY, Appellee.

Appeal from the Circuit Court of the United States for the District of New Jersey.

This cause came on to be heard on the transcript of record from the Circuit Court of the United States, for the District of New Jersey, and was argued by counsel.

On consideration whereof, it is now here ordered, adjudged and decreed by this Court that the decree of the said Circuit Court in this cause, be, and the same is hereby affirmed with costs.

Philadelphia, April 29, 1907.

GEO. M. DALLAS,
Circuit Judge.

(Indorsed:) No. 18 March Term 1907. U. S. Circuit Court of Appeals for the Third Circuit. Rumford Chemical Works, Appellant *v.* Hygienic Chemical Company, Appellee. Order affirming decree. Entered and filed April 29, 1907.

142 UNITED STATES OF AMERICA, *set:*

I, William H. Merrick, Clerk of the United States Circuit Court of Appeals for the Third Circuit, do hereby certify the foregoing pages from one to one hundred and forty-one inclusive, to contain a full true, complete and faithful copy of the original transcript of record and proceedings in the case of the Rumford Chemical Works, Complainant-Appellant, and, the Hygienic Chemical Company, Defendant-Appellee, on file, and now remaining among the records of the said Court in my office.

In Testimony whereof, I have hereunto subscribed my name and affixed the seal of the said Court at Philadelphia this eighteenth day of May, in the year of our Lord one thousand nine hundred and seven, and of the Independence of the United States the one hundred and thirty-first.

[Seal United States Circuit Court of Appeals, Third Circuit.]

WM. H. MERRICK,
Clerk U. S. Circuit Court of Appeals, Third Circuit.

143 UNITED STATES OF AMERICA, *ss:*

The President of the United States of America to the Honorable the Judges of the United States Circuit Court of Appeals for the Third Circuit, Greeting:

[Seal of the Supreme Court of the United States.]

Being informed that there is now pending before you a suit in which Rumford Chemical Works is appellant, and Hygienic Chemical Company is appellee, which suit was removed into the said Circuit Court of Appeals by virtue of an appeal from the Circuit Court of the United States for the District of New Jersey, and we, being willing for certain reasons that the said cause and the record and proceedings therein should be certified by the said Circuit Court of Appeals and removed into the Supreme Court of the United
144 States, Do hereby command you that you send without delay to the said Supreme Court, as aforesaid, the record and proceedings in said cause, so that the said Supreme Court may act thereon as of right and according to law ought to be done.

Witness the Honorable Melville W. Fuller, Chief Justice of the United States, the 12th day of June, in the year of our Lord one thousand nine hundred and eight.

JAMES H. McKENNEY,
Clerk of the Supreme Court of the United States.

145 [Endorsed:] File No. 20,815. Supreme Court of the United States. No. 412, October Term, 1907. Rumford Chemical Works *vs.* Hygienic Chemical Company. Writ of Certiorari.

146 In the United States Circuit Court of Appeals for the Third Circuit, March Term, 1907.

In Equity. No. 18.

RUMFORD CHEMICAL WORKS, Complainant-Appellant,
vs.
HYGIENIC CHEMICAL COMPANY, Defendant-Appellee.

It is stipulated herein by the parties, through their respective attorneys, that the certified Transcript of the Record herein filed in the office of the Clerk of the Supreme Court of the United States, at Washington, D. C., on or about the 25th day of July, 1907, on the Petition of the Rumford Chemical Works for a Writ of Certiorari herein, may be taken as the return of this court to the Writ of Certiorari granted herein by the Supreme Court of the United States on the 12th day of June, 1908, and that a copy of this stipulation be sent by the Clerk of the Circuit Court of Appeals, for the Third Cir-

cuit, to the Supreme Court of the United States as the return of said Circuit Court of Appeals to the aforesaid Writ.

Dated, June 15, 1908.

PHILIP MAURO,
Attorney for Complainant-Appellant.
WHITRIDGE, BUTLER & RICE,
Attorneys for Defendant-Appellee.

(Indorsed:) In the Circuit Court of Appeals of the United States for the Third Circuit. Rumford Chemical Works, Complainant-Appellant, *vs.* Hygienic Chemical Company, Defendant-Appellee In Equity, Docket No. 18, March Term 1907. On Catlin Patent No. 474,811. Stipulation. Philip Mauro Attorney for Complainant-Appellant, Tribune Building, 154 Nassau Street, New York City, New York. Filed June 17, 1908.

147 UNITED STATES OF AMERICA,
Eastern District of Pennsylvania,
Third Judicial Circuit, ss:

I, William H. Merrick, Clerk of the United States Circuit Court of Appeals, for the Third Circuit, by virtue of the foregoing Writ of Certiorari and in obedience thereto do hereby certify to the Supreme Court of the United States the consent of the Counsel for the respective parties thereto annexed as my return to the said writ.

In Testimony Whereof, I have hereunto subscribed my name and affixed the seal of the said Court, at Philadelphia, this eighteenth day of June in the year of our Lord one thousand nine hundred and eight and of the Independence of the United States the one hundred and thirty-second.

[Seal United States Circuit Court of Appeals, Third Circuit.]

WM. H. MERRICK,
Clerk U. S. Circuit Court of Appeals, Third Circuit.

148 [Endorsed:] 149 20815 No. 18, March Term, 1907. United States Circuit Court of Appeals, Third Circuit. Rumford Chemical Works, Complainant-Appellant, *vs.* Hygienic Chemical Company, Defendant-Appellee. Certified Copy of Stipulation of Counsel as to return of Writ of Certiorari.

149 [Endorsed:] File No. 20,815. Supreme Court U. S., October Term, 1908. Term No. 149. Rumford Chemical Works, Petitioner, *vs.* Hygienic Chemical Co. Writ of Certiorari and return. Filed June 19th, 1908.

150 In the Supreme Court of the United States.

No. 149, October Term, 1908.

RUMFORD CHEMICAL WORKS, Petitioner (Complainant-Appellant),
vs.
HYGIENIC CHEMICAL COMPANY, Respondent (Defendant-Appellee).

No. 339, October Term, 1908.

HYGIENIC CHEMICAL COMPANY ET AL., Petitioner (Defendants-Appellees),
vs.
RUMFORD CHEMICAL WORKS, Respondent (Complainant-Appellant).

Stipulation.

It is stipulated by the above-named parties, through their respective attorneys, for the purpose of preparing Transcripts of Record of the two above-entitled causes, that the notices, stipulations, testimony, exhibits, etc. printed on pages 27-112, inclusive, in the Transcript of Record of the cause brought from the U. S. Circuit Court of Appeals for the Third Circuit (No. 149 above) are identical with the notices, stipulations, testimony, exhibits, etc. printed on pages 12-99, inclusive, in the Transcript of Record of the cause brought from the U. S. Circuit Court of Appeals for the Second Circuit (No. 339 above),—the only difference being that in the Transcript of the Third Circuit cause the papers are entitled in the Circuit Court for the District of New Jersey, while in the Transcript of the
151 Second Circuit cause they are entitled in the Circuit Court for the Southern District of New York; and were taken before another Examiner; therefore, the Court consenting, it is stipulated that the Clerk of the Supreme Court, in preparing copies of the Transcript of the Third Circuit cause (No. 149 above), may omit from said Transcript printed pages 27-112, inclusive, and insert in place thereof a statement containing the substance of the foregoing stipulation.

The Court consenting, it is further stipulated that when cause No. 149 is reached for hearing, cause No. 339 may be argued therewith or immediately thereafter, as the Court shall elect.

Dated, New York City, July 6th, 1908.

PHILIP MAURO,
Attorney for Rumford Chemical Works.
WILLARD PARKER BUTLER,
Attorney for Hygienic Chemical Companies.

152 [Endorsed:] 149 20815 Supreme Court of the United States. Rumford Chemical Works, Petitioner (Complainant-Appellant), *vs.* Hygienic Chemical Company, Respondent (Defendant-Appellee). Hygienic Chemical Company *et al.*, Petitioner (De-

fendants-Appellees), *vs.* Rumford Chemical Works, Respondent (Complainant-Appellant). Stipulation. Philip Mauro, Attorney for Rumford Chemical Works.

153 [Endorsed:] File Nos. 20,815, 21,102. Supreme Court U. S., October Term, 1908. Term Nos. 149 & 339. Rumford Chemical Works, Petitioner, *vs.* Hygienic Chemical Company and Hygienic Chemical Company, Petitioner, *vs.* Rumford Chemical Works. Stipulation as to printing records and that cases be heard together. Filed July 11, 1908.

(21,102)

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1908.

No. 339.

HYGIENIC CHEMICAL COMPANY OF NEW YORK, JAMES E. HELLER, AND ADOLPH HIRSH, PETITIONERS,

vs.

RUMFORD CHEMICAL WORKS.

ON WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

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a United States Circuit Court of Appeals for the Second Circuit.

THE RUMFORD CHEMICAL WORKS, Complainant-Appellant,
vs.
THE HYGIENIC CHEMICAL COMPANY ET AL., Defendants-Appellees.

Transcript of Record.

Appeal from the Circuit Court of the United States for the Southern District of New York.

Printed under the Direction of the Clerk.

A copy of the within paper has been this day received at this office. Sep. 26, 1907.

WHITRIDGE, BUTLER & RICK.

1 In the Circuit Court of the United States for the Southern District of New York. In Equity.

RUMFORD CHEMICAL WORKS, Complainant,
vs.
HYGIENIC CHEMICAL COMPANY (OF NEW YORK), HYGIENIC CHEMICAL COMPANY (OF NEW JERSEY), JAMES E. HELLER, and ADOLPH HIRSH, Defendants.

Bill of Complaint.

To the Honorable the Judges of the Circuit Court of the United States for the Southern District of New York:

The Rumford Chemical Works, a corporation duly created and existing under and by authority of the laws of the State of Rhode Island, and having its principal office and place of business at the City of Providence in said State, brings this its Bill of Complaint against the Hygienic Chemical Company, a corporation of the State of New York, and Hygienic Chemical Company, a corporation of the State of New Jersey, having a regular and established place of business within the Southern District of New York and an authorized agent within said District, to wit: The above mentioned Hygienic Chemical Company (the New York corporation),
2 James E. Heller and Adolph Hirsh individually and as officers of the two corporations above mentioned and as members of the firm of Heller, Hirsh & Co., the said individuals residing within the Southern District of New York and having a regular and established place of business in said place, and thereupon your orator complains and says:

1. That Charles A. Catlin, at that time a resident of the City of Providence, State of Rhode Island, was the original, first and sole inventor of certain new and useful improvements in baking pow-

ders which were not known or used by others in this country before his invention thereof, and not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof, and not in public use or on sale in the United States for more than two years prior to his application for Letters-patent therefor, and which had not been abandoned.

2. That thereafter on the 12th day of October, 1891, the said Charles A. Catlin made application in due form of law for letters-patent of the United States for said invention, and then and there fully complied in all respects with the provisions and requirements of the laws of the United States in such case made and provided; and that by an instrument in writing, dated October 14, 1891, and duly executed and delivered, and recorded in the United States Patent Office on October 16, 1891, said Charles A. Catlin assigned and conveyed to your orator the entire right, title and interest in and to said invention, and in and to the letters-patent of the United States to be issued therefor; that thereupon, due proceedings being had upon said application, letters-patent of the United States, in due form of law, were issued and delivered to your orator, the Rumford Chemical Works, in the name of the United States of America,
3 under the seal of the Patent Office, and signed and countersigned respectively by the proper officers of the United States, number 474,811, and dated May 17, 1892; and that said letters-patent did grant to your orator, the Rumford Chemical Works, its successors or assigns, for the term of seventeen years from the said 17th day of May, 1892, the exclusive right and liberty to make, use and vend the said invention or discovery throughout the United States and the territories thereof, as by reference to said letters-patent or a duly authenticated copy thereof, here in Court to be produced, will more fully appear.

3. Your orator further shows, that by virtue of the premises it became, has been, now is, and was at the time of the acts herein complained of, the sole and exclusive owner of the said letters-patent and the invention or improvements described therein, and all of the rights and privileges granted and secured, or intended to be granted and secured thereby; and that your orator has been and is, save for the doings of said defendants and others acting in concert with them, in the exclusive possession of said rights and privileges, and is entitled to the exclusive use, benefits and advantages of the said invention and improvements, and to sue for the recovery in its own name for the infringement and violation thereof.

4. Your orator further shows that the said invention is of great value and benefit to it, and of great value and use to the public, and that your orator has been to great expense and trouble in preparing for the manufacture of, in manufacturing, in placing upon the market and introducing into use, and making profitable to itself, baking preparations manufactured in accordance with and embodying the invention set forth in the said letters-patent that the baking preparations so made and introduced and embodying said invention have attained a general and wide-spread popularity and are universally recognized as possessing superior qualities; that

a large demand has been created for the same, which de-
4 mand your orator is ready, able and willing to supply; that your orator has built up and established a large, profitable business in said baking preparations, and has filled, is now filling and is about to fill many hundreds of orders for the same; that the public generally and manufacturers and dealers in all parts of the United States have recognized and acquiesced in the exclusive rights of your orator as aforesaid, and that, but for the infringement and wrongs herein complained of, your orator would now be in peaceful possession and enjoyment of all the rights and privileges granted under said letters-patent and invention, and of the income derivable therefrom.

5. And your orator further shows, upon information and belief, that the defendants, and each of them, and others acting in conjunction with them, well knowing the premises, have jointly since the grant of said letters-patent, within the said Southern District of New York and elsewhere in the United States, wrongfully and unlawfully, and wilfully contriving to injure your orator and to deprive it of the just profits resulting from said invention, which profits would otherwise accrue to your orator by reason of said invention and letters-patent, and without the license or consent of your orator, made and used and vended, and have caused to be made and used and vended, baking powder substantially as described in said letters-patent numbered 474,811, and embodying the invention therein set forth, and that the defendants and each of them still continue jointly so to do, and threaten to continue the aforesaid unlawful acts to a large extent, all in defiance of the rights acquired by and secured to your orator as aforesaid, and to its great and irreparable loss and injury, by reason of which your orator has been and still is being deprived of large gains and profits which it would otherwise obtain; and your orator further shows that the defendants, and each of them, have or has derived and received, and still are deriving and receiving, large gains and profits by reason of said unlawful acts, but to what extent your orator is ignorant and cannot set forth and therefore prays a discovery thereof.

5 6. And your orator further shows, on information and belief, that your orator, and all persons making, under authority of your orator, baking powder embodying or made in accordance with the invention described and claimed in the letters-patent aforesaid, have given notice to the public that the same is patented, and have affixed thereto, or to packages or receptacles containing the same, the word "patented," together with the day and year said patent was granted.

7. Your orator further shows that on or about June 13, 1900, it brought its bill of complaint in this Court against the New York Baking Powder Company *et al.* charging infringement of the said Catlin patent here in suit, the said cause being docketed as number 7532; that thereafter, the defendants having duly appeared and filed their answer, voluminous testimony was taken on each side at great expense, and the cause came on to final hearing on full proofs before his Honor Judge Lacombe; that thereafter, the Circuit Court

holding the patent in suit invalid, an appeal was taken to the United States Circuit Court of Appeals for the Second Circuit; and that, on or about July 7, 1904, an opinion was handed down sustaining the validity of the said Catlin patent here in suit and your orator's title thereto, adjudicating that the said patent had been infringed by the said New York Baking Powder Company, and awarding an injunction and an accounting, as by reference to the said opinion here in Court to be produced, will more fully appear.

8. That these defendants and each of them participated in the defense of the above mentioned suit against the New York Baking Powder Company, both financially and otherwise, and were themselves engaged at that time and subsequently in manufacturing and selling Granular Acid Phosphate like or substantially like the article put out by the said New York Baking Powder Company and held by the Court of Appeals to be an infringement of the Catlin patent in suit.

6 And forasmuch as your orator can have no relief save in this Honorable Court, your orator prays as follows:

1. That the defendants and each of them, their associates, attorneys, servants, clerks, agents and workmen, may be perpetually enjoined and restrained by writ of injunction issuing out of and under the seal of this Honorable Court, from directly or indirectly making or causing to be made, using or causing to be used, selling or causing to be sold, baking preparation manufactured in accordance with or embodying the invention or improvements set forth in said letters-patent, or in any wise counterfeiting, imitating or simulating the said invention.

2. That your Honors will grant unto your orator a preliminary injunction issuing out of and under the seal of this Honorable Court, enjoining the said defendants, and each of them, their associates, attorneys, servants, clerks, agents, and workmen, to the same purport, tenor and effect as hereinbefore prayed for with regard to said perpetual injunction.

3. That said defendants, and each of them, may be required by a decree of this Honorable Court to account for and pay over to your orator such gains and profits as have accrued or arisen or been earned or received by said defendants and all of such gains and profits as would have accrued to your orator but for the unlawful doings of said defendants and the damages your orator has sustained thereby, and that on account of the willful nature of said infringement the damages be increased threefold.

4. That the defendants, and each of them, may be compelled, by the order of this Honorable Court, to deliver up to its judicial custody for destruction, in a manner to be provided for in

7 said order, all infringing articles in the possession of, or under the control of, said defendants.

5. That the defendants be decreed to pay the costs of this suit.

6. That your orator may have such other and further relief as the Equity of the case may require.

To the end that the said defendants, and each of them, may, if they can, show why your orator should not have the relief hereby prayed, and may full and direct answer make,—but not under oath,

answer under oath being expressly waived—according to the best and utmost of their knowledge, information, remembrance and belief, to the several matters hereinbefore averred and set forth, as fully and particularly as if the same were repeated paragraph by paragraph, and said defendants thereto severally and specifically interrogated, may it please your Honors to grant unto your orator a writ of *subpœna ad respondendum* issuing out of and under the seal of this Honorable Court, directed to the said defendants, the Hygienic Chemical Company (of New York), the Hygienic Chemical Company (of New Jersey), James E. Heller and Adolph Hirsh, commanding them to appear and make answer to this bill of complaint and to perform and abide by such order and decree as to this Court may seem just.

And your orator will ever pray.

RUMFORD CHEMICAL WORKS,
By NEWTON D. ARNOLD, *Treas.*
ELISHA K. CAMP,
Solicitor for Complainant, 277 Broadway, New York City.

PHILIP MAURO,
C. A. L. MASSIE,
Of Counsel for Complainant.

8 STATE OF NEW YORK, *County of New York, ss:*

Newton D. Arnold, being duly sworn, deposes and says: That he is the Treasurer of the Rumford Chemical Works, named as complainant in the foregoing bill, that he has read the same and knows the contents thereof, and that the same is true of his own knowledge, save of the matters therein stated to be alleged upon information and belief, and that as to those matters he believes it to be true.

(Signed) NEWTON D. ARNOLD.

Subscribed and sworn to before me this 29th day of July, 1904.

[SEAL.] (Signed) ELISHA K. CAMP,
Notary Public, New York County.

9 At a Stated Term of the Circuit Court of the United States for the Southern District of New York, held in the Court Rooms thereof in the Post-Office Building in the City of New York, in the State of New York, on the 26th day of October, 1904.

Present: Hon. E. Henry Lacombe, U. S. C. Judge.

In Equity. No. 8812.

RUMFORD CHEMICAL WORKS
vs.
HYGIENIC CHEMICAL COMPANY (OF NEW YORK), HYGIENIC CHEMICAL COMPANY (OF NEW JERSEY), JAMES E. HELLER, and ADOLPH HIRSH.

Order to Dismiss Bill of Complaint as Against One of the Defendants.

Upon the Bill of Complaint and the Plea to the jurisdiction filed herein on behalf of the Hygienic Chemical Company (of New Jersey), the solicitor for the said defendant consenting thereto, and upon motion of Elisha K. Camp, Esq., solicitor for complainant herein, it is

Ordered that the Bill of Complaint herein be and the same hereby is dismissed, with costs, as against the Hygienic Chemical Company (of New Jersey), without prejudice.

(Signed) E. H. LACOMBE, *U. S. C. J*

I hereby consent to the form of the foregoing order.

(Signed) FRITZ v. BRIESEN,
Solicitor for Defendant.

(Filed Oct. 26, 1904.)

10 Circuit Court of the United States for the Southern District of New York.

In Equity. No. 8812.

RUMFORD CHEMICAL WORKS, Complainant,
vs.
HYGIENIC CHEMICAL CO. (OF NEW YORK), Defendant.

Replication.

This repliant, saving and reserving to itself all and all manner of advantage of exception, which may be had and taken to the manifold errors, uncertainties, and insufficiencies of the Answer of the said defendant, for replication thereunto saith, that it doth and will aver, maintain, and prove its said bill to be true, certain and sufficient in the law to be answered unto by the said defendant, and that the Answer of the said defendant is very uncertain, evasive, and insufficient in law to be replied unto by this repliant; without this, that any other matter or thing in the said Answer contained, material or effectual in the law to be replied unto and not herein and hereby well and sufficiently replied unto, confessed or avoided, traversed or denied, is true: all which matters and things this repliant is ready to aver, maintain, and prove as this Honorable Court shall

direct, and humbly prays as in and by its said bill it hath already prayed.

(Sgd.) ELISHA K. CAMP,
Solicitor for Complainant, 277 Broadway, New York City.

Dated November 7, 1904.

11 Circuit Court of the United States for the Southern District of New York.

In Equity. No. 8812.

RUMFORD CHEMICAL WORKS, Complainant,
vs.
ADOLPH HIRSH, Defendant.

Replication.

This repliant, saving and reserving to itself all and all manner of advantage of exception, which may be had and taken to the manifold errors, uncertainties, and insufficiencies of the Answer of the said defendant, for replication thereunto saith, that it doth and will aver, maintain, and prove its said bill to be true, certain and sufficient in the law to be answered unto by the said defendant, and that the Answer of the said defendant is very uncertain, evasive, and insufficient in law to be re-lied unto by this repliant; without this, that any other matter or thing in the said Answer contained, material or effectual in the law to be replied unto and not herein and hereby well and sufficiently replied unto, confessed or avoided, traversed or denied, is true: all which matters and things this repliant is ready to aver, maintain, and prove as this Honorable Court shall direct, and humbly prays as in and by its said bill it hath already prayed.

(Sgd.) ELISHA K. CAMP,
Solicitor for Complainant, 277 Broadway, New York City.

Dated November 7, 1904.

[NOTE.—For replication as to defendant Heller, see Stipulation of April 16, 1906, in Defendants' Record.]

12 In the Circuit Court of the United States for the Southern District of New York.

In Equity. Docket No. 8812.

RUMFORD CHEMICAL WORKS
vs.
HYGIENIC CHEMICAL CO. (OF NEW YORK) ET AL.

Please Take Notice that we shall proceed to take proofs for final hearing on the part of complainant under the 67th Rule of the Supreme Court for Courts of Equity, as amended, and in accordance

with the Statutes in such cases made and provided, and in pursuance of the rules and practice of this Court, before John A. Shields, Esq., an Examiner of this Court, under said Statutes and Rules, at the office of Mauro, Cameron, Lewis & Massie, No. 90 West Broadway, Borough of Manhattan and City of New York, on the 21st day of July, 1905, at 11 o'clock in the forenoon.

We desire the evidence to be adduced in this cause to be taken orally.

You are invited to attend and cross-examine the witnesses produced. The examination will be adjourned to such time and place as may be required, without further notice.

You are hereby called upon to produce Walter Ernest Wad-
13 man, of Bayonne, New Jersey, as a witness for complainant in the above-entitled cause, to be examined at the time and place above indicated.

Dated New York City, July 18, 1905.

Respectfully,

(Sgd.) C. A. L. MASSIE.
Of Counsel for Complainant.

To Messrs. Briesen & Knauth, Solicitors for Defendants, 49 Wall Street, New York City.

Service of a copy of the within notice is hereby admitted.
Dated July 18, 1905.

(Signed) BRIESEN & KNAUTH.

14 In the Circuit Court of the United States for the Southern District of New York.

In Equity. (Suit on Catlin Patent.) No. 8812.

RUMFORD CHEMICAL WORKS
vs.
HYGIENIC CHEMICAL COMPANY (OF NEW YORK) ET AL.

Complainant's Prima Facie Proofs.

90 WEST BROADWAY,
NEW YORK CITY, *July* 21, 1905.

Complainant's *prima facie* proofs for final hearing, taken in accordance with notice and under and pursuant to the 67th rule of equity and the practice of this court, before John A. Shields, Esq., standing examiner, at the office of Mauro, Cameron, Lewis & Massie, No. 90 West Broadway, New York City.

Met pursuant to notice at 11:00 A. M.

Present: C. A. L. Massie, Esq., on behalf of complainant; Eugene Eble, Esq., on behalf of defendants.

15 *Stipulations.*

Upon request of complainant's counsel, and in view of the final decree in the Circuit Court of the United States for the Southern Dis-

trict of New York, in *Rumford Chemical Works vs. New York Baking Powder Co., et al.,* it is stipulated that complainant is a corporation as alleged in its bill.

Upon like request, it is stipulated that the Hygienic Chemical Co. (of New York) is a corporation of the State of New York, and that Hygienic Chemical Co. (of New Jersey) is a corporation of the State of New Jersey.

A printed Patent Office copy of the Catlin patent No. 474,811, dated May 17, 1892, is offered in evidence, as "Complainant's Exhibit, Patent in Suit"; and it is stipulated that the same (subject upon notice to corrections of errors, if any) may be used with like force and effect as the original patent. It is likewise stipulated that this agreement shall apply to all printed Patent Office copies of U. S. patents, and to blue-book copies of British patents.

It is further stipulated that complainant has complied with the statute in regard to marking its patented product with the proper patent notice.

By Mr. EBLE: Defendants' counsel are informed that Mr. Wadman is stricken with an attack of heat prostration and they are therefore compelled to request an adjournment of this examination.

By Mr. MASSIE: In February complainant had a subpœna served upon Mr. James E. Heller to give testimony in the suit against the Hygienic Chemical Co. (of N. Y.) *et al.,* and has been compelled to postpone his examination on account of Mr. Heller's sickness and absence; there have been subsequent delays due to attempts at negotiating either a settlement or stipulations as to what Mr. Heller would testify if examined. Complainant's counsel is at this moment
16 in receipt of a letter from Mr. N. D. Arnold, Treasurer and Manager of Complainant, inclosing a letter from Mr. Heller requesting further delay on account of Mr. Wadman's illness, and suggesting a settlement of the litigation.

Under all these circumstances, defendants' counsel is requested to ascertain and advise complainant's counsel as soon as possible of the name of some other person connected with the Hygienic Chemical Co. who is in a position to testify concerning the manufacture of the Hygienic "Special" phosphatic material, and the relation thereto of the two Hygienic Chemical Companies and of Messrs. James E. Heller and Adolph Hirsh. The object in making this request is that no further time may be lost in case the negotiation suggested to Mr. Arnold by Mr. Heller should come to nothing.

Adjourned subject to notice.

17 In the Circuit Court of the United States for the Southern District of New York.

In Equity. No. 8812.

RUMFORD CHEMICAL WORKS
vs.
HYGIENIC CHEMICAL CO. (OF N. Y.), JAMES E. HELLER, and ADOLPH HIRSH.

Please take notice that we shall proceed to take proofs for final hearing on the part of the Complainant under the 67th Rule of the Supreme Court for Courts of Equity, as amended, and in accordance with the Statutes in such cases made and provided, and in pursuance of the rules and practice of this Court, before John A. Shields, Esq., an Examiner of this Court, under said Statutes and Rules, at the office of Philip Mauro, Esq., No. 90 West Broadway, Borough of Manhattan, City of New York, on the 27th day of November, 1905, at eleven o'clock in the forenoon.

We desire the evidence to be adduced in this cause to be taken orally.

You are invited to attend and cross-examine the witnesses produced. The examination will be adjourned to such time and place as may be required, without further notice.

Dated New York City, November 21, 1905.

Very respectfully,
(S'g'd) ELISHA K. CAMP,
Solicitor for Complainant.

To Arthur von Briesen, Esq., Solicitor for Hygienic Chemical Co. (of N. Y);
To Hans von Briesen, Esq., Solicitor for Defendant Hirsh;
To Felix Jellenik, Esq., of Counsel for Defendants.

18 Due and timely service of a copy of this notice is hereby admitted.

Dated New York City, November 21, 1905.

____ ____,
Solicitor for Hygienic Chemical Co. (of New York);

____ ____,
Solicitor for Defendant Hirsh;

____ ____,
Of Counsel for Defendants.

In the Circuit Court of the United States for the Southern District of New York.

In Equity. No. 8812.

RUMFORD CHEMICAL WORKS
vs.
HYGIENIC CHEMICAL CO. (OF NEW YORK), JAMES E. HELLER and ADOLPH HIRSH.

Affidavit of Service.

STATE OF NEW YORK, *County of New York, ss:*

R. L. Scott, being duly sworn, deposes and says: that he is twenty-one years of age and upwards, and that he is employed in the office of Philip Mauro, Esq., of Counsel for Complainant herein. That on the 21st day of November, 1905, between the hours of 12 M.
19 and 1 P. M., at the office of Messrs. Briesen & Knauth, 49 Wall Street, New York City, he served the foregoing notice of taking testimony upon Arthur v. Briesen, Esq., Solicitor for Hygienic Chemical Co. (of New York) and Hans v. Briesen, Esq., Solicitor for the defendant Hirsh, by delivering to and leaving with the said Hans v. Briesen, personally, a true copy thereof.

Deponent further says that on the same day and between the same hours, at the office of Felix Jellenik, Esq., 15 William Street, New York City, he served the foregoing notice of taking testimony upon the said Felix Jellenik, of counsel for defendants, by delivering to and leaving with the person seemingly in charge of said office at the time a true copy thereof.

R. L. SCOTT.

Subscribed and sworn to before me this 27th day of November, 1905.

[SEAL.] (S'g'd) WILLIAM E. HILLS,
Notary Public, New York County.

20 NEW YORK CITY, *Nov.* 27, 1905.

Met pursuant to annexed notice.

Present: C. A. L. Massie, Esq., for Complainant; Felix Jellenik, Esq., for Defendants.

Complainant's counsel states that Mr. James E. Heller and Mr. Walter E. Wadman have been served with subpœnas requiring them to be present to-day, and produces the original subpœnas and requests the Examiner to note that these gentlemen have not appeared.

The Examiner so notes upon the record that the witnesses have not attended pursuant to the subpœnas duly issued.

Mr. Jellenik states that both the witnesses Heller and Wadman are sick at home and unable to attend and he therefore asks an adjournment until some reasonable date to be fixed by the Examiner.

Complainant's counsel states to the Examiner that in the case of

Rumford Chemical Works vs. Hygienic Co. et al. pending in New York, Mr. Heller was served with subpœna to appear and testify last March; and that Messrs. Briesen & Knauth, solicitors of record and at that time acting as counsel for defendants, reported that Mr. Heller was ill and leaving town for his health, but pending negotiations they agreed to produce Mr. Heller, when requested to do so, or (in case of his continued illness) to produce some other officer of the defendant corporation.

Last Summer complainant requested Messrs. Briesen & Knauth to produce Mr. Wadman; and at the first session herein, on July 21, 1905, Messrs. Briesen & Knauth's representative, Mr. Eble, stated that defendants' counsel were informed that Mr. Wadman was stricken with an attack of heat prostration, and an adjournment was thereupon requested and granted.

Subsequent negotiations looking toward a settlement having come to nothing, on last Monday, the 20th inst., Messrs. Heller and
21 Wadman were served with subpœnas, and the proof of service in each case shows that each gentleman was at that time at his regular place of business. Each witness was paid his witness fee and his mileage.

On Thursday, the 23rd inst., defendants' counsel requested an adjournment on other grounds but did not represent that either Mr. Heller or Mr. Wadman would be unable to attend.

On Saturday afternoon, the 25th inst., Mr. Heller requested an adjournment and then stated that he himself was not in good health and that Mr. Wadman was too ill to attend.

We felt it our duty to have an investigation made, and have received a report that on Saturday evening Mr. Heller attended a theatre and afterwards went to a restaurant with a party of friends remaining until midnight; and that on Sunday Mr. Wadman was seen standing bare-headed on his front porch.

For these reasons the Examiner is requested to appoint a physician of his own designation to call upon Mr. Heller and Mr. Wadman and report to the Examiner whether or not either of these gentlemen is able to attend at the next session, whose date the Examiner is requested to fix.

The Examiner being present, calls the witnesses James E. Heller and Walter E. Wadman and both men fail to respond.

Pending the Examiner's decision at the next session, Complainant's counsel offers in evidence *de bene esse* the depositions given by James E. Heller and Walter E. Wadman in the suit entitled *Rumford Chemical Works vs. New York Baking Powder Co. et al.*, the same being on file in the office of the Clerk of the Circuit Court of the United States for the Southern District of New York.

Defendants' counsel objects to the introduction of said evidence on the ground that it is immaterial, irrelevant and incompetent and further that the said witnesses are available for examination.

22 Complainant's counsel offers in evidence a sealed bottle containing a whitish substance, bearing a label pasted thereon reading "Rumford Chemical Works *v.* Hygienic Chem. Co. *et al.*, Catlin Exhibit Hygienic Special—William L. Sweet—Notary Pub-

lic," the same to be identified as "Complt's Exhibit, Catlin Exhibit, Hygienic Special." Complainant's counsel states that this is the sample Exhibit identified in Complainant's motion papers for preliminary injunction in the New York suit; and full proof of the identity will be made later.

Defendants' counsel objects to the admission of said Exhibit in evidence on the ground that it is immaterial and incompetent and not in any manner identified as affecting the defendants.

Adjourned by the Examiner to Wednesday, November 29, 1905, at 11 o'clock A. M.

23 In the Circuit Court of the United States for the Southern District of New York.

In Equity. No. 8812.

RUMFORD CHEMICAL WORKS
vs.
HYGIENIC CHEMICAL CO. (OF N. Y.), JAMES E. HELLER and ADOLPH HIRSH.

NEW YORK CITY, *Nov.* 29, 1905.

Met pursuant to adjournment and agreement at the office of John A. Shields, Esq., Examiner, in the Post-Office Building.

Present: John A. Shields, Esq., Examiner; C. A. L. Massie, Esq., Counsel for Complainant; and James E. Heller, the witness.

Mr. Heller states that he is willing to be sworn in the absence of his counsel. Thereupon JAMES E. HELLER, a witness appearing in response to a subpœna, on behalf of the complainant is duly sworn as follows:

By the EXAMINER: Do you solemnly swear that the evidence you give in this suit, Rumford Chemical Works *vs.* Hygienic Chemical Co. *et al*, will be the truth, the whole truth, and nothing but the truth, so help you God?

By Mr. HELLER: I do.

Complainant's counsel states that he has received a telephone communication from Mr. Willard Parker Butler stating that
24 the latter gentleman is retained or about to be retained by the defendants, and therefore requests an adjournment with a view of becoming more familiar with the matters in controversy, and in order to effectuate a settlement out of Court, if possible.

Adjourned to Wednesday, December 6, 1905, at 11 o'clock A. M., at the office of Philip Mauro, Esq., 90 West Broadway, New York City.

NEW YORK CITY, *Dec.* 6, 1905—11 a. m.

Met pursuant to adjournment.

Present: C. A. L. Massie, Esq., of Counsel for Complainant; No appearance for Defendants.

Mr. Massie states that he has been in consultation with Willard Parker Butler, Esq., who stated that he had been consulted by de-

fendants and had given them advice, but was not certain whether he would appear in the case as of counsel. On the occasion of Mr. Butler's visit to this office, December 4, 1905, he was advised that complainant's counsel had a number of cases in Court and might possibly not be able to proceed with to-day's session, but defendants' counsel would be notified in case there would be no session. This morning we telephoned to remind Mr. Butler and Mr. Jellenik that we would proceed at eleven o'clock in pursuance of the adjournment. We have been notified by telephone that Mr. Jellenik is attending in a case in Hackensack, N. J., and that Mr. Butler had supposed there would be no session to-day and had not yet committed himself as counsel for the defendants. Mr. Butler agreed to notify us this afternoon whether or not he will appear in the case as counsel for defendants.

25 Complainant's counsel states that Mr. Heller, a witness already sworn, has not been notified by us not to appear this morning; but in the absence of any counsel for defendants, we will not at this time take any steps to enforce his attendance.

Adjourned to this afternoon in order to consult the convenience of counsel for the defense in fixing the date for the next session.

SAME DATE, 4:30 p. m.

Mr. Massie states that Mr. Butler has advised him over the telephone that he will appear in the case as counsel for the defense, and that he consents to an adjournment to next Saturday.

Adjourned to Saturday morning, December 9, 1905, at 11 o'clock, at this office.

NEW YORK CITY, *Dec.* 9, 1905—11 a. m.

Met pursuant to adjournment.

Present: C. A. L. Massie, Esq., for Complainant; Willard Parker Butler, Esq., and John French, Esq., for Defendants.

In answer to questions by Mr. Massie, Mr. JAMES E. HELLER, the witness already sworn, testifies as follows:

Q. 1. Please state your name, age, residence and occupation?

A. James E. Heller; age, 64; residence, 108 West 75th St.; occupation, merchant.

26 Q. 2. Are you a member of the firm of Heller, Hirsh & Co.; and, if so, for how long?

Objected to as immaterial and irrelevant on the ground that it does not appear that the firm of Heller, Hirsh & Co., as such, is a party to the action.

A. Yes, since 1879.

Q. 3. What has been the general nature of the business of Heller, Hirsh & Co.?

Same objection.

A. They are brokers and commission merchants in fertilizing material.

Q. 4. That includes acid phosphates, does it not?

Same objection.

A. No, sir.

Q. 5. Acid phosphates are not employed in fertilizing materials, is that it?

A. Acid phosphate manufactured by the fertilizer manufacturers in the country is a material made from phosphate rock dissolved by sulphuric acid and could be used for fertilizer only. We were not selling acid phosphate but other fertilizer material used by the manufacturers.

Q. 6. Are you connected with the Hygienic Chemical Company or any concern of that name?

A. Yes, I am president of the Hygienic Chemical Co. of New York.

Q. 7. How long have you been connected with that concern?

A. Since its incorporation, I don't remember what date that was.

Q. 8. Are you connected with the Hygienic Chemical Co., the New Jersey concern; and, if so, for how long?

27 A. Yes, since its incorporation, I don't remember the date.

Q. 9. Who else beside yourself compose the firm of Heller, Hirsh & Co.?

Same objection.

A. Mr. Adolph Hirsh, Mr. Joseph H. Schmaltz, Mr. Samuel A. Tuska.

Q. 10. Was there any member of the firm besides yourself and Mr. Hirsh at the time the Hygienic Chemical Company, of New Jersey or of the same name of New York, was created?

Same objection.

A. No.

Q. 11. Is it the fact that you and Mr. Hirsh own practically all the capital stock of the two Hygienic Chemical Companies?

Objected to as immaterial and irrelevant.

A. It is not a fact, it is not so.

Q. 16. What is the relation, if any, between the Hygienic Chemical Company of New Jersey and the Hygienic Chemical Company of New York; that is, now do these two Companies do business?

Objected to as immaterial and irrelevant for the reason that only one of the Companies to each of the two actions; in other words, the New Jersey Company is not a party to the action pending in the Southern District of New York and the New York Company is not a party to the action pending in the District of New Jersey.

A. The Hygienic Chemical Company of New York sell the product of the Hygienic Chemical Company of New Jersey.

28 Q. 13. Is the product of the Hygienic Chemical Company of New Jersey handled only by the New York Corporation;

and does the New York concern do nothing except handle the product of the New Jersey Company?

Same objection and the further objection that the business of the New York Company is not a proper subject of inquiry in this action and it is therefore immaterial and irrelevant.

A. As to that, I can't answer exactly, although I am sure that most of the product of the Hygienic Chemical Company of New Jersey is sold by the Hygienic Chemical Company of New York, but the Hygienic Chemical Company of New York sells merchandise for other parties besides the Hygienic Chemical Company of New Jersey, and also buys and sells from other parties, and selling on commission for other parties, besides buying direct from other parties.

Q. 14. The New Jersey concern manufactures, or did manufacture, acid phosphates and the New York concern sold them as agent for the New Jersey concern?

Objected to on the ground that it is leading, and second on the gorund that it calls for a conclusion of law.

By Mr. MASSIE: Question temporarily withdrawn.

Q. 15. You are the James E. Heller named as a defendant in the New York suit, are you not?

A. I don't know exactly whether I am or not, although I was served in that suit. I am the only James E. Heller connected with the defendant company.

Q. 16. What is the capital stock or the number of shares in the Hygienic Chemical Company of New Jersey, and the same as to the New York Hygienic Chemical Company?

29 Counsel for the defendants states upon the record that he was not aware this morning of the precise line of inquiry which complainant's counsel desired to elicit from this witness, and hence has had no opportunity of conferring with the defendant company or its officers on this subject. He suggests that the answer to this question be postponed with a view to the possibility of stipulating as to the line of inquiry suggested by this question.

Counsel for complainant states that, in view of the foregoing, the question is temporarily withdrawn.

Q. 17. Who manages the Hygienic Chemical Company of New Jersey?

A. Mr. W. E. Wadman.

Q. 18. Who instructs him what to do?

A. No one.

Q. 19. Is he empowered to make alterations in the manner of conducting the business, or to make changes in the machinery employed, or to purchase new machinery, without consulting any one else?

A. He is authorized to do so, but frequently consults me.

Q. 20. If Mr. Wadman should desire to throw out all the machinery now in the plant and purchase entirely new machinery, could

he do so without obtaining permission from you or from some one else?

Objected to as immaterial and irrelevant.

A. He could do so, but he would not.

Q. 21. Who would he consult, or whose permission would he obtain?

Same objection.

A. He might consult me or Mr. Hirsh or would ask the directors to decide.

30 Q. 22. Who are the directors of the New Jersey Hygienic Chemical Company?

Counsel for defendant suggests that this question be also postponed pending a possible stipulation as to the facts. Question accordingly withdrawn.

Q. 23. Who employs Mr. Wadman?

A. The Hygienic Chemical Company of New Jersey.

Q. 24. Who created the Hygienic Chemical Company of New Jersey?

Objected to as immaterial and irrelevant, as not the best evidence as to the facts sought to be elicited. As the names of the persons who created the Company should appear from its certificate of incorporation.

By Mr. MASSIE: The question is not for the names of the incorporators, but asks who created the Company; that is, what persons or what interests caused the Company to be incorporated.

A. The interests that James E. Heller and other parties had in the property upon which this Hygienic Chemical Company of New Jersey's factory was built.

Q. 25. I will ask you the same question as to the Hygienic Chemical company of New York?

Same objection.

A. The Hygienic Company of New Jersey.

Q. 26. The Hygienic Chemical Company of New Jersey continues practically to own and control the New York Company?

A. It does not. It does not own or control a single share of it.

Q. 27. What proportion of the capital shares of the Hygienic Chemical Company of New Jersey do you and Mr. Hirsh own?

31 Objected to in so far as it is deemed to be a question asked in the action pending in the District of New Jersey on the ground that it is immaterial and irrelevant, for the reason that Mr. Heller and Mr. Hirsh are not parties to the New Jersey action.

A. I could not tell you now, I would have to examine into it. I do not know by heart.

Complainant's counsel requests this information for a later session, and likewise as to the proportion of the capital stock of the Hygienic Chemical Company of New York, owned or controlled by the witness

and Mr. Adolph Hirsh. Counsel for defendants states that he will endeavor to supply these facts at the next hearing, subject to any objections he may desire to make as to their admissibility.

Q. 28. Does the Hygienic Chemical Company of New Jersey pay regular dividends to its shareholders?

Objected to as immaterial and irrelevant.

A. It never paid a dollar since its existence.

Q. 29. Has the Hygienic Chemical Company of New Jersey ever earned anything?

Same objection.

A. Never earned a dollar.

Q. 30. What was done with any monies received by the Hygienic Chemical Company of New Jersey?

Same objection.

A. They paid their debts.

Q. 31. Has the Hygienic Chemical Company of New Jersey been run at a loss ever since its organization?

Same objection.

32 A. As to that I cannot say by heart, but I know they did not make any money since they were in business.

Q. 32. Has the Hygienic Chemical Company of New Jersey always, during every year since its creation, received sufficient monies from the sale of its products to pay all its debts?

Same objection.

A. I cannot remember whether every year they had sufficient money to pay their debts, but I believe they ran into debt some years.

Q. 33. Has the Hygienic Chemical Company of New York always paid regular dividends to its shareholders?

Same objection.

A. It never paid one single dollar.

Q. 34. What was done with the monies received by the Hygienic Chemical Company of New York?

Objected to as immaterial and irrelevant.

A. They paid it to the parties who were entitled to it.

Q. 35. Is practically the greater part of the business done by the Hygienic Chemical Company of New York in the nature of a commission business?

Same objection.

A. Yes, sir.

Q. 36. What was done with the commissions retained or received by the Hygienic Chemical Company of New York?

Same objection.

A. They paid their expenses and clerk hire and rent.

33 Q. 37. And there was nothing left over after paying the indebtedness?

A. Very little.

Q. 38. Have the commissions or other earnings received from time to time by the Hygienic Chemical Company of New York always been sufficient to pay its indebtedness from time to time?

Same objection.

A. As near as I can remember, just about sufficient.

Q. 39. Have you received any salary or other compensation from the Hygienic Chemical Company of New Jersey?

Same objection.

A. Never one cent since its existence.

Q. 40. Same question as to Mr. Adolph Hirsh?

Objected to as immaterial and irrelevant and not the best evidence.

A. Never one cent since its existence.

Q. 41. Have you ever received any salary or any compensation from the Hygienic Chemical Company of New York?

Same objection.

A. Never one cent since its existence.

Q. 42. Same question as to Mr. Hirsh?

Same objection.

A. Same answer.

Q. 43. Has the Hygienic Chemical Company of New Jersey or the Hygienic Chemical Company of New York ever had any surplus over and above its current indebtedness?

Same objection.

34 A. I regret that I can not answer just now as I do not know by heart whether they did have a surplus or not at any year since their existence.

Q. 44. Are you willing to assert that always for every year since its existence each Company has had a substantial surplus or any surplus over its current indebtedness?

Same objection.

A. No, there was not every year, and if there was any it was not substantial.

Adjourned to Tuesday, December 19th, 1905, at 10:30, at same place.

NEW YORK, *December* 19, 1906.

Met pursuant to adjournment.
Present: Parties as before.

Examination of Mr. HELLER continued:

Q. 45. Do you know about when the Hygienic Chemical Company of New Jersey commenced the manufacture of an acid phosphate designated as the special brand?

That is objected to so far as it is asked in the New York action as immaterial and irrelevant.

A. I don't remember.
Q. 46. Do you know that that company did put out such a brand in question?

Same objection.

A. Yes, I do.
35 Q. 47. Were you familiar with the appearance of that article?

Same objection.

A. Yes, I was to some extent.
Q. 48. I show you the sealed bottle identified as Complainant's Exhibit, Catlin Exhibit Hygienic Special, and ask if according to your recollection this resembles the article put out by the Hygienic Chemical Company of New Jersey?

Question objected to as indefinite, and assuming that the specimen has been identified as indicated in the question and in so far as the question relates to matters in the New York action it is immaterial and irrelevant.

A. It seems to me that this is nothing like the material that has been put out by the Hygienic Chemical Company of New Jersey, as that product contained a very large percentage of extremely fine material which seems to have been screened out of this sample.
Q. 49. Does this sample just shown you resemble, according to your present recollection, any product put out by the Hygienic Chemical Company of New Jersey, whether the same was designated "Special" or not?

Mr. BUTLER: I renew last objections to previous question.

A. It does not resemble any of the product manufactured by the Hygienic Chemical Company of New Jersey, to my best recollection, as all of the product made by them, as near as I can remember, contained very large percentage of extremely fine material.
Q. 50. The product likewise contained a considerable amount of granular material, did it not?
A. I could not judge, because I do not know what you consider granular material.
36 Q. 51. In answer to Q. 49 you said the products as near as you could remember contained a very large percentage

of extremely fine material. What was the rest of the stuff that was not extremely fine material?

A. Somewhat coarser.

Q. 52. Why was it made somewhat coarser; why was it not all made extremely fine?

A. I can't answer that, because I don't remember now why.

Q. 53. Are you the James E. Heller who gave testimony for the defense in a suit in the Circuit Court of the United States for the Southern District of New York, entitled "The Rumford Chemical Works against the New York Baking Powder Co., *et al.*"?

Objected to as immaterial and irrelevant.

A. Yes, sir.

Q. 54. I produce a copy of the transcript of record printed under the direction of the Clerk of the United States Circuit Court of Appeals for the Second Circuit, and show you on page 1142 thereof the following questions and answers:

"Q. 2. Where is the Hygienic Chemical Company located? A. At Elizabethport, New Jersey.

Q. 3. What does it manufacture? A. It manufactures acid phosphate.

Q. 4. For baking powder purposes? A. For baking powder and other purposes."

Are these answers true?

A. Certainly.

Q. 55. On the next page (1143) occur the following questions and answers:

"Q. 7. Are you interested in this suit? If so, in what manner?
A. We are manufacturers of granulated acid phosphate and
37 are selling it to the trade in the same way as the parties who are sued in this case, the Provident Chemical Works of St. Louis.

Q. 8. Have you undertaken to assist in bearing the burdens of this defense? A. We have, most surely.

Q. 9. Contributing to the defense financially and otherwise? A. We have financially and otherwise."

Are these answers true?

A. I cannot answer these questions all in one, as I have to answer each separately. In answering question 7 I desire to say what I said then, that the Hygienic Chemical Company of New Jersey were manufacturing an acid phosphate which contained a large percentage of very fine powdered material, and some percentage of coarser material which I then designated as granulated acid phosphate, because as I understood it then and understand it now granulated means to have been ground, and in grinding some of it is extremely fine and some of it coarser.

In reply to question 8 the Hygienic Chemical Company of New York assisted in the burden of the defense.

To question 9, the same answer.

Q. 56. Were any experiments or tests made at the establishment of the Hygienic Chemical Company of New Jersey, for the purpose

of assisting in the defense of the suit against the New York Baking Powder Co., *et al.*?

Objected to as immaterial and irrelevant.

A. I do not remember at this moment whether there had been.

Q. 57. Do you remember whether or not the Hygienic Chemical Company of New Jersey contributed to the defense of the suit against the New York Baking Powder Co., *et al.*, either financially or otherwise?

38 A. As near as I remember, I dont' think they did financially, and I don't remember whether they did otherwise.

It is noted that the first date earlier than the testimony just referred to is found on page 1132, which notes that the session was held on May 28, 1901, and that the questions quoted appear to have been asked on that date.

Q. 58. At a session which appears to have been on the next day, (May 29, 1901), complainant's counsel in that case referred to a series of letters dated from April 30, 1898, to June 13, 1899, (X Q. 162); and then occurs the following cross question and answer:

"X Q. 169. Were you during that period manufacturing granular acid phosphates, such as you are making today for baking powder purposes? A. Yes, sir."

Is this answer correct?

A. I do not remember this moment just what my answer was, but as I have explained before, I have reference now to granulated acid phosphate.

Q. 59. What is the object in having the acid phosphate, or any portion of it, "granulated"?

A. As near as I can remember, it had to be granulated before it could be used for baking powder.

Q. 60. Then the purpose in making it "granulated" was so as to adapt it for use in baking preparations?

A. Yes, that we have done since 1886.

Q. 61. Who did this in 1886, the Hygienic Chemical Company of New Jersey, or Heller, Hirsh & Company?

A. To my best recollection it was the Hygienic Chemical Company of West Virginia.

Q. 62. That same concern was subsequently reincorporated under the laws of New Jersey, was it not?

A. Yes, sir.

39 Q. 63. During that same session (which appears to be May 29, 1901), on pages 1176-7, occur the following cross question and answer:

"Re-X Q. 244. One of the witnesses, I think the chemist of the Hygienic Company, as I recollect his testimony, said that he kept closely informed as to what the Rumford Chemical Works were doing, by examination of their powders. Was that by your direction, if it was a fact? A. It might have been to some extent, but the superintendent of the factory had made it his business for years to have all the baking powders that he knows of or hears of that come

in competition with the baking powders manufactured by our customers, under his observation."

Is this answer correct?

A. As near as I can remember, yes.

Q. 64. Is it the fact that during the year 1898 and down to date, the Hygienic Chemical Company of New York has sold all the output of the Hygienic Chemical Company of New Jersey?

A. I can't remember as to the date you mention, nor can I say that they sell all because it may be the Hygienic Chemical Company of New Jersey may sell some of their product direct.

Q. 65. The bulk of the product of the New Jersey Company, however, is sold by the New York Company, is it not?

A. Yes.

Q. 66. And this applies to the acid phosphate some of which was "granulated," as that term has been explained by you?

A. Yes.

Q. 67. On page 1466 of the transcript of the suit against the New York Baking Powder Co. is a photolithographic reproduction of a bill upon a bill head purporting to be that of Hygienic
40 Chemical Co.; and on page 1467 of the same is a similar reproduction of what purports to be a receipt by the Hygienic Chemical Co. Please examine these two reproductions and state whether they appear to you to be fac-similes of genuine papers.

A. It is hard for me to tell.

Complainant's counsel states that due proof of the bill and receipt will be produced later.

Q. 68. Assuming for the present that these two pages now shown you are fac-similes of two genuine documents put out by the party or parties whose name appears thereon, please state whether the two show a direct sale by the New Jersey Company; or if not, what is the nature of the transaction?

Objected to in so far as it seeks to prove the contents of the written instruments as improper and incompetent, and it is further objected to on the ground the instruments themselves are the best evidence of what they are to show.

A. As near as I can see now there isn't anything on the two instruments which would lead me to know whether it was from the Hygienic Chemical Company of New York or the Hygienic Chemical Company of New Jersey.

Q. 69. Has the Hygienic Chemical Company of New Jersey at this time an office in New York City?

A. They have not.

Q. 70. When did the New Jersey Company cease to have an office in New York City?

A. I cannot remember at this moment.

Q. —. Was it about the time the New York Corporation was created?

A. I don't remember whether it was then or later.

Q. 71. In answer to direct question 16 in the same suit against

the New York Baking Powder Co. *et al.*, (page 1144 of the
41 transcript on appeal), you say that the manufacture of the acid phosphate was originally carried on by Heller, Hirsh & Company in their own name, as they then owned the property as well as the factory now owned by the Hygienic Chemical Co. Is that true?

A. That is true as to the time before the Hygienic Chemical Company of West Virginia was formed?

Q. 72. In answer to Q. 31, (page 1147 of transcript on appeal) and referring to entries in 1888 and 1889, you say:

"Q. 31. And who are H. H. & Co. mentioned in the entries? A. Heller, Hirsh & Co. as outside any interest in the chemical works, to keep it separate from the chemical works. It was entered up to Heller, Hirsh & Co., whenever any goods were shipped to them, and which they sold to baking powder manufacturers and accounted for it as sellers to the chemical works at Elizabethport."

Is that answer true?

A. Yes, that is true.

Q. 73. Is that course of business still carried on?

A. No, sir; not since the Hygienic Chemical Company of West Virginia was formed.

Q. 74. Upon the formation of the Hygienic Chemical Company of West Virginia, what was the course of business?

A. The Hygienic Chemical Company of West Virginia did all the business; Heller, Hirsh & Co. did none.

Q. 75. I call your attention to your answer to Q. 41 in the same transcript, Q. 42, also the next page, Q. 68, X-Q. 125, also answers on page 1170-1, to Re-D. Q. 202, pages 1173-4, Re-D. Q. 239, 242, and pages 1176-8. In view of these answers formerly given by you, is it not the fact that you had considerable familiarity with the conditions existing in the baking powder and baking preparation business, and were familiar with the demands of the trade,
42 and had the Hygienic Chemical Company manufacture products to satisfy the demands of the trade?

Objected to in so far as it relates to evidence given by the witness in another case, as improper, for the reason that the questions and answers composing such evidence are not embraced in the question.

In view of this objection, question temporarily withdrawn, and I read you from the record in the Rumford Chemical Works against the New York Baking Powder Co. as follows:

"Q. 34. Will you please read the entire letter into this record? A.—

"Hygienic Chemical Company, Manufacturers of Acid Phosphate for Baking Powder, &c.

NEW YORK, *February* 17, 1891.

W. E. Wadman, Esq., Supt. Hygienic Chemical Company.

DEAR SIR: I have mailed you to-day a sample of the Provt. Chemical Works C. A. P. The party claims it is finer bolted than ours,

Will order 5 barrels of us if we can turn it out as fine. As near as I can judge I think the sample is finer than our circle C and that it is more bulky and goes farther in filling his cans. It is therefore cheaper for him. Please write me fully about this sample and if you can bolt as fine or finer. How do you like the last circular? I have had some inquiries for it already. Herewith order No. 14 for 5 barrels circle W.

Yours truly,

N. WATERBURY,
Sole Agent."

43 Q. 41½. You can answer the question with reference to all these dates.

A. I then prefer to answer the question as to the dates of 1886, 1887, 1888 and 1889. At that time we had at first when we started a cloth through which was admitted a great deal of fine material and we had trouble in shipping the sample of the first goods sent to Stein, Hirsch & Co.; that the same caked in transit to such an extent that their customer said he couldn't use it if a great deal of fine pulverized material were contained in it, but if we would eliminate that, he could use large quantities of it. I then arranged at the factory with the then superintendent to rig up a screen over which this material, after going through the original silk cloth, was again screened and eliminated from it all of the extremely fine powder, which gave us a material free from powdered material, and that was shipped at that time to Chicago, and subsequent to which the users found it to give excellent satisfaction, and they used large quantities of it.

Q. 42. Now, if you will answer the same question with reference to 1891?

A. I believe I will not be able to answer that question as readily as the other, because Mr. Wadman, who was superintendent there at that time, had made arrangements for bolting and changed them to some extent. But I know that we were using coarser silks for the manufacture of our acid phosphate, or cream of tartar substitute, as we then called it, coarser cloths than we did subsequently.

Q. 68. Was it in 1886 a new thing to you to see granular goods in baking powder?

A. It was new as far as I could learn, because all of the other acid phosphates for baking powder purposes were finer than our goods.

X Q. 125. You supply the acid phosphate for the Egg
44 Baking Powder Company of New York?

A. We do.

X Q. 126. For the Adam Roth Grocery Company of St. Louis?

A. I don't remember at this moment.

X Q. 191. What kind of phosphates did Heller, Hirsch & Co. deal in prior to 1890, if you know?

A. Only such as were furnished by the Chemical Works at Elizabethport, N. J., of which they were proprietors.

X Q. 192. They handled no other kind of phosphates?

A. No; that is, no acid phosphates of the description made for baking powder purposes.

X Q. 193. You evidently did not clearly understand the question. I intended to ask with reference to phosphates generally for different purposes?

A. Oh, we handled all kinds of phosphates in enormous quantities for fertilizer purposes.

X Q. 194. Prior to 1890?

A. Yes, sir.

X Q. 195. Is the same true of Stein, Hirsch & Co.?

A. No, sir; that is not.

X Q. 196. They did not handle any for fertilizer purposes?

A. No, sir; not to my knowledge.

Re-D. Q. 202. A number of letters were shown you in one of the cross questions which were dated from some time in 1898 to some time in 1899. What general matter do those letters refer to?

A. They refer to interviews had with Mr. N. D. Arnold as the treasurer of the Rumford Chemical Works for the purpose of eliminating the destressed condition of the phosphate business in the United States, owing to the low price at which the goods were sold in the United States in comparison with the low cost and the advanced prices of materials used for the purpose of manufacturing acid phosphate for baking powders.

45 Re-D. Q. 216. Was the original of that letter of Slingluff received by you?

A. Yes, sir; I have the original.

Re-D. Q. 217. That letter reads as follows, does it not?

'BALTIMORE, *June* 8 (1898 Evidently).

Mr. James E. Heller, President Hygienic Chemical Co., 62 William Street, N. Y.

DEAR SIR: In reply to your communication we say the price of our goods is certainly too low, owing to the great advance in raw materials. Whether it would be good business to advance our prices now, owing to the great competition of alum goods is a hard question to answer.

However, we are not desirous of stopping any effort to get a profit from our business.

We would be glad to entertain a proposition from you looking to an honorable and just arrangement to advance all our interests.

Awaiting your favors we are very truly yours,

SLINGLUFF & CO.'

Is that the letter?

A. That is the letter.

Re-D. Q. 218. That is about the plan and the objections to the then existing conditions that you were trying to overcome?

A. Yes, sir.

Re-D. Q. 219. What is that reference to alum in the letter?

A. The reference to alum in the letter means that large quantities of alum baking powders were sold in the market at extremely low prices, for baking powders.

Re-D. Q. 223. Has that enforcement of that law had any effect upon the use of alum in baking powders generally in the country?

A. It has to a very large extent.

Re-D. Q. 224. Yet you say the alum in baking powders is still a formidable competitor with the acid phosphate?

46 A. It is in other States; it has a large output in the country.

Re-D. Q. 239. What did you know, if anything, about the form in which tartaric acid entered baking powder prior to 1889, we will say?

A. I knew that the material, tartaric acid, being a competitive material with our acid phosphate for the manufacture of baking powder, it was used in granular form and also what was called by them powder form, but which I know had very little very fine material in it, as I had frequently examined it myself.

Re-X Q. 244. One of the witnesses, I think the chemist of the Hygienic Company, as I recollect his testimony, said that he kept closely informed as to what the Rumford Chemical Works were doing, by examination of their powders. Was that by your direction, if it was a fact?

A. It might have been to some extent, but the superintendent of the factory had made it his business for years to have all the baking powders that he knows of or hears of that come in competition with the baking powders manufactured by our customers, under his observation.

By Mr. BRIESEN:

Re-D. Q. 249. Is it or was it true, in 1898, that the Rumford baking powder brought a higher price than that of any other manufacturer?

A. The Rumford baking powder was sold higher than some of the alum and phosphate baking powders in the market.

Re-D. Q. 250. But was it sold higher than any?

A. No, sir. Of course the Royal Baking Powder Company's baking powder was sold at higher price than the Rumford.

By Mr. MAURO:

Re-X Q. 251. But the Royal Baking Powder is not an acid phosphate powder, is it?

A. It is not.

47 By Mr. BRIESEN:

Re-D. Q. 252. Were all the acid phosphate powders lower in price than the Rumford?

A. No, sir; the powders that were lower than the Rumford were those manufactured from alum and acid phosphate, a combination of the two.

Re-D. Q. 253. Were those that left out the alum much less or more, or the same as the Rumford?

A. One company much more; the Egg Baking Powder much more. And another company about the same price. Whether there was any much less I don't remember.

Re-D. Q. 254. When you speak of these prices do you mean the retail price at which the consumer gets the goods?

A. I mean the retail prices at which the consumer gets the goods, because I am not informed of the prices at which it is sold by the different manufacturers to these concerns."

Q. 76. In view of these answers formerly given by you, is it not the fact that you had considerable familiarity with the conditions existing in the baking powder and baking preparation business, and were familiar with the demands of the trade, and had the Hygienic Chemical Company manufacture products to satisfy the demands of the trade?

Objected to as immaterial and irrelevant.

A. As near as I can remember, I kept posted through the salesmen of the Hygienic Chemical Company of New York as to the requirements of the Baking Powder manufacturers existing before 1901.

Q. 77. Why did you do this?

A. Because I was the president of the Hygienic Chemical Company.

Q. And you endeavored, as president of the Hygienic Chemical Company, as far as possible to meet the requirements of the trade, is that it?

A. As near as it possibly could be done.

48 Q. 78. In the same transcript on appeal, in the suit against the New York Baking Powder Co., in answer to Q.'s 35 and 6, (page 1148) you said Mr. W. E. Wadman was then and formerly superintendent of the Hygienic Company Works at Elizebethport, New Jersey, and that he was working under your directions. Are those answers correct? You may limit your reply to stating whether or not those answers were correct when you made them.

A. As I remember, they were.

Q. 79. When, if ever, has Mr. Wadman ceased to work under your direction?

A. I do not remember, but some years ago he was given full power to do anything that was proper and advisable in the works, and that he should at times as he thinks proper, consult with me on matters of importance.

Adjourned to 2:00 p. m.

Q. 80. I call your attention to my question 58, to which your answer does not seem fully responsive. Is the answer you gave in the other suit to X Q. 169 correct?

A. I cannot say at this moment whether the answer four years ago or five years ago is correct or not, but as near as I can remember the Hygienic Chemical Company of New Jersey was manufacturing then an acid phosphate which contained a large percentage of fine and some percentage of coarser granulated material.

Q. 81. Had the New Jersey Company between 1898 and 1899 been making the same acid phosphate as it was making in 1901 when you gave your testimony?

A. I cannot remember as the Hygienic Chemical Company were making five to six and possibly eight different grades of product.

Q. 82. Each grade designated by a brand or symbol, was it?

A. Not all grades, maybe some time.

49 Q. 83. Please name each one of those grades, and where you cannot recall the name please describe the grade? I am speaking of the period between 1898 to 1901, inclusive?

A. I could give you none by heart.

Q. 84. Is it a fact that the firm of Heller, Hirsh & Company has never had any dealings or transactions with the Hygienic Chemical Company of New Jersey since that concern was incorporated under the laws of New Jersey?

A. Certainly, it is not a fact.

Q. 85. Please state briefly the nature of the dealings between the firm of Heller, Hirsh & Company and the Hygienic Chemical Company of New Jersey?

A. It is impossible for me to remember the exact dates, except when they needed money they borrowed it from Heller, Hirsh & Company, and Heller, Hirsh & Company loaned it to them, and they paid it back again.

Q. 86. Is it the fact that the Hygienic Chemical Company of New Jersey never paid any money to Heller, Hirsh & Company, and never furnished your firm any compensation or earnings whatsoever, except to return money that had been borrowed?

A. That is a fact.

Q. 87. The last three questions related to the New Jersey concern. Do you make the same answers as to the relations between the Hyginie Chemical Company of New York, and Heller, Hirsh & Company?

A. Yes, sir.

Q. 88. Is it your testimony that the Hygienic Chemical Company of New Jersey from the date of its creation down to the present time has never earned anything above its current indebtedness, and that the parties interested in it have never received any compensation from its business?

A. Yes, sir.

Q. 89. Please give us your best estimate as to the value of the establishment and plant of the Hygienic Chemical Company

50 of New Jersey, and how much capital is invested in that concern.

Objected to as immaterial and irrelevant, and not the proper subject of inquiry here.

A. It is impossible for me to estimate its value, nor is it possible for me at this moment to tell you how much is invested in it. The capital stock is $150,000.

Direct examination closed.

Complainant's counsel requests defendants' counsel to produce Mr. Walter E. Wadman, who has been served with subpœna, to be examined as a witness for complainant; and requests that if the cross-examination of Mr. Heller can be finished within an hour or so after the beginning of the next session, Mr. Wadman be produced at that time.

Counsel for defendants states that he will notify Mr. Wadman in any case so that he may attend immediately after the cross-examination of this witness is closed.

Counsel for the defendants states upon the record that the capital stock of the Hygienic Chemical Company of New York is $3,000.

Cross-examination by Mr. BUTLER, without waiving any objections:

X Q. 90. In answer to question 9 of the direct-examination you stated that Mr. Adolph Hirsh, Mr. Joseph H. Schmaltz and Mr. Samuel A. Tuska, compose the firm of Heller, Hirsh & Company, is that the case at the present time; if so, state the fact?

A. I had misunderstood that question and therefore stated that both Mr. Schmaltz and Mr. Tuska were members, which is not a fact, as they merely had for many years past had an interest in the profits in lieu of salary, and were never partners of Heller.
51 Hirsh & Company, and are not partners now. The firm of Heller, Hirsh & Company consist- of James E. Heller and Adolph Hirsh.

X Q. 91. When was it that these two gentlemen commenced to share in the profits of Heller, Hirsh & Company; give me the date, if you can?

A. I don't know as it is possible for me at this moment to remember the date, but it is a great many years ago.

X Q. 92. Has the Hygienic Chemical Company of New Jersey and its predecessor in business, the West Virginia Company, manufactured and sold acid phosphates for uses other than in the manufacture of baking powder?

A. Yes, sir.

X Q. 93. Now, state some of the uses for which acid phosphates so manufactured and sold were used, if you know, or could be used?

A. It was sold to and used by candy manufacturers, sugar boilers and sugar planters, to druggists and to the suppliers of soda water fountains.

X Q. 94. What relative proportion of the total sales of acid phosphates made and sold by these two companies, were made and sold for the purposes last mentioned as compared with other purposes?

A. It is very hard for me to be exact, but the proportion so sold is quite large.

X Q. 95. In other words, the business of these companies was not in any sense restricted to making and selling acid phosphate capable of being used in the manufacture of baking powder, was it?

A. It was not.

X Q. 96. Were all these acid phosphates sold for these different uses by the two companies the same general variety and grade of goods; in other words, was the same grade of goods sold for these different purposes, or was there any particular grade alone sold for any particular use?

A. It frequently occurred as near as I can remember that the same grade of goods as being used by the baking powder manu-
52 facturers was also used by other trades.

X Q. 97. In other words, as I understand it, these two com-

panies made certain lines of goods, and they weren't of necessity limited for use in any particular manufacture although they might have been more or less available for one manufacture as distinguished from another; is that correct?

A. That is a fact.

Adjourned to Thursday morning, December 21, at 11.00 o'clock, same place.

NEW YORK, *December 21st*, 1905.

Met pursuant to adjournment.

Present: Same as before.

Cross examination closed.

Redirect examination of Mr. HELLER by Mr. MASSIE:

Re-D. Q. 98. Is the Hygienic Chemical Company of New Jersey still manufacturing the brand of acid phosphate called "Special"?

A. They are not.

Re-D. Q. 99. When did you discontinue its manufacture?

A. As near as I can remember over a year or two ago.

Re-D. Q. 100. About the time the Court of Appeals sustained the Catlin patent suit against the New York Baking Co., *et al?*

A. I don't remember when that occurred.

Re-D. Q. 101. Is the Hygienic Chemical Co. of New Jersey still making an acid phosphate containing granular or "granulated substance"?

A. I couldn't tell you.

Re-D. Q. 102. Please look at cross-question 94 and state
53 what you understand by the words "other purposes" in that question?

A. I understood other purposes than that for baking powders.

Re-D. Q. 103. In X Q. 93 you name certain uses or possible uses of acid phosphate, and in X Q. 94 you are asked about "other purposes" for which acid phosphates were made and sold. What I am asking is what were those *other* purposes besides those named in X Q. 93?

A. For baking powders.

Re-D. Q. 104. For what is acid phosphate used in connection with soda water fountains?

A. I couldn't explain, except that they are buying it for the use of soda water fountains.

Re-D. Q. 105. The acid phosphate bought for use in soda water fountains is a liquid, is it not

A. We have sold both liquid and dry.

Re-D. Q. 106. Which is best suited for that purpose?

A. I don't know.

Re-D. Q. 107. For what purpose do druggists use acid phosphate?

A. As near as I could learn for some drug preparation.

Re-D. Q. 108. The acid phosphate used by druggists is a liquid, is it not?

A. No, we have sold it in both the liquid and dry state.

Re-D. Q. 109. Which form is best suited for the purposes of the druggists?

A. As near as I could judge the dry form.

Re-D. Q. 110. Why?

A. Because I have been informed, they use it for dry preparations in the dry form, and dissolve it for liquid preparations.

Re-D. Q. 111. What use is made of acid phosphate by sugar boilers and sugar planters?

A. It is used for clarifying sugar.

Re-D. Q. 112. In what form is acid phosphate used for clarifying sugar; is it not a liquid?

54 A. I don't know, but they buy it both in the dry form and the crystal form.

Re-D. Q. 113. Which form is best suited for the use of sugar boilers and sugar planters, liquid or dry?

A. I am informed that they buy the dry for the convenience of shipping and handling and that they dissolve it when they want to use it for clarifying.

Re-D. Q. 114. For what purpose do candy manufacturers use acid phosphate?

A. They use it as a substitute for lemon juice.

Re-D. Q. 115. For the sake of its acid flavor?

A. Its acid taste, yes, sir.

Re-D. Q. 116. In what form is acid phosphate used for this purpose, is it not a liquid?

A. I do not know how they use it, but it is sold to them in the dry state.

Re-D. Q. 117. When acid phosphate is manufactured for fertilizing purposes it comes in large lumps or chunks, does it not?

A. No, sir.

Re-D. Q. 118. In what form is it?

A. In fine granulated form.

Re-D. Q. 119. At what price does acid phosphate fertilizer sell per pound?

Objected to as irrelevant and immaterial.

A. All superphosphates being an acid phosphate varying in quality, strength and condition have different prices at different seasons of the year, depending upon the supply and demand.

Re-D. Q. 120. Besides acid phosphates for fertilizer purposes, the Hygienic Company made acid phosphate in the form of a liquid, acid phosphate in a finely powdered condition, and acid phosphate containing granular or "granulated" substance—in all at least four different descriptions. Is that correct?

Objected to unless limited as to time.

Complainant's counsel states that the question may be con-

55 sidered as limited to the period from the beginning of the year 1898 down to the present time.

Objected to on the ground that the witness has not testified that the Hygienic Company made any acid phosphate containing granular or "granulated" substance between those specific dates.

A. As near as I can tell and know the Hygienic Chemical Co. of New Jersey does not manufacture any acid phosphate for fertilizer purposes. I believe they have made some in a liquid form, in the ground form, but could not say whether they made it granulated or not up to about two years ago. Just how they are making it now I cannot state.

Re-D. Q. 121. You say the company *does* not make any acid phosphate, fertilizer, (using the present tense), does that statement apply to the entire period enquired of, from the beginning of 1898 to date?

A. It don't make any now and it never made any before, as near as I know.

Re-D. Q. 122. Why is it that you cannot now say whether the Hygienic Chemical Company of New Jersey made any acid phosphate in granulated form up to about two years ago?

A. Because I don't know whether it was in granulated form.

Re-D. Q. 123. Can you state whether or not during the period inquired of, from the beginning of 1898 down, the Hygienic Chemical Company of New Jersey was manufacturing an acid phosphate which contained some fine and some coarser granulated material?

Objected to unless it specifies particular periods.

By COMPLAINANT'S COUNSEL: What particular period does counsel have in mind?

DEFENDANTS' COUNSEL: I think the period ought to be
56 limited prior to the entry of the decree on the opinion of the Circuit Court of Appeals in the case of Rumford Chemical Company against the New York Baking Powder Company.

By COMPLAINANT'S COUNSEL: Will defendants stipulate that at the time of the entry of said decree, and by reason of said decree, the defendants desisted from the manufacture and sale of the granular acid phosphate complained of here?

Counsel for the defendant states that he is not willing to make quite as broad a statement as counsel's question calls for, but he is instructed by the defendants to state that the defendants have not made or sold since some time prior to the entry of the said decree any of the particular brand of acid phosphate referred to in the aforesaid case as "Special," and described by the witnesses in that case.

COMPLAINANT'S COUNSEL: In view of the foregoing stipulation, the witness may confine his answer to the period between the beginning of the year 1898 and the date of the entry of the order referred to in stipulation by defendant's counsel.

It is noted that the opinion of the Court of Appeals was handed down on July 7, 1904.

A. Yes, it was.

Re-D. Q. 124. And during the period between the beginning of 1898 and the first of July, 1904, or at least during a portion of that period was the Hygienic Chemical Co. of New York engaged in selling the product just inquired about?

A. Yes, they were.

Re-D. Q. 125. For the purpose of soda water fountains which is

more suitable acid phosphate containing some coarser granulated material or acid phosphate in a uniformly fine pulvarlent condition; or in a liquid form?

57 A. I don't know.

Re-D. Q. 126. Can you say which of the three forms just inquired of is better suited for the purposes of druggists?

A. I don't know, except as I stated before.

Re-D. Q. 127. The same question with regard to sugar boilers and sugar planters?

A. I don't know, except as stated before.

Re-D. Q. 128. The same question with regard to candy manufacturers?

A. Same answer.

Re-D. Q. 129. Why did you assist in the defense of the test suit against the New York Baking Powder Co., *et al?*

Objected to as immaterial and irrelevant.

A. I don't know now why I did.

Re-D. Q. 130. Did you feel at that time that if the Catlin patent in suit should be sustained and enforced it would interfere with the operations of your companies?

Objected to as immaterial and irrelevant, as calling for matters of conjecture which cannot in any way affect the issues in the present case no matter what the witness may have thought or been advised. Also objected to on the ground that it incorrectly states a conclusion of law in assuming that the defendant companies are the property of the witness, there being no other evidence before the Court than the witness is a stockholder in and officer of the defendant company.

A. I did not.

Re-D. Q. 131. You were present on a great many days during the taking of testimony in that test suit against New York

58 Baking Powder Co., *et al.*, were you not?

Same objection.

A. Yes, sir.

Re-D. Q. 132. Why?

Same objection.

A. Because I have promised Mr. Udell of the Provident Chemical Works Co. that I would be present whenever I could.

Re-D. Q. 133. Mr. Udell or the Provident Chemical Works paid you nothing for your services; but, on the contrary, you or one of the Hygienic Chemical Companies contributed money in support of the defense?

Same objection.

A. I never contributed a dollar towards the defense, but the Hygienic Chemical Company did.

Re-D. Q. 134. And you received nothing for your services in attending during the taking of testimony?

A. I did not.

Redirect examination closed.
Deposition closed.

(Signed) JAMES E. HELLER.

Subscribed and sworn to before me this 28th day of February, 1906.

(Signed) JOHN A. SHIELDS, *Examiner.*

59 (NEW YORK, *December* 21, 1905.)

Mr. Walter E. Wadman appeared at the beginning of this morning session, as arranged by counsel at the last session. By agreement of both parties Mr. Wadman went with Willard H. Harting, a clerk in the office of Complainant's counsel to the office of John A. Shields, Esq., and was duly sworn by Mr. Shields in this case.

Thereupon, WALTER E. WADMAN, a witness subpœnaed by complainant, having been duly sworn, pursuant to said subpœna, testified as follows:

Direct examination by Mr. MASSIE:

Q. 1. You are superintendent of the Hygienic Chemical Company whose factory is located at Elizabethport, New Jersey; and you appear here in response to a subpœna?

A. That is correct.

Q. 2. You have occupied that position continuously since earlier than 1898, and down to the present time?

A. I have.

Q. 3. You gave testimony for the defendants in the test suit brought against the New York Baking Powder Co., *et al.*, did you not?

Mr. BUTLER: I object to the use of the word test.

Mr. MASSIE: Question withdrawn.

Q. 4. Did you give testimony for the defense in the suit brought in the Circuit Court of the United States for the Southern District of New York against the N. Y. Baking Powder Co., The Provident Chemical Works, *et al.*, by the Rumford Chemical Works?

A. I gave testimony in a case in which the Rumford Chemical Company were the plaintiffs, and I assume you have correctly stated the title of that case.

Q. 5. Did the Hygienic Chemical Co. of New Jersey, about
60 1901, manufacture an article of acid phosphate known as "Special?"

A. The word "Special" has been a number of times used as a factory designation of certain brands to distinguish them from other brands. Whether we manufactured at the time you mention anything so designated, I am unable to say from memory.

Q. 6. In order to refresh your recollection as to dates I show you a bound volume of the transcript of record printed under the direction of the Clerk of the U. S. Circuit Court of Appeals for the

Second Circuit, in the case against the New York Baking Powder Co. *et al.*, and point out re-direct questions 187-191, on pages 1228 and 1229, which appear to be on June 4, 1901. I now ask you if it was the fact that beginning somewhere around 1898 the Hygienic Chemical Co. at Elizabethport put out an article of granulated acid phosphate, which was sold as "special," possibly in connection with the "Diamond" as a brand, and that the Hygienic Co. was continuing the manufacture of that same article in June, 1901.

A. In view of the date of this testimony, and that I there testified that date that we were putting out an article of acid phosphate of the brand called "special," it is undoubtedly a fact that we were doing so at that time.

Q. 7. In the same bound volume I call your attention to your answers on page 1290, Re-D. Q. 233, and 234; and ask if it was your object in putting out the granulated acid phosphate to supply the same for use in baking purposes?

Objected to on the ground that the questions referred to for the purpose of refreshing witness' recollection do not on their face relate to a granular acid phosphate.

COMPLAINANT'S COUNSEL: The testimony referred to in the old case relates to the purposes of the Hygienic in putting out or attempting to put out a certain article around the year 1891; my
61 question is whether the Hygienic Company had the same purpose in 1898 or 1901 with regard to the special granulated acid phosphate.

DEFENDANT'S COUNSEL: If counsel limits his questions to the so-called "Special" acid phosphate referred to in that case, the objection is withdrawn.

A. My business was to make acid phosphate. I did not know in the majority of cases to what purpose they were applied or would be applied, and referring to my answer which plaintiff's counsel has referred to you will observe that I replied "I presume." I have a definite recollection of a case in which I was requested to prepare acid phosphate for special use as mentioned to me, and I believe my answers 233 and 234 had that particular substance in mind, although at the time I did not recall the exact use to which it was to be put. I have since recollected that either this article or a similar one was prepared for flavoring certain jellies or desert preparations which consisted of granulated gelatine suitably flavored and colored.

Q. 8. In view of the stipulation occurring after Re-D. Q. 123 in the testimony of Mr. Heller, my questions will be limited to the period between the first of the year 1898 and the first of July, 1904. Was all of the granulated acid phosphate made by the Hygienic Chemical Co. put out under the brand "special;" and, if not, what other brands or designations were used?

DEFENDANTS' COUNSEL: I object to the question on the ground that the witness has not testified that there was any acid phosphate made by the Hygienic Chemical Co. of New Jersey except the article called "Special."

A. There were no other designations used.

Adjourned to 2.15 P. M.

62 Q. 9. Was the article, that was put out by the Hygienic Chemical Co. during the time between the beginning of 1898 and the middle of 1904, and called "special," a granulated acid phosphate?

A. It was a mixture of articles of various sizes.

Q. 10. According to your present recollection, was it similar in appearance to the contents of the sealed bottle I now hand you?

A. In so far as this is a white powdered material it was similar. I would further say that the material in the bottle appears to be a mixture of various substances. There are particles of many colors, shapes and apparent sizes. In this respect, as consisting of particles of different colors it is quite different.

The bottle shown the witness is "Complainant's Exhibit, Catlin Exhibit Hygienic Special."

Q. 11. Do you observe on tilting the bottle and rotating it slowly, that the contents "flow" easily, that is, the contents do not form together in lumps, but act more like dry sand?

A. On your calling attention to this I do so notice, but I should not have observed this unless my attention had been specially drawn to it, for the reason that the property you call attention to is one possessed by a great majority of dry powdered substances.

Q. 12. Was this property possessed by the "Special" Hygienic product which you have testified was put out around 1891.

Objected to, as matter of conjecture, and for the reason that the powder itself is the best evidence as to the property in characteristics.

A. If counsel's question refers to the material to which I testified in Rumford *vs.* Baking Powder Company, my recollection at this distant date is that the material there referred to possessed
63 this property of running or flowing even more markedly than the sample in the bottle.

Q. 13. Will acid phosphate in a uniformly fine pulverized or "pulverulent" condition without any coarser particles, show the same peculiarity?

A. I do not regard the phenomena as a peculiarity, but as a property common to nearly all powdered substances. Some may possess it in greater or less degree than others. I take it, to be scientifically expressed as "the angle of repose" of the material.

Q. 14. Will acid phosphate in a uniformly fine condition of pulverulence, without any coarser particles, present the phenomenon inquired of in Q. 11?

A. Never having seen an acid phosphate of the character described, I am unable to say.

Q. 15. Is the Hygienic Chemical Company, the New Jersey concern, at this time manufacturing an acid phosphate containing some finely powdered material and some in a coarser condition?

A. Yes, and no time did it make any other.

Q. 16. Is such acid phosphate, which the Hygienic Company is

now making similar to the brand spoken of in your testimony as the "Special?"

A. The question is a very broad one. All acid phosphates are very similar, acid phosphate being a chemical substance all acid phosphates are similar.

Q. 17. Wherein, if at all, does the acid phosphate now being manufactured by the Hygienic Company differ from the "special" acid phosphate manufactured by it during 1901?

A. I should say that the average size of the particles is less now than formerly, and further the range of variation in size of particles is greater now than formerly.

Q. 18. What is the minimum size of bolting cloth through which all, or the greater part of, the acid phosphate now manufactured by the Hygienic Company will pass?

A. I have no idea.

64 Q. 19. Will you produce a sample of the acid phosphate as now manufactured by the Hygienic Chemical Company of New Jersey?

A. That is a matter over which I have no authority except as directed by the officers of the company.

Q. 20. Have you any authority to change the brands of articles manufactured by the Hygienic Company, to discontinue one brand or to put out a new and different brand; or do you receive directions from the officers of the company in such matters?

A. In some cases new brands have been put out at my suggestion and in some cases at the instruction of the officers of the company.

Q. 21. Was the special brand of acid phosphate which you were putting out in 1901, put out upon your own initiative, or by the instruction of the officers of the company?

A. I do not now recollect, but I believe it was at my own suggestion.

Q. 22. What was the reason that moved you to put this out, if such was a fact? That is, what advantage did you suppose would be obtained from that form of acid phosphate?

Objected to as immaterial and irrelevant.

A. The reasons that I put that out are very fully expressed in a letter of mine to Mr. N. Waterbury dated about two years prior to the granting of the Catlin patent, the idea of that letter Mr. Catlin appropriated and the exact phraseology he borrowed for his specification.

COMPLAINANT'S COUNSEL: All after the words, "the Catlin patent" is objected to as volunteered.

Q. 23. On page 1149 of the same printed transcript on appeal in the suit against the New York Baking Co. *et al.*, appears

65 what purports to be a copy of a letter from yourself to Mr. Waterbury, dated February 14, 1889. Please read this and state whether it appears to you to be a correct copy.

Objected to as not being the best evidence as to the contents of

the letter; inadmissible, no notice having been given either to produce the letter, or that secondary evidence would be offered in lieu of it.

A. As I remember, it is a correct transcript of the letter.

Q. 24. Will you be good enough to produce the original letter itself?

A. The original letter was filed with other exhibits in the suit of Rumford *vs.* the New York Baking Powder Co. and is not in my possession.

Q. 25. In the printed copy of the letter just shown you you adduce several reasons why it is advantageous for the acid phosphate to be a little coarser; one refers to the presence of "bi-carb. soda"; another refers to "leavening action," and another relates to the tendency of the powder to deteriorate when in a very fine condition. Are these three reasons among the reasons why around the year 1898 the Hygienic Chemical Co. put out the "Special" brand of phosphate?

Objected to as immaterial and irrelevant.

A. The putting out of the brand "special" at or about the time mentioned in the question is not to be regarded as a new development *per saltem*, but as an evolution, and from my earliest experience in the manufacture of acid phosphate I had steadily and continuously increased the size of the particles. Unquestionably the reasons as given in this letter and afterwards quoted verbatim in the patent specifications were among those that led me to make the changes referred to; such reasons would be apparent to every scientific
66 man and would necessarily tend in the direction of just such changes.

Q. 26. Is bi-carbonate of soda employed in connection with acid phosphate for any purpose other than baking powders, baking preparations and the like?

A. I so understand that it is.

Q. 27. What other purposes?

A. The only one I recall at present is used in certain machines for generating carbonic acid gas, as I remember for the purpose of aerating, or carbonating, water for drinking purposes.

Q. 28. Contrasting the acid phosphate now put out by the Hygienic Chemical Co. with the "special" brand being manufactured by that concern in 1901, you have testified that the particles are somewhat smaller, which would indicate that you have reversed the evolution referred to in answer to Q. 25. Why do you make the particles so much smaller now?

Objected to as immaterial and irrelevant.

A. I think a reference to my former answer will show that I said the average size of the particles.

Q. 29. Why is the Hygienic acid phosphate now manufactured in such form that the average size of the particles is smaller than in 1901?

Same objection.

A. As I remember it, I was informed the company had been served with an injunction by the Rumford Chemical Company re-

straining them from selling the brand "Special," claiming that it infringed the Catlin patent, and in order that the company should not subject itself to any risk whatever of disobeying the orders of the Court, I was instructed to discontinue the manufacture of any material that might by any possibility be construed as conflicting with the Catlin patent.

Q. 30. Is it your testimony that the Hygienic Chemical
67 Company continued to manufacture that "special" brand of acid phosphate which it was manufacturing in 1901, down to the time it was served with the injunction order referred to?

A. No; I am not prepared to testify at present as to when the manufacture of "special" was discontinued.

Q. 31. Is it your testimony that down to the time the Hygienic Chemical Company was served with the injunction order referred to, it manufactured an acid phosphate, the average of whose particles was of larger size than the average particles in the present output?

A. That is correct.

Q. 32. During the period from 1898 down to the time the injunction order was served on the Hygienic Company, was all the acid phosphate put out by the Hygienic Chemical Company, excepting the liquid form, the "special"; and, if not, how did any such other phosphates differ from the "special"?

A. Only a very small part of the output was "special." There were a great number of other brands differing in many ways from "special," in quality, price, chemical composition and probably more or less in size of particles.

Q. 33. For the present, this last matter, size of particles, is all that concerns us. In what respect did each of the other brands of acid phosphate put out by the Hygienic Chemical Company differ in size of particles from the "special"?

A. As nearly as that can be made the subject of a general statement I should say that particles of other brands were generally smaller than those of the "special."

Q. 34. Your answer is only general, and I suppose inevitably so. Is it the fact that all of these brands contained more or less powdered phosphate together with more or less coarser particles; that in some brands there was more of the coarser particles than others, the "special" containing the larger portion; and then again in
68 some brands the average size of the particles was larger than in others, the "special" containing the larger particles. Is this in general correct?

A. That is in general correct.

Q. 35. Take the brand which contained the smallest amount of the coarser particles, and in which the average size of the coarser particles was smallest; for what purpose was that brand intended?

A. I do not know.

Q. 36. What advantages, real or supposed, did that brand have over the "special," if any?

A. I do not know.

Q. 37. What advantages, if any, had the "special" over such brands just inquired of?

A. I should say precisely the advantages set forth in the letter already in evidence.

Q. 38. That is, the "special" was better adapted for baking preparations and baking powders?

A. My opinion to that effect is already a matter of record.

Q. 39. And the "special" was made for that purpose?

A. The "special" was made as any coarser material is made to obtain the results which coarse particles would give as against fine.

Q. 40. On pages 1176-7 of the same printed transcript on appeal, appears Re-X Q. 244 and Mr. Heller's answer thereto. This question and answer were read to Mr. Heller in advance of Q. 76, (appearing on type-written pages 35-6). Are you the superintendent of the factory there referred to?

A. I presume I am, yes.

Q. 41. Is it true that you made it your business for years to have under your observation all the baking powders that you knew of or heard of, that came in competition with the baking powders manufactured by customers of the Hygienic Chemical Co.?

A. I think in making that answer Mr. Heller was prompted by an exaggerated idea of my own industry, which possibly I
69 have endeavored to foster. It is true that I had at various times examined baking powders, but it is hardly correct to say that I kept track of all baking powders manufactured by the Rumford or our own customers. Referring back you will note this answer was not Mr. Heller's direct answer to that question, but as to whether he understood the testimony of a former witness to be correct.

Complainant's counsel construes the last part of the answer as pointing out the fact that Mr. Heller, without being asked, voluntarily made the statements with regard to *this* witness' industry.

Q. 42. Are you the "chemist" of the Hygienic Co.; would that designation be properly applied to you, or is there some other gentleman who occupies that position?

A. I have an assistant, but I presume I should be called the head chemist.

Q. 43. Is it a fact that your industry with regard to baking powders was by direction of Mr. Heller?

A. In a general way, all my industry is by direction of Mr. Heller.

Q. 44. Is that the complete answer to my question? Did Mr. Heller indicate to you that you should keep informed, whether "closely" or not, about the baking powders *manufactured* by the customers of the Hygienic Co., or by other concerns?

A. No, I can recall no specific instructions to that effect.

Q. 45. Why then did you examine baking powders made by the Rumford, or its customers, or by the Hygienic Co. or its customers?

Objected to on the ground it assumes defendant Company has made baking powders, which doesn't appear and is not the fact.

70 A. Because I have regarded it as a part of my duty to keep more or less informed as to anything that may connect with our business or be of interest to us, and in such cases as I have ex-

amined baking powders it was being precisely in the same way as I regard it part of my duty to examine machinery, methods of construction or business management.

Q. 46. Regarding the various grades or brands of acid phosphate made by the Hygienic Co., still omitting any liquid preparation, are they all manufactured in the same manner?

A. No; they are differently.

Q. —. Are they all equally expensive; that is, does it cost any more to make one grade than another grade?

A. I wish I knew myself. My opinion is, there are differences in cost.

Q. 48. Do they all command the same price on the market?

A. I don't know.

Q. 49. By what means did you bring it about that the "Special" brand contains the coarser particles that were on the average larger than the coarser particles in the other brand?

A. Obviously by grinding it less.

Q. 50. Is it your testimony that there is more grinding or longer grinding to obtain the other brands?

A. No.

Q. 51. Please name the different brands of acid phosphate put up by the Hygienic Chemical Company from 1898 to the present time?

A. I am unable to name from memory all the brands that have been put out in the years you mention.

Q. 52. Please name all the different brands that are now being put up by the Hygienic Chemical Company?

A. That necessitates my remembering the alphabet, practically: "A," "B," "C," "D." I am not sure about an "F." There is also "AA" and "AAA," and there is "HH," "HP," "N," "S," "W." I don't recall any more now.

71 Q. 53. Is there a printed catalogue or circular describing or advertising these various brands?

A. Not to my knowledge.

Direct examination closed.

Cross-examination by Mr. BUTLER:

X Q. 54. You stated in answer to Question 41 that you had at various times examined baking powders. Please state what sort of an examination you mean you made?

A. In a majority of cases there would be simply tests for the gas strength of the powder; mostly powders sent by our customers, to ascertain if they contained a suitable amount of gas.

X Q. 55. And you don't wish to be understood that you are in the habit of making analyses of baking powders?

A. Certainly, I never acquired that habit.

X Q. 56. What I meant to convey to your mind, Mr. Wadman, was this that you have from time to time made tests of baking powders for the purposes of determining the carbonic acid gas contents, but you never were in the habit of analyzing baking powders for the purpose of knowing exactly what they were made of and how they were made?

A. No; I was not in the habit of making such analysis.

Mr. BUTLER: I should like to offer in evidence the letter which was referred to somewhat indirectly in his examination in answer to Mr. Massie's question, which letter is in my judgment necessary to have in its entirety in the record in order to explain Mr. Wadman's answers to certain of the questions in his direct examination. The letter is as follows:

72 "ELIZABETHPORT, N. J., *February* 18.

N. Waterbury.

DEAR SIR: Herewith unfst. for 4 bbls. B shipped to-day.

Sample of weak (cheap) goods recd. and I am making the best examination I can on so small a sample. Will probably be able to send you word tomorrow about this.

As to fineness of C. A. P. I believe your customer is correct and that it is more finely bolted than our C. We could possibly by re-bolting get ours a little finer—but not much without getting a new cloth. I have always considered it rather an advantage for these goods to be a little coarser for several reasons. First, the particles being coarser there are less points of contact between the A. P. & the bicarb. soda & consequently the rate of deterioration should be slower. Second, coarse particles dissolve more slowly & consequently the leavening action is slower. Third, the very fine, loose, fluffy material must necessarily enclose a great deal of air (& consequently of moisture) between the particles & hence increase the tendency of the powder to deteriorate. It might be worth while to suggest some of these points to your customer & in the meantime I will have a little C bolted and send you a sample to submit to him.

We are almost on our last legs as to this brand until we get our new apparatus started, which may be three or four weeks. Till then we shall probably be able to supply you only in driblets.

We now owe you 5 bbls. B on order No. 12. Please advise me by return whether you want these or the 5 bbls. W the most.

Yours truly, W. E. WADMAN."

73 Redirect examination by Mr. MASSIE:

Re-D. Q. 57. In the cross examination reference is made to "habit." What do you intend by that word?

A. I meant to imply that anything like a complete analysis of any baking powder, as being the exception rather than the rule; such cases have been comparatively rare.

Re-D. Q. 58. The letter just read into the record by defendants' counsel was written in reply to a letter to you from Mr. Waterbury, was it not; and does not the printed letter on the preceding page of the same transcript on appeal, page 1148, appear to you to be a correct copy of the letter to yourself?

A. I understand that is the letter to which mine is a reply.

Complainant's counsel offers this printed copy of the letter in evidence, on the ground that it forms a part of the correspondence of which the other branch has just been put in. The letter is as follows:

"Hygienic Chemical Company, Manufacturers of Acid Phosphate for Baking Powder, &c.

NEW YORK, *February* 17, 1891.

"W. E. Wadman, Esq., Supt. Hygienic Chemical Company.

DEAR SIR: I have mailed you to-day a sample of the Provt. Chemical Works C. A. P. The party claims it is finer bolted than ours. Will order 5 barrels of us if we can turn it out as fine. As near as I can judge I think the sample is finer than our circle C and that it is more bulky and goes farther in filling his cans. It is therefore cheaper for him. Please write me fully about this sample and if you can bolt as fine or finer. How do you like the last circular?

74 I have had some inquiries for it already. Herewith order No. 14 for 5 barrels circle W.

Yours truly, N. WATERBURY,
Sole Agent."

Re-D. Q. 59. The letter just read into the record bears the heading as follows: "Hygienic Chemical Company, Manufacturers of Acid Phosphate for Baking Powder, &c." does the stationery or any other literature put out by the Hygienic Chemical Company continue to bear words of similar purport?

A. As I remember the stationery we use at present does not have any words to that import.

Redirect examination closed.

(Signed) WALTER E. WADMAN.

Subscribed and sworn to before me this 18th day of January, 1906.

(S'g'd) JOHN A. SHIELDS, *Examiner.*

Adjourned subject to four days' notice, as to time and place, it being understood that at the request of defendants' counsel that notice shall not be given before January 2nd, 1906, and shall not be given for January 4th and 5th.

75 In the Circuit Court of the United States for the Southern District of New York.

In Equity. Docket No. 8812.

RUMFORD CHEMICAL WORKS
vs.
HYGIENIC CHEMICAL COMPANY (OF NEW YORK) ET AL.

Notice of Taking Testimony.

To Willard Parker Butler, Esq., Counsel for Defendants, 59 Wall Street, New York City:

Please take notice that we shall proceed to take proofs for final hearing on the part of complainant under the 67th Rule of the

Supreme Court for Courts of Equity, as amended, or in accordance with the statutes in such cases made and provided, and in pursuance with the Rules and practice of this Court, before C. M. Van Slyck, Esq., a notary public, acting as Special Examiner, or other proper officer, under said statutes and Rules; at the office of C. M. Van Slyck, Esq., No. 49 Westminster Street, Providence, R. I., on the 10th day of January, 1906, at 11 o'clock A. M.

The name and residence of the witness, whom it is intended to examine, is Newton D. Arnold, Esq., of Providence, R. I., and possibly others, who lives at a greater distance than one hundred miles from the place of trial.

We desire the testimony in the case to be taken orally. You are invited to attend and cross-examine the witness or witnesses
76 produced. The examination will be adjourned from day to day as may be necessary without further notice.

Dated, New York City, January 4, 1906.

Respectfully,

(S'g'd) C. A. L. MASSIE,
Of Counsel for Complainant.

Due and timely service of the foregoing notice admitted this 4th day of January, 1906.

(S'g'd) WHITRIDGE, BUTLER & RICE,
Of Counsel for Defendants.

77 *Stipulation.*

It is hereby stipulated and agreed by and between counsel for the respective parties herein that if Newton D. Arnold were called as a witness for complainant he would testify that he is Treasurer of the Rumford Chemical Works, complainant herein; that he in the year 1901 received a barrel of acid phosphate from one William P. Clotworthy, who has since died, and that he received with it from said Clotworthy, a paper which purported to be a bill, and a paper which purported to be a receipt showing payment for said barrel; that the said bill and receipt were produced by him when testifying as a witness for complainant in a suit brought by the Rumford Chemical Works against the New York Baking Powder Co. *et al.*, in the United States Circuit Court for the Southern District of New York; that the said bill and receipt were then offered in evidence in said case and were marked respectively "Complainant's Exhibit, Hygienic Co. Bill" and "Complainant's Exhibit, Hygienic Company Receipt," and that he delivered the said barrel to Charles A. Catlin, chemist of the Rumford Chemical Works.

It is further stipulated and agreed that if the said Charles A. Catlin were produced as a witness for complainant he would testify that he is the inventor and patentee of the patent in suit; that after several years of practical experience in milling operations, the bolting and handling of gypsum land plaster, the use of the microscope, he took a special course at the University of Vermont, preparing himself for the duties of an assaying position; that he then engaged in assaying, and in further pursuance of his chemical

studies he took a regular course in the University of Vermont, receiving in 1872 the degree of Bachelor of Science, and in 1873 the degree of Bachelor of Philosophy; that in 1873 he became chemist to the Rumford Chemical Works; that he has made a constant study of phosphates, particularly in their commercial
78 relations ever since 1873; that he is a member of the American Chemical Society and that he was one of its Vice-Presidents; that he is a member and fellow of the Association of Advancement of Science, a member of the British Chemical Industry, a member of the Franklin Chemical Society of Providence, R. I., and a member of other societies. Mr. Catlin would further testify that he received from Mr. Arnold the said barrel of acid phosphate, which he examined; that one sample he placed in a bottle which he sealed with his monogram (consisting of the letters "C. A. C.") and caused to be pasted thereon a label containing the words "Rumford Chemical Works *vs.* Hygienic Chem. Co. *et al.*, Catlin Exhibit Hygienic Special—William L. Sweet—Notary Public;" that he identified the said sealed bottle containing the said sample by an affidavit used on motion for preliminary injunction in complainant's suit against the Hygienic Chemical Company of New York, in the Circuit Court of the United States for the Southern District of New York, said affidavit and sample being delivered to counsel for complainant herein; that the sealed bottle referred to is the sealed bottle already offered in evidence herein as "Complainant's Exhibit Catlin Exhibit Hygienic 'Special' " on Nov. 27, 1905. Mr. Catlin would further testify that he examined other samples from the same barrel of acid phosphate and found the same to be an acid granular phosphate such as used in the manufacture of baking preparations; and that as a result of several special examinations of samples from the said barrel, in order to determine as closely as possible the percentage of pulverulent acid phosphate therein, he found that the quantity of pulverulent phosphatic material that would pass through a No. 16 silk bolting cloth was less than five per cent. (5%) of the whole mass. Mr. Catlin would finally testify that he delivered samples from the same barrel to Mr. Walter W. Saunders, a chemical expert, of Providence, Rhode Island.

79 It is further stipulated and agreed that if Walter N. Saunders were produced as a witness for complainant, he would testify that he began the study of chemistry in 1882 at the Providence High School; that upon graduating there he pursued his studies at the Massachusetts Institute of Technology and at Brown University; that for two years he was private assistant to Prof. Appleton, Professor in Chemistry at Brown University; that he was instructor for six years at Brown University; and that since 1896 he has conducted a chemical laboratory in Providence R. I. Mr. Saunders would further testify that he received from Mr. Catlin the samples above referred to, in sealed bottles, that he examined the contents and found the same to be an acid phosphate.

The foregoing stipulations are made without waiver of defendant's right to object to the testimony thereby presented, or to any part of the same, in the same manner as if the said testimony had

been duly taken in the usual form. Accordingly, the facts recited in the foregoing stipulations are now objected to as irrelevant and immaterial.

(Sgd.) C. A. L. MASSIE,
Of Counsel for Complainant.

(Sgd.) WHITRIDGE, BUTLER & RICE,
Of Counsel for Defendants.

Complainant's counsel now by consent offers in evidence Certificate of Incorporation of the defendant Hygienic Chemical Company, being the New York corporation; and likewise Certificate of Incorporation of the defendant Hygienic Chemical Company, being the New Jersey corporation. The same are marked "Complainant's Exhibit, Certificate of Incorporation of New York Defendant" and "Complainant's Exhibit, Certificate of Incorporation of New Jersey Defendant."

80 In the Circuit Court of the United States for the Southern District of New York.

In Equity. Docket No. 8812.

RUMFORD CHEMICAL WORKS
v.
HYGIENIC CHEMICAL COMPANY (OF NEW YORK) ET AL.

Complainant's *prima facie* proofs for final hearing, taken under and pursuant to the annexed notice before Frederick A. Jones, Esq., Notary Public, acting as Special Examiner by consent, at 49 Westminster street, Providence, Rhode Island, at 11 o'clock a. m., on January 10, 1906.

Met pursuant to notice.

Present: C. A. L. Massie, Esq., of counsel for complainant; John French, Esq., of counsel for defendants.

NEWTON D. ARNOLD, a witness produced on behalf of the complainant, having been duly sworn, testifies as follows:

By Mr. MASSIE:

Q. 1. Please state your name, age, residence, and occupation?

A. Newton D. Arnold; 63 years of age; Providence, Rhode Island; Treasurer and General Manager of the Rumford Chemical Works.

81 Q. 2. You are familiar with the testimony taken in the suit in the Circuit Court of the United States for the Southern District of New York, entitled "Rumford Chemical Works *v.* New York Baking Powder Company *et al.*," are you not?

A. I am.

Q. 3. Do you know what has become of Mr. W. P. Clotworthy, who gave testimony in that suit?

A. He is dead.

Q. 4. Do you know what connection, if any, he had with the Clotworthy Chemical Company?

A. He was President and General Manager.

Q. 5. Was the name of that company, the Clotworthy Chemical Company or Clotworthy Chemical Works?

A. The Clotworthy Chemical Company, I believe.

Q. 6. It appears by stipulation in this case that you received from Mr. Clotworthy a barrel of acid phosphate. Do you remember whether or not Mr. Clotworthy testified where he got this barrel; and if so, please state what the substance of his testimony was?

Counsel for defendants objects to the question, as calling for testimony of a deceased witness in a previous action which is not admissible under the rules of evidence in this action, not being between the same parties.

Complainant's counsel points out that the defendant Heller has testified that the Hygienic Chemical Company of New York participated in the defence of the suit in which Mr. Clotworthy testified.

A. I remember that Mr. Clotworthy testified that he received one or more barrels of granular acid phosphate from the Hygienic Chemical Company and from the Provident Chemical Works, and that he had shipped one or more of these barrels to me.

Counsel for defendants objects to the answer as incompetent for the reasons given.

82 Q. 7. Do you remember what testimony, if any, Mr. Clotworthy gave with regard to any bills or receipts in connection with the said barrel or barrels of acid phosphate?

Some objection by counsel for defendants.

A. He testified that he had received bills, either receipted or a separate receipt for them.

Q. 8. What did he testify became of such bill and receipt, or bills and receipts?

Same objection by counsel for defendants.

A. That they were sent to me.

Q. 9. Do you know Mr. James E. Heller, one of the defendants in this suit in New York?

A. I do.

Q. 10. Was Mr. Heller present during the examination, or any part of the examination, of Mr. Clotworthy?

A. Mr. Heller was present on the first day of Mr. Clotworthy's testimony. Mr. Clotworthy testified the following day, but I do not recall whether Mr. Heller was present at that time or not.

Q. 11. You were, yourself, present during all of Mr. Clotworthy's examination, were you?

A. I was.

Q. 12. Did you receive, at that time, a copy of Mr. Clotworthy's deposition?

A. I did.

Q. 13. Have you read or examined the printed transcript of the Clotworthy testimony, as prepared for the purpose of appeal in the said suit against the New York Baking Powder Company *et al.?*

Objected to by counsel for defendants, as incompetent and irrelevant.

A. I have.

83 Q. 14. According to your best independent recollection and belief, is said printed transcript a correct transcript of what Mr. Clotworthy testified to in your presence?

Same objection by counsel for defendants.

A. It is.

Complainant's counsel gives notice that he will print as part of complainant's record, for the convenience of the court, the Clotworthy deposition referred to, or at least so much thereof as relates to the barrel of special acid phosphate referred to.

Defendant's counsel objects to any reference to or admission of the deposition, for the reasons before stated.

Direct examination closed.

Cross-examination waived.

It is stipulated by and between counsel that the signature of the deponent to the foregoing deposition, and the magistrate's certificate thereto, be, and they hereby are waived.

Adjourned, subject to new notice.

84 NEW YORK CITY, *Feb.* 27, 1906.

It is stipulated and agreed, subject to the defendant's objection that the evidence embraced in this stipulation is immaterial and irrelevant and not proper evidence to establish the issues herein, that if N. D. Arnold were recalled as a witness for the complainant, he would testify that the two documents produced by him and annexed hereto, are lithographic copies of the Hygienic Company bill and the Hygienic Company receipt referred to in the previous stipulation, which were offered in evidence in an action brought by the Rumford Chemical Works against the New York Baking Powder Company and others, and it is further stipulated that the bill and receipt thus identified by Mr. Arnold may be offered in evidence on behalf of the complainant, with the same force and effect as if the originals of said lithographic copies had been produced, and that the bill may be marked "Complainant's Exhibit, Hygienic Company's Bill," and the receipt may be marked "Complainant's Exhibit, Hygienic Company's Receipt," subject to the objections aforesaid, and to the further objection that they are insufficiently proven.

C. A. L. MASSIE,
Counsel for Complainant.
WILLARD PARKER BUTLER,
Counsel for Defendants.

Complainant's *prima facie* proofs closed except as to defendant Heller.

85 At a Stated Term of the Circuit Court of the United States for the Southern District of New York, held in the Court Rooms thereof in the Postoffice Building in the Borough of Manhattan and City of New York, this 18th day of May, 1906.

Present: Hon. E. Henry Lacombe, U. S. Circuit Judge.

In Equity. No. 8812.

RUMFORD CHEMICAL WORKS
vs.
HYGIENIC CHEMICAL COMPANY (OF NEW YORK), JAMES E. HELLER, and ADOLPH HIRSH.

Order Limiting Defendants' Time.

This cause came on to be heard upon complainant's motion for an order limiting defendants' time, based on the Massie affidavit annexed thereto, and on motion of complainant's counsel and the annexed consent of defendants' counsel, it is this day

Ordered that defendants take and complete their answering proofs herein on or before June 29, 1906, but without prejudice to defendants' right to apply for an extension of time upon cause shown.

(S'g'd) E. H. LACOMBE, *U. S. C. J.*

We hereby consent to the entry of the foregoing order.

(S'g'd) WILLARD PARKER BUTLER,
Solicitor and of Counsel for Defendants.

(Filed May 18, 1906.)

86 COMPLAINANT'S EXHIBIT, CERTIFICATE OF INCORPORATION OF NEW YORK DEFENDANT.

Certificate of Incorporation of the Hygienic Chemical Company.

STATE OF NEW YORK, *County of New York, ss:*

We, the undersigned, who are of full age and two thirds of whom are citizens of the United States, and a majority of whom are residents of the State of New York, desiring to form a corporation pursuant to the provisions of the Business Corporation Law, do hereby certify:

1. The name of the proposed corporation is: Hygienic Chemical Company.

2. The objects for which it is formed and the nature of its business are manufacturing, buying and selling acid phosphates and other chemical compounds and all other articles of merchandise which may be in any manner connected therewith and to receive and sell the same as consignees, factors and agents and the acquiring of letters patent, licenses for the manufacture and dealing in the said articles and merchandise and to do, carry on and transact any

and all lawful business whatsoever which in any manner is connected with or which may arise out of said objects and business. The locality of its business is in the State of New York, in the County of New York and City of New York.

3. The amount of the capital stock shall be Three Thousand dollars and shall be issued at par for cash.

4. The number of shares of which the capital stock shall consist is to be Six hundred shares at Five Dollars par.

5. The location of its principal business office is to be in the City of New York.

6. Its duration is to be fifty years.

87 7. The number of its directors is to be three.

8. The names and post-office address of the directors for the first year, are:

Names.	Post-Office Addresses.
Adolph Hirsh	No. 164 Front Street, New York City.
James E. Heller	No. 164 Front Street, New York City.
Samuel A. Tuska	No. 164 Front Street, New York City.

9. The post-office addresses of the subscribers and the number of shares which each agrees to take in the corporation are as follows:

Names.	Post-Office Address.	No. of Shares Subscribed.
Adolph Hirsh	164 Front Street, New York	297
James E. Heller	164 Front Street, New York	297
Samuel A. Tuska	164 Front Street, New York	6

In Witness whereof, we have made, signed and acknowledged this certificate in duplicate this 21st day of April, 1893.

ADOLPH HIRSH.
JAMES E. HELLER.
SAMUEL A. TUSKA.

In presence of

——— ———.

STATE OF NEW YORK, *County of New York, ss:*

On this 21st day of April, 1893, before me personally came Adolph Hirsh, James E. Heller, and Samuel A. Tuska to me personally known and known to be the individuals described in and who executed the foregoing certificate and severally acknowledged that they executed the same.

FELIX JELLENIK,
[SEAL.] *Notary Public No. 87, N. Y. Co.*

88 Duplicate.

$3 75/100. TREASURER'S OFFICE, STATE OF NEW YORK.

Received from Hygienic Chemical Company in full of tax of one eighth of one per centum upon the capital Stock of $3,000. of the

above-named Company, for the privilege of organization, pursuant to Chapter 143, Laws of 1886.

GEO. B. CHURCH,
Deputy Treasurer.

CALVIN J. HUESON,
Deputy Comptroller.

No. 416.

STATE OF NEW YORK, *County of New York, ss:*

I, Thomas L. Hamilton, Clerk of the said County and Clerk of the Supreme Court of said State for said County, Do Certify, That I have compared the preceding with the original Certificate of Incorporation of Hygienic Chemical Company on file in my office, and that the same is a correct transcript therefrom, and of the whole of such original. Indorsed Filed. Recorded May 1st, 1893, 10 h 34 m.

In Witness Whereof, I have hereunto subscribed my name and affixed my official seal, this 27th day of Dec., 1905.

(Signed) THOS. L. HAMILTON, *Clerk.*

89 COMPLAINANT'S EXHIBIT, CERTIFICATE OF INCORPORATION OF NEW JERSEY DEFENDANT.

Certificate of Incorporation of the Hygienic Chemical Company.

We, the undersigned, do hereby certify that we associate ourselves together into a company under and by virtue of the provisions of an act of the Legislature of the State of New Jersey, entitled "An Act Concerning Corporations," approved April 7th, 1875, and the several acts amendatory, supplementary and relating thereto, for the purpose hereinafter mentioned and to that end, we do by this certificate set forth:

First. The name assumed to designate such company and to be used in its business dealings, will be the Hygienic Chemical Company.

Second. The place in this State where the business of such Company is to be conducted, will be at Elizabeth; and that the objects for which the Company is formed are to acquire processes for the manufacture of acid phosphate and bye products thereof and other chemical compounds and letters patent for such processes and licenses under letters patent for such processes and to manufacture, buy and sell such acid phosphate and bye products and chemical compounds. Some portions of its business, namely, the purchase and sale of products manufactured and dealt in by it, is to be carried on out of this State, and its principal office or place of business out of this State, is to be situated in the City, County and State of New York. And it proposes to carry on operations not alone in the State of New Jersey but in New York, in the New England States and other

States of the United States; and the principal part of the business of said Company within this State, is to be transacted at Elizabeth.

Third. The total amount of the capital stock of said Company shall be One hundred and fifty thousand dollars, to be divided
90 into fifteen hundred shares of the par value of One hundred dollars each and of which Fifty thousand dollars shall be preferred stock entitled to seven per centum cumulative annual dividend before any dividend shall be paid on common stock, and One hundred thousand dollars common stock entitled to twelve per centum annual dividends after paying said seven per centum and all dividends over and above said twelve per centum to be divided *pro rata* according to the number of shares between said preferred and common stock. The amount with which the said Company will commence business will be One hundred thousand dollars divided into one thousand shares of the par value of One hundred dollars each.

Fourth. The names and residences of the stockholders and the number of shares held by each, are;

Names.	Residences.	No. of Shares.
Adolph Hirsh	New York, N. Y.	498
James E. Heller	New York, N. Y.	498
Samuel A. Tuska	New York, N. Y.	2
Walter A. Wadman	Bayonne, New Jersey	1
Callow A. Leonard	303 Bloomfield St., Hoboken, N. J.	1

Fifth. The period at which said Company shall commence is the 17th day of April, 1893 and the period at which it shall terminate is the 17th day of April 1943.

In witness whereof, we have hereunto set our hands and seals the 14th day of April, 1893.

ADOLPH HIRSH. [L. S.]
JAMES E. HELLER. [L. S.]
SAMUEL A. TUSKA. [L. S.]
CALLOW A. LEONARD. [L. S.]
WALTER E. WADMAN. [L. S.]

91 STATE OF NEW YORK, *City and County of New York, ss:*

Be It Remembered that on the 14th day of April, Eighteen hundred and ninety-three, before me, Felix Jellenik, a Notary Public duly commissioned and sworn, and authorized under the laws of the State of New York to exercise the functions of the said office in and for the City and County of New York, personally appeared Adolph Hirsh, James E. Heller, Samuel A. Tuska, Walter E. Wadman and Callow A. Leonard whom I am satisfied are the persons named in and who executed the foregoing certificate; and I having first made known to them the contents thereof, they did each acknowledge that they signed, sealed and delivered the same, as their voluntary act and deed.

[L. S.]

FELIX JELLENIK,
Notary Public (48) *N. Y. Co.*

STATE OF NEW YORK, *City and County of New York, ss:*

I, Henry D. Purroy, Clerk of the City and County of New York, and also Clerk of the Supreme Court for the said City and County, the same being a Court of Record, do hereby certify, That Felix Jellenik whose name is subscribed to the Certificate of the proof or acknowledgment of the annexed instrument and thereon written, was, at the time of taking such proof and acknowledgment, a Notary Public, in and for said County duly commissioned and sworn, and authorized by the laws of said State to take the acknowledgments and proofs of deeds or conveyances for land, tenements or hereditaments in said State of New York. And further that I am well acquainted with the handwriting of such Notary Public, and verily believe that the signature to said certificate of proof or acknowledgment is genuine.

92 In testimony whereof, I have hereunto set my hand and affixed the seal of the said Court and County, the 18 day of Apl. 1893.

[L. S.] HENRY D. PURROY, *Clerk.*

[Endorsed.]

"Received in the Clerk's Office of the County of Union, N. J., on the 19 day of April A. D., 1893 at 12 O'clock, noon, and Recorded in Book 6 of Incorporations for said County on pages, 45 &c.

JAS. J. GERBER, *Clerk.*"

"Filed Apr. 19 1893

HENRY C. KELSEY,
Secretary of State."

STATE OF NEW JERSEY.

[Shield.]

DEPARTMENT OF STATE.

I, S. D. Dickinson, Secretary of State of the State of New Jersey, Do Hereby Certify that the foregoing is a true copy of the Certificate of Incorporation of Hygienic Chemical Company and the endorsement thereon, as the same is taken from and compared with the original filed in my office on the Nineteenth day of April A. D. 1893, and now remaining on file and of record therein.

In Testimony Whereof, I have hereunto set my hand and affixed my Official Seal at Trenton, this Third day of January A. D. 1906.

[SEAL.] S. D. DICKINSON,
Secretary of State.

93 *Extract from Clothworthy Deposition, Under Notice on Page 83.*

WASHINGTON, D. C., MONDAY, *January 6th*, 1902.

Met pursuant to adjournment at the office of Philip Mauro, Esq., Washington, D. C., this date, at 10:30 A. M., before Reeve Lewis, Esq., acting herein as Special Examiner, by consent.

Present: Philip Mauro, Esq., of counsel for complainant; and Fritz v. Briesen, Esq., of counsel for defendants.

Whereupon WILLIAM P. CLOTHWORTHY, a witness produced on behalf of complainant, being duly sworn, testified as follows:

By Mr. MAURO:

Q. 1. Please state your name, age, resid[illegible] and occupation?

A. William P. Clothworthy; baking powder manufacturer; age, thirty-six; residence, Baltimore.

* * * * * * *

Q. 49. Have you recently made any purchases of phosphatic material in a physical condition similar to that of the sample marked "Granular"?

Objected to by counsel for defendants as irrelevant and improper rebuttal.

A. I have purchased a barrel or two barrels each of granular phosphate from the Hygienic Chemical Company of New York, and the Provident Chemical Company of St. Louis.

94 Q. 50. What did you do with those barrels of granular phosphate?

Counsel for defendants repeats his objection.

A. I sold a barrel of each to the Rumford Chemical Works.

Q. 51. You sold a barrel that you obtained from the Provident Chemical Company to the Rumford Chemical Works, and another barrel that you obtained from the Hygienic Chemical Company to the Rumford Chemical Works. Is that correct?

A. Yes.

Q. 52. Can you state what, if any, difference in price these manufacturers, or either of them, make between the granular phosphatic material and the regular or powdered phosphatic material?

Counsel for the defendants renews his objection.

A. About three cents a pound.

Q. 53. Can you give the price of each, and if so, state the source of your knowledge?

Objection repeated.

A. About eight and a half cents, I think, for the granulated phos-

phate, and about five and a half for the ordinary or commercial kind. Those were the prices at which they were invoiced to me.

* * * * * * *

X Q. 83. Describe the last experiment that you made for the purpose of producing a marketable phosphatic powder.

The question is objected to by counsel for the complainant as immaterial and the witness is advised that he is not compelled, unless he is willing to do so to disclose any secret experiments he has been making.

95 A. I got from the Provident Chemical Company and from the Hygienic Chemical Company some phosphate in a granular form. I made a baking-powder out of that granular phosphate. At the same time I made a baking-powder out of the ordinary phosphate, with all the conditions alike. I put them away and every thirty days I would examine them. I found that the powder made by the ordinary process deteriorated very rapidly, while that made by the granular process kept very well. These experiments have been running for the past year.

* * * * * * *

X Q. 165. Have you bought any granulated phosphate with the exception of the shipments you have testified to, as having been received from the Provident Chemical Works and the Hygienic Chemical Company?

A. I bought from each of those parties a barrel on my own account for experimental purposes.

96 COMPLAINANT'S EXHIBIT, PATENT IN SUIT.

UNITED STATES PATENT OFFICE.

CHARLES A. CATLIN, of Providence, Rhode Island, Assignor to the Rumford Chemical Works, of Same Place.

Baking-Powder.

Specification Forming Part of Letters Patent No. 478,811, Dated May 17, 1892.

Application Filed October 12, 1891. Serial No. 408,502. (No Specimens.)

To all whom it may concern:

Be it known that I, Charles A. Catlin, a resident of Providence, in the State of Rhode Island, have invented a new and useful Improvement in Baking Preparations, which improvement is fully set forth in the following specification.

My invention relates to that class of baking preparations in which the active acid agent is, either in whole or in part, some form of phosphoric acid or acid phosphate.

Under the general head of baking preparations may be included, first, the ordinary baking-powder, composed of a mixture of the phosphoric-acid element with a carbonate or bicarbonate as active agents; second, the phosphoric-acid element when put up alone, as is sometimes done, without the carbonate or bicarbonate; third, preparations in which the phosphoric-acid element and carbonate or its equivalent are put up in separate packages to be mixed before use, and, fourth, preparations known as "self-raising flour," "quick-rising flour," "prepared flour," and by various other names, in which the phosphoric-acid element and carbonate are mixed by the manufacturer with flour in proper proportions for use in making bread.

Broadly stated, the present invention consists in the production of a baking preparation in which the phosphoric-acid element is in a practically uniform granular condition, free from pulverulent phosphatic material. This granular phosphoric-acid material constitutes a new product or article of manufacture, possessing peculiar and distinctive properties and characteristics of great value for the purposes stated, as will be hereinafter explained.

As is well known to those familiar with such matters, preparations of the kind above referred to, as ordinarily prepared, while possessing the highest dietetic value and leavening efficiency, possess, nevertheless, the property of serious deterioration when freely exposed to atmospheric humidity, compelling the manufacturer to employ extraordinary and expensive means in packing to protect them from this influence.

Heretofore it has been the aim of the manufacturer to produce the phosphatic element in the finest pulverulent condition possible, believing that thus, and thus only, could highest efficiency be obtained. I have discovered, however, that the fine pulverulent condition of the commercial phosphatic powders is not necessary to highest efficiency in the leavening quality, but is rather detrimental to it. Indeed, the results of my experiments have demonstrated that when a baking-powder having the phosphatic element in a granular condition is used in place of one containing that element mainly in a fine pulverulent form the leavening efficiency of the preparation is materially augmented, while at the same time the deterioration quality is retarded, if not entirely overcome. The reason for the increased efficiency will be readily understood when we take into consideration the fact that within limits a somewhat slow evolution of the leavening carbonic-acid gas is desirable, in order that too much of it may not escape from the dough during the mixture and kneading before the loaf is placed in the oven; but rather that a considerable part of it shall remain to be evolved during the baking process, that the dough may be at its highest expansion when hardened by the baking into the permanent cellular structure of the finished loaf. The slow-evolution quality is not possessed in a marked degree by phosphatic baking-powders as heretofore prepared, and especially is it lacking when the phosphatic element employed is of a highly-acidulous character. This is due to the ready solubility of the acid agent in its finely-powdered condition, which of course brings it into

rapid reaction with the alkaline bicarbonate and causes the rapid evolution of its gas. When, on the contrary, the particles of the acid are in a coarse condition, solution and consequent reaction are retarded. In practice I have found, therefore, that by giving to the phosphatic element of the baking-powder a uniformly-coarse condition the property of slow evolution of the gas is increased and a consequent marked increase in baking efficiency is obtained. In this respect, therefore, the new product possesses a distinct advantage over phosphatic powders heretofore made and used.

97 As is well known, acid phosphates possess naturally a highly-deliquescent property, and this to such a degree when reduced to a finely-powdered state and exposed to variable atmospheric conditions that they at times greedily absorb moisture, and thereby acquire of themselves alone (or impart to any mixture of powders of which they form a considerable proportion) a sticky, clammy condition. This absorption of moisture by the acid element when packed separately in the usual fine condition causes a recrystallization of the powder, which in such case hardens into a caky crystalline mass, unsuitable for the use intended. Moreover, such a powder or mixture of powders is difficult to pour either in or out of any small-necked receptacle, and is especially difficult to measure out in the quantities in which baking-powders are used. This objectionable quality in phosphatic powders, I have found, does not attach to any serious extent to the new granular preparation. The reason for this improvement is plainly apparent when we take into consideration the fact that in the same weight of material the surface exposed to the atmospheric influence is greatly increased the finer its pulverulent condition.

I have furthermore discovered that in phosphatic baking-powders as heretofore prepared the deteriorating quality is largely due to the exceedingly fine pulverulent condition of the acidulated element, and I have demonstrated that this is true by comparing a baking-powder having its phosphatic element in granular form essentially free from all finely-pulverulent phosphatic material with other like baking-powders having the phosphatic element in the usual powdery condition, with the result that the latter was practically spoiled, while the former showed little or no deterioration.

The improved keeping quality of baking-powder mixtures containing the acid phosphates in a uniformly-granular condition is due partly to the reduced deliquescent property of the acidulated material in such condition, already referred to, and partly to the greatly reduced number of points of contact which such granular acidulated material presents to the carbonate, with which it is in admixture, in proportion to the weight employed. Another reason for this improved result is the increased size of the interspaces between the active particles, due to this granular condition, which permits, when a fine diluent is employed, of a more complete introduction of said diluent between these particles and their isolation from each other.

To prepare the acidulated phosphate in this improved granular condition, I proceed as follows: I take the material as ordinarily

Circuit Court of the U.S.
Southern District of New York.

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Rumford Chemical Works

vs.

New York Baking Powder Co. et al.

Complainant's Exhibit
Hygienic Company Bill

WORKS:
ELIZABETHPORT, N. J.
TELEPHONE, 1034 ELIZABETH.

BRANCH OFFICES:
BOSTON, MASS., 200 C. MASS ST.
TEL. CALL, 470.
CHICAGO, ILL., 10 PACIFIC AVE.
TEL. CALL, 1000 HARRISON.
BALTIMORE, MD., 201 E. LOMBARD ST.
TEL. CALL, 708.
CHARLESTON, S. C., BROWN'S WHARF.
TEL. CALL, 277.

NEW YORK TELEPHONE,
1034 JOHN.

New York Mar. 13 1901

Mr The Elsworthy Chemical Co.
Baltimore, Md.

Bought of Hygienic Chemical Co.
of New Jersey.
Manufacturing Chemists
Offices 62 & 64 William St.
New York City.

O. B. 10160
S. B. 8205

All claims for damage to be reported within three days after receipt of goods.

Terms: 60 days or 2% 10 days

Bbl. Special Phosphate.
305-25-280 lbs @ 8½ net $23.80

Marked
N.D.A.
(Hy)

Notary Public,
District of Columbia

U.S.Circuit Court
Southern District of New York.

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Rumford Chemical Works

vs.

New York Baking Powder Compant et al.

Complainant's Exhibit Hygienic Company Receipt.

Hygienic Chemical Co.
New York N.Y.
Payment
Mch 13
Less freight
Received MAR 25 1901
The Hygienic Chemical Co.
Less 2%
23 34
47
22 87

CLOTWORTHY CHEMICAL CO.

Notary Public,
District of Columbia

prepared for the grinding process and, passing it through any suitable mill, grind it to a rather coarse condition and then bolt it through as coarse a bolt as I find its proper baking efficiency will allow. For most preparations of this kind I have found a No. 9 silk bolt to answer the requirement. This bolted product from the No. 9 silk I now subject to another bolting process, using a much finer bolt for this purpose. A No. 16 silk has given me excellent results for this. The material should be continued long enough in this No. 16 silk to completely remove all of the fine material that will pass through it. The process may be much facilitated by using knockers or aspirators, if the condition of the material requires. The material refusing to pass the No. 16 bolt is a mass composed entirely of granules practically uniform in size, and this may be put up for use and sale in any of the ways above indicated. The material passing through the No. 16, if no other use be found for it, may be used as a drier in the crystallization of new batches of the phosphatic material and no loss be incurred from this source except the double handling involved.

It is evident that any other suitable method of producing the phosphatic material in granular form may be employed, and the resulting product possesses equally valuable qualities, and therefore I do not restrict myself to the method described nor to the particular size of granules set forth.

What I claim as my invention, and desire to secure by Letters Patent, is—

1. A baking preparation containing phosphoric acid or its compounds in granular condition essentially free from pulverulent phosphatic material, substantially as described.

2. A baking prepartion composed of a phosphoric-acid element in granular form essentially free from pulverulent phosphatic material, in admixture with a carbonate or bicarbonate, as set forth.

In testimony whereof I have signed this specification in the presence of two subscribing witnesses.

CHAS. A. CATLIN,

Witnesses:
JAMES V. SCHROEDER.
CHAS. HALLEY.

(Here follow facsimiles marked pp. 98 and 99.)

100 Circuit Court of the United States for the Southern District of New York. In Equity.

RUMFORD CHEMICAL WORKS, Complainant,
vs.
ADOLPH HIRSH, Defendant.

The Answer of Adolph Hirsh, Defendant, to the Bill of Complaint of the Rumford Chemical Works, Complainant.

The defendant answering the said complainant's said bill of complaint says, on information and belief, that he admits the issue of certain Letters Patent, numbered 474,811, on the 17th day of May, 1892; but denies that the grant and issue of said Letters Patent secured any exclusive rights whatsoever; and denies that Charles A. Catlin was the true, original and first inventor or discoverer of the alleged invention or discovery patented in and by said Letters Patent.

101 And this defendant denies that the alleged improvement described in said Letters Patent was not abandoned by the said Charles A. Catlin, but alleges that the said Charles A. Catlin abandoned the said alleged invention by disclosing and delivering the same to the officers and employees of the Rumford Chemical Works without reservation or restriction, and without making application therefor in the United States Patent Office fully seven years before the said application was filed, wherefore and by reason of which abandonment and neglect the public is deprived of the free use of the said invention at the present time, and this defendant alleges that this neglect, delay and abandonment, followed by an application for patent seven years later, makes the patent a fraud on the public and a means of exacting royalties from the public at the present time when the patent would have been public property had the inventor been reasonably diligent and had he not abandoned the said invention.

And this defendant, answering the fourth paragraph of the bill of complaint, denies that the alleged invention is of great value and use to the public, but on the contrary, by reason of the aforesaid fraudulent acts of the complainant and of Charles A. Catlin, this defendant alleges that the alleged invention has been and is being used as a means of oppression and extortion from the public.

And this defendant, further answering, admits that the complainant is the owner of said Letters Patent No. 474,811.

And this defendant, further answering, upon information and belief, says that the said Letters Patent No. 474,811 are void by reason of the following special matters:

First. That for the purpose of deceiving the public, the description and specification filed by the said Charles A. Catlin, in the Patent Office, was made to contain less than the whole truth relative to his alleged invention or discovery, or more than is necessary to produce the desired effect, and that such latter

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fact has been affirmatively found to be true by the United States Circuit Court for this Circuit, and by the United States Circuit Court of Appeals of the Second Circuit.

Second. That said Letters Patent were surreptitiously and unjustly obtained for that which was, in fact, invented by another, who was using reasonable diligence in adapting and perfecting the same, to wit, by Walter E. Wadman, and that the same was suggested to the said Charles A. Catlin by the said Walter E. Wadman.

Third. That said Charles A. Catlin was not the original and first inventor or discoverer of any material and substantial part of the thing patented, and that the following are the names and residences of the persons who have had knowledge and made use of the thing patented, and of every material and substantial part thereof, prior to the alleged invention thereof by said Charles A. Catlin, and the names of the places where such use was had and known.

Eben N. Horsford, of and at Cambridge, Massachusetts, and at other places;

The officers and employees of the Rumford Chemical Works, of and at Providence, R. I., and at other places.

Edwin B. Bangh, of and at Philadelphia, Pa., and at other places;

George F. Wilson, of and at East Providence, R. I., and at other places;

John E. Lauer, of and at New York, N. Y., and at other places.

William P. Clotworthy, of and at Baltimore, Md., and at other places;

Charles E. Catlin, of and at Providence, R. I., and at other places;

103 Carl V. Petraens, of and at Camden, New Jersey, and at other places;

Adolph Ciesecke, of and at Buffalo, New York, and at other places;

James W. Carson, of and at Philadelphia, Pa., and at other places;

Francis P. Harned, of and at Camden, N. J., and at other places;

John M. Hughes, of and at Brooklyn, N. Y., and at other places;

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S. Elwood May, of and at New York, N. Y., and at other places;

Leopold Schepp, of and at New York, N. Y.., and at other places;

104 Caspar B. Shafer, of and at Washington, D. C., and at other places;

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John C. Schuman, of and at Akron, Ohio, and at other places;

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Joseph F. Gent, of and at Columbus, Indiana, and at other places;

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Russell S. Penninmann, of and at Jenkintown, Pa., and at other places;

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The employees and members of the firm of Heller, Hirsch & Co., of and at New York, N. Y., and at other places;

Vincent C. Rice, of Waukegon, Illinois, at Chicago, Illinois, and at other places;

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Morris N. Hirsch, of and at Chicago, Illinois, and at other places;

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W. J. Gesell, of and at New York, N. Y., and at other places;

The members of the firm and employees of Powers & Weightman, of and at Philadelphia, Pa., and at other places;

William J. Baird, of and at New York, N. Y., and at other places;

Albert Plant, of and at New York, N. Y., and at other places;

Walter E. Wadman, of and at Bayonne, N. J., and at other places;

Henry Heuer and Frank Wilson, of and at Elizabethport, N. J., and at other places;

Charles F. Herreshoff, of and at Bristol, R. I., and at other places;

John Wilson, of and at Elizabethport, N. J., and at other places;

Thomas Boyle, of and at Elizabethport, N. J., and at other places;

William Smith, of and at Elizabethport, N. J., and at other places;

Mary Boyle, of and at Elizabethport, N. J., and at other places;

106 James E. Barney, of Dorchester, Mass., at Pleasant Valley, North Providence and East Providence, R. I., and at other places;

David F. Whitaker, of and at Seekonk, R. I., and at other places;

Patrick Brady, now of Providence, R. I., of and at Pleasant Valley, R. I., and East Providence, R. I., and at other places;

Henry McElroy, now of Pawtucket, R. I., of and at East Providence, R. I., and at other places;

Hanna Morton, of and at East Providence, Rhode Island, and at other places;

and many others, whose names this defendant has not yet ascertained, but which he craves leave to insert in this answer as soon as ascertained.

Fourth. That the thing patented in said Letters Patent had been patented and described prior to said Charles A. Catlin's supposed invention or discovery thereof, in and by the following Letters Patent granted to the following named persons, to wit:

Reissue No. 2979, issued June 9, 1868, for improvement in Pulverulent Acid for use in the Preparation of Soda Powders, Farinaceous Food and for other purposes to The Rumford Chemical Works;

Reissue No. 2597, issued May 7, 1867, for Improvement in the Manufacture of Phosphoric Acid and Phosphates for use in the preparation of Food and for other purposes to The Rumford Chemical Works;

No. 14,722, issued April 22, 1856, to E. N. Horsford;

No. 41,815, issued March 1, 1864, to E. N. Horsford;

No. 42,140, issued March 29, 1864, to E. N. Horsford;

No. 45,631, issued December 27, 1864, to Potts & Klett;

No. 45,961, issued January 17, 1865, to Liebig & Cooper;

107 No. 47,610, issued May 9, 1865, for Improved Mode of Manufacturing Superphosphate of Lime, to Edwin P. Bangh;

No. 75,271, issued March 10, 1868, to E. N. Horsford;

No. 75,272, issued March 10, 1868, to E. N. Horsford;

No. 75,326, issued March 10, 1868, to George F. Wilson, for Im-

provement in the Preparation of Bones for the Manufacture of Phosphoric Acid and Phosphates;

No. 75,327, issued March 10, 1868, to George F. Wilson.

No. 75,328, issued March 10, 1868, to George F. Wilson, for Improvement in the Manufacture of Acid Phosphates;

No. 75,329, issued March 10, 1868, to George F. Wilson;

No. 75,330, issued March 10, 1868, to George F. Wilson, for Improvement in Drying Acid Phosphates;

No. 75,331, issued March 10, 1868, to George F. Wilson, for Improved Process and Apparatus for the Manufacture of Acid Phosphates;

No. 75,332, issued March 10, 1868, to George F. Wilson;

No. 75,333, issued to George F. Wilson, March 10, 1868, for Improvement in Grinding and Pulverizing Acid Phosphates;

No. 75,334, issued to George F. Wilson, March 10, 1868, for Improvement in Granulating Acid Phosphates;

No. 75,335, issued March 10, 1868, to George F. Wilson;

No. 75,336, issued to George F. Wilson, March 10, 1868, for Improvement in the Manufacture of Phosphates and in Extracting Phosphoric Acid from Bones;

No. 75,337, issued to George F. Wilson and Eben N. Horsford, March 10, 1868, for Improvement in Treating the Mixture
108 of Acid Phosphate of Lime and Farinaceous matters in order to granulate them;

No. 75,338, issued to George F. Wilson and Eben N. Horsford, March 10, 1868, for Improved Process of Treating Acid Phosphates in the Manufacture of Yeast, Powder, &c.

No. 75,339, issued March 10, 1868, to George F. Wilson;

No. 86,275, issued January 26, 1869, to Henry Bower;

No. 86,594, issued February 2, 1869, to O. A. Moses;

No. 104,034, issued June 7, 1870, to E. N. Horsford;

No. 105,319, issued July 12, 1870, to Alfred Du Vall;

No. 106,147, issued August 9, 1870, to Frank & Adt;

No. 114,304, issued May 2, 1871, to F. J. Kimball;

No. 114,693, issued May 9, 1871, to George T. Lewis;

No. 128,752, issued July 9, 1872, to Pratt & Lewis;

No. 130,298, issued to Eben N. Horsford, August 6, 1872, for Improvement in the Manufacture of Phosphate of Lime and Yeast Powders;

No. 137,635, issued April 8, 1873, to Storck & Lyre;

No. 140,051, issued to John E. Lauer, June 17, 1873, for Improvement in Manufacturing Crystal-ine Acid Phosphate of Lime for Yeast Powders;

No. 143,580, issued to John G. Kopping and John Weidemann, Oct. 14, 1873, for Baking Powder for Bread;

No. 195,142, issued Sept. 11, 1877, to James Mactean;

No. 206,930, issued to William H. Clotworthy, Aug. 13, 1878, for Improvement in Baking Powders;

No. 223,847, issued January 27, 1880, to J. F. Gent;

109 No. 229,518, issued to Charles A. Catlin, July 6, 1880, for Acid Phosphate for Baking Powders;

No. 238,570, issued to Charles A. Catlin, March 8, 1881, for Baking Powder;

No. 239,802, issued to Charles A. Catlin, April 5, 1881, for Baking Powder;

No. 256,832, issued to Adolph Giesecke, April 25, 1882, for Manufacture of Baking Powder;

No. 294,592, issued to Franz Dietrich, March 4, 1884, for Manufacture of Cream of Tartar;

No. 338,934, issued to James W. Carson and Francis P. Harned, March 30, 1886, for Manufacture of Blocks of Bicarbonate of Soda;

No. 352,465, issued to John N. Hughes, Nov. 9, 1886, for Compound Table Salt or Condiment;

No. 374,201, issued to Carl V. Petraens, Dec. 6, 1887, for Process of Making Acid Potassium Phosphates;

No. 389,566, issued Sept. 18, 1888, to Charles Glaser, for Process of Making Acid Phosphate;

No. 407,241, issued July 16, 1880, to Nathaniel B. Powter, for Phosphatic Fertilizer;

No. 417,710, issued Dec. 24, 1889, to Herbert E. Dennett, for Food Compound;

No. 215,341, issued to John G. Finke, May 13, 1879, for Granulated Chocolate;

No. 391,630, issued to Louis Hennemeier, Jr., October 23, 1888, for Cocoanut Compound;

No. 398,982, issued to Leopold Schepp, Feb. 19, 1889, for Cocoanut Compound;

No. 398,983, issued to Leopold Schepp, Feb. 19, 1889, for Cocoanut Compound;

No. 287,781, issued to Caspar B. Shafer, Oct. 30, 1883, for Medicated Effervescent Salts;

No. 155,043, issued to William S. Sampson, Sept. 15, 1874, for Methods of Preserving Lime;

No. 320,401, issued to John C. Schuman, June 16, 1885, for Method of Preparing and Treating Starch;

No. 304,722, issued to Joseph F. Gent, Sept. 9, 1884, for Art of Making a Product from Indian Corn known as Cerealine;

110 No. 350,532, issued to Charles H. W. Foster, Oct. 12, 1886, for Apparatus for Sifting Sugar;

No. 316,277, issued to James Macteer, April 21, 1885, for Apparatus for Making Granulated Crystal-ine Carbonate of Soda;

No. 312,010, issued to Russell S. Penniman, Feb. 10, 1885, for Protected Nitrate of Ammonia for use in Explosive Compounds;

No. 476,592, issued to Jessie Ascough, June 7, 1892, for Process of Making Borax;

No. 364,587, issued to Thomas Higgin, June 7, 1887, for Process of Separating Sand Scale, Hard Pan Scale and other Impurities from Salt;

No. 333,348, issued to John C. Schrader, Dec. 29, 1885, for Dynamite and Process of Making the Same;

No. 333,346, issued to John C. Schrader, Dec. 29, 1885, for Dynamite;

No. 449,064, issued to Newton M. Bell, Mch. 24, 1891, for Art of Manufacturing Borax;

No. 244,575, issued to Camille A. Faure, July 19, 1881, for Explosive Blasting Material;

No. 458,663, issued to Francis Ellershausen, Sept. 1, 1891, for Process of Making Caustic Alkali;

No. 260,786, issued to William E. Quinan, July 11, 1882, for Explosive Powder;

No. 300,281, issued to William R. Quinan, June 10, 1884, for Explosive Compound.

British Patents.

No. 9,977 of 1843;
No. 466 of 1852;
No. 910 of 1852;
No. 189 of 1855;
No. 2,161 of 1856;
No. 568 of 1860;
No. 2,082 of 1862;
No. 713 of 1864;
No. 320 of 1865;
111 No. 1,267 of 1868;
No. 924 of 1869;
No. 3,645 of 1869;
No. 514 of 1871;
No. 3,022 of 1871;
No. 3,160 of 1872;
No. 1,455 of 1875;
No. 1,249 of 1879;
No. 2,875 of 1880;
No. 5,115 of 1880;
No. 2,725 of 1882;
No. 6,208 of 1882;
No. 8,658 of 1884;
No. 984 of 1890.

French Patents.

No. 58,807 of 1863, Dufourmental & Poire;
No. 59,527 of 1863, LePerdriel;

and in many others which this defendant has not yet ascertained, but which he craves leave to insert in this answer as soon as ascertained.

Fourth. That the thing patented in said Letters Patent has been described prior to said Charles A. Catlin's supposed invention or discovery thereof in the following named printed publications, all of which were publicly circulated in the United States prior to the said Charles A. Catlin's supposed invention or discovery, to wit:

In "Remington's Practice of Pharmacy," published at Philadelphia in the year 1885, by J. B. Lippincott Company, at Chapter XVI., page thereof.

In "Mineral Phosphate and Pure Fertilizers," by Campbell Morfit, published at London, England, in 1873, by , at page 316 thereof, article entitled "Manufacture of Superphosphate of Lime."

In "Donovan's Domestic Economy," published at London,
112 England, in the year 1842, Volume I. thereof, at page 102.

In Dingler's Polytechnic Journal, published at Augsburg, Germany, in the year 1863, Volume 170, page 314.

In "Quantitive Analysis," by C. Freservius, published at in the year 1865, at page 37.

In "Quantitive Analysis," by Classen, Fourth Edition, published at in the year 1891, at page 4.

In Kamarsch & Heeren, Technical Dictionary, published at in the year 1880, Volume 4, page 465.

In National Dispensary, published at in the year 1887, at page 1257.

In Muspratt's Chemical Encyclopedia, published at in the year 1878, Third Edition, at pages 1566 and 1627.

In Wurtz Dictionaire de Chimie, published at in the year 1876, Volume 2, page 1167.

In Miller's Elements of Chemistry, published at in the year 1868, part 2, pages 815-816.

In Mendelies' Principles of Chemistry, published at in the year 1870, Volume 1, pages 38 and 39;

and in many others which this defendant has not yet ascertained, but which he craves leave to insert in this answer as soon as ascertained.

Fifth. That the thing patented in said Letters Patent had been in public use and on sale in this country for more than two years before the said Charles A. Catlin's application for a patent, and that the persons hereinabove named as having had prior knowledge and use of the said alleged invention, and many others, knew of
113 such prior public use and sale as did also said Charles A. Catlin.

And this defendant, further answering, upon information and belief, says that said Letters Patent do not disclose or show any invention whatsoever in view of the state of the art in the manufacture of baking powder, soda, cream of tartar, phosphoric acid, acid phosphates, &c., and many other articles which existed at and long before the time when it is alleged in the complainant's said bill of complaint that the said Charles A. Catlin made his alleged invention; and that in view of the state of the art the said Charles A. Catlin has not, in his said Letters Patent, disclosed any new or patentable invention whatsoever, but that the alleged invention involves, if anything, simply mechanical skill and judgment.

And this defendant denies that the complainant has gone to great or any expense and trouble in preparing for the manufacture of, in manufacturing, in placing it on the market, and introducing into use baking preparations manufactured in accordance with and embodying the alleged invention set forth in said Letters Patent; that

the baking preparations so made and introduced and embodying said alleged invention have attained a general and widespread popularity, and are universally recognized as possessing superior qualities; that the public generally and manufacturers and dealers in all parts of the United States have recognized and acquiesced in the alleged exclusive rights of the complainant, and that but for the alleged infringement and wrongs specified in the bill of complaint, the complainant would now be in the peaceful possession and enjoyment of all the alleged rights and privileges granted under said Letters Patent and of the income derivable therefrom; and on the contrary this defendant alleges that the public generally, manufacturers and dealers throughout the United States are in arms against the unjust and inequitably secured monopoly repre-
114 sented by said Letters Patent, and are severally doing their utmost to establish the fraudulent character of such monopoly to the extent of contesting the said patent in all judicial districts in the United States wherever suit is brought against any of them.

And this defendant, answering the fifth paragraph of the bill of complaint, denies that he has jointly with James A. Heller, Adolph Hirsch and the Hygienic Chemical Company (of New Jersey), and each of them, within the Southern District of New York, or anywhere, unlawfully and wrongfully made and used and vended, or caused to be made and used and vended, baking powder substantially as described in said Letters Patent; and denies further that he continues to do so jointly with the aforesaid persons or threatens to continue such alleged unlawful acts to a large or any extent.

And this defendant, answering the eighth paragraph of the bill of complaint, denies that he participated in the defense of the suit of Rumford Chemical Works against New York Baking Powder Company, either financially or otherwise, and that he was at the time engaged in manufacturing and selling granular acid phosphate like or similar to the article put out by the said New York Baking Powder Company.

And this defendant alleges as a separate and distinct defense that there is now pending undetermined in the United States Circuit Court for the Southern District of New York a suit, entitled Rumford Chemical Works against Hygienic Chemical Company (of New York) and others, involving the same patent, the same issues, the same parties, and that the pendency of such suit is a bar to the present suit, except as to a baking powder or acid phosphate made by this defendant prior to the institution of the old suit aforesaid.

And this defendant, further answering, upon information and belief, alleges and will prove that the invention alleged to have
115 been made by the said Charles A. Catlin, or disclosed in said Letters Patent, was old at the time of the alleged making thereof by said Charles A. Catlin, and was at that time a common and well known means of attaining the object sought to be attained by said Charles A. Catlin, and that the same was constantly being used in the manufacture of such articles as baking powder, soda, cream of tartar, phosphoric acid, acid phosphates, and other articles, and that therefore said Letters Patent are void.

And this defendant denies all and all manner of unlawful acts wherewith he is by the said bill charged. All which matters and things this defendant is ready and willing to prove as this Honorable Court shall direct, and he humbly prays to be hence dismissed, with his reasonable costs and charges in this behalf most wrongfully sustained.

ADOLPH HIRSCH, *Defendant.*

HANS v. BRIESEN,
Solicitor for Defendant, and of Counsel.

(Endorsed)—Filed Oct. 19, 1904.—Southern District of New York.—John A. Shields, Clerk.

116 Circuit Court of the United States for the Southern District of New York. In Equity.

RUMFORD CHEMICAL WORKS, Complainant,
vs.
HYGIENIC CHEMICAL COMPANY (OF NEW YORK), Defendant.

The Answer of Hygienic Chemical Company (of New York), defendant, to the Bill of Complaint of the Rumford Chemical Works, Complainant.

The defendant answering the said complainant's said bill of complaint says, on information and belief, that it admits the issue of certain Letters Patent, numbered 474,811, on the 17th day of May, 1892; but denies that the grant and issue of said Letters Patent secured any exclusive rights whatsoever; and denies that Charles A. Catlin was the true, original and first inventor or discoverer of the alleged invention or discovery patented in and by said Letters Patent.

And this defendant denies that the alleged improvement
117 described in said Letters Patent was not abandoned by the said Charles A. Catlin, but alleges that the said Charles A. Catlin abandoned the said alleged invention by disclosing and delivering the same to the officers and employees of the Rumford Chemical Works without reservation or restriction, and without making application therefor in the United States Patent Office fully seven years before the said application was filed, wherefore and by reason of which abandonment and neglect the public is deprived of the free use of the said invention at the present time, and this defendant alleges that this neglect, delay and abandonment, followed by an application for patent seven years later, makes the patent a fraud on the public and a means of exacting royalties from the public at the present time when the patent would have been public property had the inventor been reasonably diligent and had he not abandoned the said invention.

And this defendant, answering the fourth paragraph of the bill of complaint, denies that the alleged invention is of great value and use to the public, but, on the contrary, by reason of the aforesaid fraudulent acts of the complainant and of Charles A. Catlin, this

defendant alleges that the alleged invention has been and is being used as a means of oppression and extortion from the public.

And this defendant, further answering, admits that the complainant is the owner of said Letters Patent No. 474,811.

And this defendant, further answering, upon information and belief, says that the said Letters Patent No. 474,811 are void by reason of the following special matters:

First. That for the purpose of deceiving the public, the description and specification filed by the said Charles A. Catlin, in the Patent Office, was made to contain less than the whole truth relative
118 to his alleged invention or discovery, or more than is necessary to produce the desired effect, and that such latter fact has been affirmatively found to be true by the United States Circuit Court for this Circuit, and by the United States Circuit Court of Appeals of the Second Circuit.

Second. That said Letters Patent were surreptitiously and unjustly obtained for that which was, in fact, invented by another, who was using reasonable diligence in adapting and perfecting the same, to wit, by Walter E. Wadman, and that the same was suggested to the said Charles A. Catlin by the said Walter E. Wadman.

Third. That said Charles A. Catlin was not the original and first inventor or discoverer of any material and substantial part of the thing patented, and that the following are the names and residences of the persons who have had knowledge and made use of the thing patented, and of every material and substantial part thereof, prior to the alleged invention thereof by said Charles A. Catlin, and the names of the places where such use was had and known:

Eben N. Horsford, of and at Cambridge, Massachusetts, and at other places;

The officers and employees of the Rumford Chemical Works, of and at Providence, R. I., and at other places;

Edwin B. Bangh, of and at Philadelphia, Pa., and at other places;

George F. Wilson, of and at East Providence, R. I., and at other places;

John E. Lauer, of and at New York, N. Y., and at other places.

William P. Clotworthy, of and at Baltimore, Md., and at other places;

Charles E. Catlin, of and at Providence, R. I., and at other places;

119 Carl V. Petraens, of and at Camden, New Jersey, and at other places;

Adolph Ciesecke, of and at Buffalo, New York, and at other places;

James W. Carson, of and at Philadelphia, Pa., and at other places;

Francis P. Harned, of and at Camden, N. J., and at other places;

John M. Hughes, of and at Brooklyn, N. Y., and at other places;

Edward N. Dickerson, Jr., of and at New York, N. Y., and at other places;

Charles Glaser and Charles F. W. Dambmann, both of and at Baltimore, Maryland, and at other places;

Nathaniel B. Powter, of and at New York, N. Y., and at other places;

John Orrett, of and at Kingston, Jamaica, and at other places;
Herbert E. Dennett, of and at Boston, Massachusetts, and at other places;
The officers and employees of the New York Baking Powder Co., of and at New York, N. Y., and at other places;
The officers and employees of the Provident Chemical Co., of and at St. Louis, Mo., and at other places;
The officers and employees of the Emerson Drug Co., of and at Baltimore, Md., and at other places;
The officers and employees of the Royal Baking Powder Co., of and at New York, N. Y., and Brooklyn, N. Y., and at other places;
John G. Finke, of and at New York, N. Y., and at other places;
Louis Hennomeier, Jr., of and at Jersey City, New Jersey, and at other places;
S. Elwood May, of and at New York, N. Y., and at other places;
Leopold Schepp, of and at New York, N. Y., and at other places;
120 Caspar B. Shafer, of and at Washington, D. C., and at other places;
William S. Sampson, of and at New York, N. Y., and at other places;
John C. Schuman, of and at Akron, Ohio, and at other places;
William T. Jebb, of and at Buffalo, New York, and at other places;
Joseph F. Gent, of and at Columbus, Indiana, and at other places;
Charles N. W. Foster, of and at Brookline, Mass., and at other places;
Russell S. Pennimann, of and at Jenkintown, Pa., and at other places;
John C. Schrader, of and at McCainsville, N. J., and at other places;
Newton M. Bell, of and at San Francisco, Cal., and at other places;
William R. Quinan, of and at San Francisco, Cal., and at other places;
John G. Kopping, John Weidman and Archibald B. Henry, all of and at Clinton, Iowa, and at other places;
James B. Herreshoff, now residing at Coronado Beach, San Diego County, California; at Pleasant Valley, North Providence, Rhode Island, and at East Providence, Rhode Island, and at other places;
James E. Heller, of New York, at Elizabethport, New Jersey, and New York, N. Y., and at other places;
The employees and members of the firm of Heller, Hirsch & Co., of and at New York, N. Y., and at other places;
Vincent C. Rice, of Waukegan, Illinois, at Chicago, Illinois, and at other places;
The officers and employees of the Price Baking Powder Company of and at Chicago, Illinois, and at other places;
Morris N. Hirsch, of and at Chicago, Illinois, and at other places;
121 The members of the firm and employees of Stein, Hirsch & Co., of and at Chicago, Illinois, and at other places;

The employees and members of the firm of Martin Kalbfleisch & Sons, of and at Brooklyn, N. Y., and at other places;

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Charles F. Herreshoff, of and at Bristol, R. I., and at other places;

John Wilson, of and at Elizabethport, N. J., and at other places;

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William Smith, of and at Elizabethport, N. J., and at other places;

Mary Boyle, of and at Elizabethport, N. J., and at other places;

122 James E. Barney, of Dorchester, Mass., at Pleasant Valley, North Providence and East Providence, R. I., and at other places;

David F. Whitaker, of and at Seekonk, R. I., and at other places;

Patrick Brady, now of Providence, R. I., of and at Pleasant Valley, R. I., and East Providence, R. I., and at other places;

Henry McElroy, now of Pawtucket, R. I., of and at East Providence, R. I., and at other places;

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and many others, whose names this defendant has not yet ascertained, but which it craves leave to insert in this answer as soon as ascertained.

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No. 14,722, issued April 22, 1856, to E. N. Horsford;

No. 41,815, issued March 1, 1864, to E. N. Horsford;

No. 42,140, issued March 29, 1864, to E. N. Horsford;
No. 45,631, issued December 27, 1864, to Potts & Klett;
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123 No. 47,610, issued May 9, 1865, for Improved Mode of Manufacturing Superphosphate of Lime, to Edwin P. Bangh;
No. 75,271, issued March 10, 1868, to E. N. Horsford;
No. 75,272, issued March 10, 1868, to E. N. Horsford;
No. 75,326, issued March 10, 1868, to George F. Wilson, for Improvement in the Preparation of Bones for the Manufacture of Phosphoric Acid and Phosphates;
No. 75,327, issued March 10, 1868, to George F. Wilson;
No. 75,328, issued March 10, 1868, to Gorge F. Wilson, for Improvement in the Manufacture of Acid Phosphates;
No. 75,329, issued March 10, 1868, to George F. Wilson;
No. 75,330, issued March 10, 1868, to George F. Wilson, for Improvement in Drying Acid Phosphates;
No. 75,331, issued March 10, 1868, to George F. Wilson, for Improved Process and Apparatus for the Manufacture of Acid Phosphates;
No. 75,332, issued March 10, 1868, to George F. Wilson;
No. 75,333, issued to George F. Wilson, March 10, 1868, for Improvement in Grinding and Pulverizing Acid Phosphates;
No. 75,334, issued to George F. Wilson, March 10, 1868, for Improvement in Granulating Acid Phosphates;
No. 75,335, issued March 10, 1868, to George F. Wilson;
No. 75,336, issued to George F. Wilson, March 10, 1868, for Improvement in the Manufacture of Phosphates and in Extracting Phosphoric Acid from Bones;
No. 75,337, issued to George F. Wilson and Eben N. Hors-
124 ford, March 10, 1868, for Improvement in Treating the Mixture of Acid Phosphate of Lime and Farinaceous matters in order to granulate them;
No. 75,338, issued to George F. Wilson and Eben N. Horsford, March 10, 1868, for Improved Process of Treating Acid Phosphates in the Manufacture of Yeast, Powder, &c.
No. 75,339, issued March 10, 1868, to George F. Wilson;
No. 86,275, issued January 26, 1869, to Henry Bower;
No. 86,594, issued February 2, 1869, to O. A. Moses;
No. 104,034, issued June 7, 1870, to E. N. Horsford;
No. 105,319, issued July 12, 1870, to Alfred Du Vall;
No. 106,147, issued August 9, 1870, to Frank & Adt;
No. 114,304, issued May 2, 1871, to F. J. Kimball;
No. 114,693, issued May 9, 1871, to George T. Lewis;
No. 128,752, issued July 9, 1872, to Pratt & Lewis;
No. 130,298, issued to Eben N. Horsford, August 6, 1872, for Improvement in the Manufacture of Phosphate of Lime and Yeast Powders;
No. 137,635, issued April 8, 1873, to Storck & Lyre;
No. 140,051, issued to John E. Lauer, June 17, 1873, for Improve-

ment in Manufacturing Crystal-ine Acid Phosphate of Lime for Yeast Powders;

No. 143,580, issued to John G. Kopping and John Weidemann, Oct. 14, 1873, for Baking Powder for Bread;

No. 195,142, issued Sept. 11, 1877, to James Mactean;

No. 206,930, issued to William H. Clotworthy, Aug. 13, 1878, for Improvement in Baking Powders;

No. 223,847, issued January 27, 1880, to J. F. Gent;

125 No. 229,518, issued to Charles A. Catlin, July 6, 1880, for Acid Phosphate for Baking Powders;

No. 238,570, issued to Charles A. Catlin, March 8, 1881, for Baking Powder;

No. 239,802, issued to Charles A. Catlin, April 5, 1881, for Baking Powder;

No. 256,832, issued to Adolph Giesecke, April 25, 1882, for Manufacture of Baking Powder;

No. 284,592, issued to Franz Dietrich, March 4, 1884, for Manufacture of Cream of Tartar;

No. 338,934, issued to James W. Carson and Francis P. Harned, March 30, 1886, for Manufacture of Blocks of Bicarbonate of Soda;

No. 352,465, issued to John N. Hughes, Nov. 9, 1886, for Compound Table Salt or Condiment;

No. 374,201, issued to Carl V. Petraens, Dec. 6, 1887, for Process of Making Acid Potassium Phosphates;

No. 389,566, issued Sept. 18, 1888, to Charles Glaser, for Process of Making Acid Phosphate;

No. 407,241, issued July 16, 1880, to Nathaniel B. Powter, for Phosphatic Fertilizer;

No. 417,710, issued Dec. 24, 1889, to Herbert E. Dennett, for Food Compound;

No. 215,341, issued to John G. Finke, May 13, 1879, for Granulated Chocolate;

No. 391,630, issued to Louis Hennemeier, Jr., October 23, 1888, for Cocoanut Compound;

No. 398,982, issued to Leopold Schepp, Feb. 19, 1889, for Cocoanut Compound;

No. 398,983, issued to Leopold Schepp, Feb. 19, 1889, for Cocoanut Compound;

No. 287,781, issued to Caspar B. Shafer, Oct. 30, 1883, for Medicated Effervescent Salts;

No. 155,043, issued to William S. Sampson, Sept. 15, 1874, for Methods of Preserving Lime;

No. 320,401, issued to John C. Schuman, June 16, 1885, for Method of Preparing and Treating Starch;

No. 304,722, issued to Joseph F. Gent, Sept. 9, 1884, for Art of Making a Product from Indian Corn known as Cerealine;

126 No. 350,532, issued to Charles H. W. Foster, Oct. 12, 1886, for Apparatus for Sifting Sugar;

No. 316,277, issued to James Macteer, April 21, 1885, for Apparatus for Making Granulated Crystal-ine Carbonate of Soda;

No. 312,010, issued to Russell S. Penniman, Feb. 10, 1885, for Protected Nitrate of Ammonia for use in Explosive Compounds;

No. 476,592, issued to Jesse Ascough, June 7, 1892, for Process of Making Borax;

No. 364,587, issued to Thomas Higgin, June 7, 1887, for Process of Separating Sand Scale, Hard Pan Scale and other Impurities from Salt;

No. 333,348, issued to John C. Schrader, Dec. 29, 1885, for Dynamite and Process of Making the Same;

No. 333,346, issued to John C. Schrader, Dec. 29, 1885, for Dynamite;

No. 449,064, issued to Newton M. Bell, M'ch 24, 1891, for Art of Manufacturing Borax;

No. 244,575, issued to Camille A. Faure, July 19, 1881 for Explosive Blasting Material;

No. 458,663, issued to Francis Ellershansen, Sept. 1, 1891, for Process of Making Caustic Alkali;

No. 260,786, issued to William E. Quinan, July 11, 1882, for Explosive Powder;

No. 300,281, issued to William R. Quinan, June 10, 1884, for Explosive Compound.

British Patents.

No. 9,977 of 1843;
No. 466 of 1852;
No. 910 of 1852;
No. 189 of 1855;
No. 2,161 of 1856;
No. 568 of 1860;
No. 2,082 of 1862;
No. 713 of 1864;
No. 320 of 1865;
127 No. 1,267 of 1868;
No. 924 of 1869;
No. 3,645 of 1869;
No. 514 of 1871;
No. 3,022 of 1871;
No. 3,160 of 1872;
No. 1,455 of 1875;
No. 1,249 of 1879;
No. 2,875 of 1880;
No. 5,115 of 1880;
No. 2,725 of 1882;
No. 6,208 of 1882;
No. 8,658 of 1884;
No. 984 of 1890.

French Patents.

No. 58,807 of 1863, Dufourmental & Poire;
No. 59,527 of 1863, Le Perdriel;

and in many others which this defendant has not yet ascertained, but which it craves leave to insert in this answer as soon as ascertained.

Fourth. That the thing patented in said Letters Patent has been described prior to said Charles A. Catlin's supposed invention or discovery thereof in the following named printed publications, all of which were publicly circulated in the United States prior to the said Charles A. Catlin's supposed invention or discovery, to wit:

In "Remington's Practice of Pharmacy," published at Philadelphia in the year 1885, by J. B. Lippincott Company, at Chapter XVI, page thereof.

In "Mineral Phosphate and Pure Fertilizers," by Campbell Morfit, published at London, England, in 1873, by , at page 316 thereof, article entitled "Manufacture of Superphosphate of Lime."

In "Donovan's Domestic Economy," published at London,
128 England, in the year 1842, Volume I thereof, at page 102.

In Dingler's Polytechnic Journal, published at Augsburg, Germany, in the year 1863, Volume 170, page 314.

In "Quantitive Analysis," by C. Freservius, published at in the year 1865, at page 37.

In "Quantitive Analysis," by Classen, Fourth Edition, published at in the year 1891, at page 4.

In Kamarsch & Heeren, Technical Dictionary, published at in the year 1880, Volume 4, page 465.

In National Dispensary, published at in the year 1887, at page 1257.

In Muspratt's Chemical Encyclopedia, published at in the year 1878, Third Edition, at pages 1566 and 1627.

In Wurtz Dictionaire de Chimie, published at in the year 1876, Volume 2, page 1167.

In Miller's Elements of Chemistry, published at in the year 1868, part 2, pages 815-816.

In Mendelies' Principles of Chemistry, published at in the year 1870, Volume 1, pages 38 and 39;

and in many others which this defendant has not yet ascertained, but which it craves leave to insert in this answer as soon as ascertained.

Fifth. That the thing patented in said Letters Patent had been in public use and on sale in this country for more than two years before the said Charles A. Catlin's application for a patent, and that the persons hereinabove named as having had prior knowledge and use of the said alleged invention, and many others, knew of
129 such prior public use and sale as did also said Charles A. Catlin.

And this defendant, further answering, upon information and belief, says that said Letters Patent do not disclose or show any invention whatsoever in view of the state of the art in the manufacture of baking powder, soda, cream of tartar, phosphoric acid, acid phosphates, &c., and many other articles which existed at and long before the time when it is alleged in the complainant's said bill of complaint that the said Charles A. Catlin made his alleged invention; and that in view of the state of the art the said Charles A. Catlin has not, in his said Letters Patent, disclosed any new or patentable

invention whatsoever, but that the alleged invention involves, if anything, simply mechanical skill and judgment.

And this defendant denies that the complainant has gone to great or any expense and trouble in preparing for the manufacture of, in manufacturing, in placing it on the market, and introducing into use baking preparations manufactured in accordance with and embodying the alleged invention set forth in said Letters Patent; that the baking preparations so made and introduced and embodying said alleged invention have attained a general and widespread popularity, and are universally recognized as possessing superior qualities; that the public generally and manufacturers and dealers in all parts of the United States have recognized and acquiesced in the alleged exclusive rights of the complainant, and that but for the alleged infringement and wrongs specified in the bill of complaint, the complainant would now be in the peaceful possession and enjoyment of all the alleged rights and privileges granted under said Letters Patent and of the income derivable therefrom; and on the contrary this defendant alleges that the public generally, manufacturers and dealers throughout the United States are in arms against the unjust
130 and inequitably secured monopoly represented by said Letters Patent, and are severally doing their utmost to establish the fraudulent character of such monopoly to the extent of contesting the said patent in all judicial districts in the United States wherever suit is brought against any of them.

And this defendant, answering the fifth paragraph of the bill of complaint, denies that it has jointly with James A. Heller, Adolph Hirsh and the Hygienic Chemical Company (of New Jersey), and each of them, within the Southern District of New York, or anywhere, unlawfully and wrongfully made and used and vended, or caused to be made and used and vended, baking powder substantially as described in said Letters Patent; and denies further that it continues to do so jointly with the aforesaid persons or threatens to continue such alleged unlawful acts to a large or any extent.

And this defendant, answering the eighth paragraph of the bill of complaint, denies that it participated in the defense of the suit of Rumford Chemical Works against New York Baking Powder Company, either financially or otherwise, and that it was at the time engaged in manufacturing and selling granular acid phosphate like or similar to the article put out by the said New York Baking Powder Company.

And this defendant alleges as a separate and distinct defense that there is now pending undetermined in the United States Circuit Court for the Southern District of New York a suit, entitled Rumford Chemical Works against Hygienic Chemical Company (of New York) and others, involving the same patent, the same issues, the same parties, and that the pendency of such suit is a bar to the present suit, except as to a baking powder or acid phosphate made by this defendant prior to the institution of the old suit aforesaid.

And this defendant, further answering, upon information and belief, alleges, and will prove, that the invention alleged to
131 have been made by the said Charles A. Catlin, or disclosed in said Letters Patent, was old at the time of the alleged mak-

ing thereof by said Charles A. Catlin, and was at that time a common and well known means of attaining the object sought to be attained by said Charles A. Catlin, and that the same was constantly being used in the manufacture of such articles as baking powder, soda, cream of tartar, phosphoric acid, acid phosphates, and other articles, and that therefore said Letters Patent are void.

And this defendant denies all and all manner of unlawful acts wherewith it is by the said bill charged. All which matters and things this defendant is ready and willing to prove as this Honorable Court shall direct, and it humbly prays to be hence dismissed, with its reasonable costs and charges in this behalf most wrongfully sustained.

HYGIENIC CHEMICAL COMPANY
(OF NEW YORK),
By ADOLPH HIRSH, *Treas., Defendant.*

ARTHUR v. BRIESEN,
Solicitor for Defendant and of Counsel.

(Endorsed:) Filed Oct. 19, 1904.—Southern District of New York.—John A. Shields, Clerk.

132 At a Stated Term of the Circuit Court for the Southern District of New York, held at the Court Room thereof in the Post Office Building, in the City of New York, in the State of New York, on the — day of ——, 1904.

Present: Hon. E. Henry Lacombe, U. S. C. Judge.

In Equity. No. —.

RUMFORD CHEMICAL WORKS
vs.
HYGIENIC CHEMICAL COMPANY (OF NEW YORK), HYGIENIC CHEMICAL COMPANY (OF NEW JERSEY).

Order to Dismiss Bill of Complaint as Against One of the Defendants.

Upon the bill of complaint and the plea to the jurisdiction filed herein on behalf of the Hygienic Chemical Company (of New Jersey), the solicitor for the said defendant consenting thereto, and upon motion of Elisha K. Camp, Esq., solicitor for complainant herein, it is ordered, that the bill of complaint herein be and the same hereby is dismissed, with costs as against the Hygienic Chemical Company (of New Jersey), without prejudice.

E. H. LACOMBE, *U. S. C. J.*

(Filed Oct. 26, 1904.)

133 Circuit Court of the United States, Southern District of New York.

RUMFORD CHEMICAL WORKS
against
HYGIENIC CHEMICAL COMPANY, JAMES E. HELLER, and ADOLPH HIRSH.

Upon the annexed consent of the attorneys, and upon motion of Willard Parker Butler, of counsel for defendant, it is

Ordered, that Whitridge, Butler & Rice, of 59 Wall street, be and the same hereby are substituted as solicitors for the defendants and each of them in the above entitled suit, in place of Briesen & Knauth.

Dated New York, November 25, 1905.

E. HENRY LACOMBE,
U. S. C. J.

We consent to the entry of the above order.

BRIESEN & KNAUTH,
WHITRIDGE, BUTLER & RICE.

134 Circuit Court of the United States, Southern District of New York.

RUMFORD CHEMICAL COMPANY, Complainant,
against
HYGIENIC CHEMICAL COMPANY (of New York), JAMES E. HELLER, and ADOLPH HIRSH, Defendants.

It is hereby stipulated and agreed by the defendant herein, James E. Heller, through his solicitors, Messrs. Whitridge, Butler & Rice, pursuant to the directions and conditions contained in the order of Hon. E. Henry Lacombe, Circuit Judge, vacating the decree *pro confesso* heretofore entered herein against the said defendant, James E. Heller, duly made and entered herein on or about the 12th day of April, 1906, that the answer of the defendants Hygienic Chemical Company of New York and Adolph Hirsh, heretofore filed herein in the office of the Clerk of the Court, on or about the 19th day of October, 1904, is hereby adopted as the answer of the said defendant, James E. Heller, with the same force and effect as if the said James E. Heller had been an original party to said answer; and it is further

Stipulated that the evidence already taken in this case shall stand with the same legal force and effect as if it had been taken after such answer had been filed by the said James E. Heller, and notice of the taking of said evidence duly given to him, and shall have
135 the same force and effect as it would have had if the said James E. Heller had duly appeared upon the hearing of said evidence and the witnesses had been cross-examined on his behalf; and it is further

Stipulated that the replication filed by the complainant to the said answer of the defendants Hygienic Chemical Company and Adolph Hirsh shall stand with full force and effect to the answer of the said James E. Heller, as if it had been duly filed after said answer had been, and that no further replication need be filed by said complainant.

Dated New York, April 16, 1906.

JAMES E. HELLER,
By WHITRIDGE, BUTLER & RICE,
His Solicitors.

136 United States Circuit Court, Southern District of New York.

In Equity. No. 8812.

RUMFORD CHEMICAL WORKS
against
HYGIENIC CHEMICAL COMPANY, JAMES E. HELLER, and ADOLPH HIRSH.

Elisha K. Camp (Philip Mauro and C. A. L. Massie, of Counsel), for Complainant.

Whitridge, Butler & Rice (Willard Parker Butler and Edwin T. Rice, of Counsel), for Defendants.

HOLT, *J.:*

The decision of Judge Cross in the New Jersey suit, although not technically *res adjudicata,* ought, in my opinion, to be held to be controlling by this Court. Moreover, I concur with the conclusions of Judge Cross on the merits.

The bill is dismissed, with costs.

April 12, 1907. G. C. H.

(Endorsed:) United States Circuit Court, Southern District of New York.—Rumford Chemical Works against Hygienic Chemical Company, James E. Heller and Adolph Hirsh.—Memorandum, Holt, J.—U. S. Circuit Court, Southern District, New York.—Filed Apr. 12, 1907.—John A. Shields, Clerk.

137 At a Stated Term of the Circuit Court of the United States for the Southern District of New York, held in the Court Rooms thereof in the Post Office Building, in the City of New York, State of New York, on the 24th day of April, 1907.

Present: Hon. George C. Holt, U. S. District Judge.

In Equity. No. 8812.

RUMFORD CHEMICAL WORKS, Complainant,
vs.
HYGIENIC CHEMICAL COMPANY (of New York), JAMES E. HELLER, and ADOLPH HIRSH, Defendants.

This cause having come on to be heard upon the pleadings and proofs, and after hearing C. A. L. Massie, Esq., on the part of the

complainant, and Edwin T. Rice, Esq., on the part of the defendants, and due deliberation having been had,

Now, on motion of Messrs. Whitridge, Butler & Rice, Solicitors for the defendants, it is

Ordered, adjudged and decreed, that the bill of complaint herein be and the same hereby is dismissed, with costs to the defendants, to be taxed.

GEO. C. HOLT,
U. S. Judge.

Approved as to form.
C. A. L. MASSIE,
Solicitor for Complainant.

(Endorsed:) United States Circuit Court, Southern District of New York.—Rumford Chemical Works, Complainant, *vs.* Hy-
138 gienic Chemical Company (of New York), James E. Heller and Adolph Hirsh, Defendants.—Decree.—Whitridge, Butler & Rice, Attorneys for Defts., 59 Wall St., New York, N. Y.—U. S. Circuit Court, Southern District, N. Y.—Filed Apr. 24, 1907.—John A. Shields, Clerk.

In the Circuit Court of the United States for the Southern District of New York.

In Equity. No. 8812.

RUMFORD CHEMICAL WORKS
vs.
HYGIENIC CHEMICAL COMPANY, JAMES E. HELLER, and ADOLPH HIRSH.

To John A. Shields, Esq., Clerk of the said Court.
To Messrs. Whitridge, Butler & Rice, Solicitors and of Counsel for Defendants, 59 Wall Street, New York City.

GENTLEMEN: Please take notice that the complainant, the Rumford Chemical Works, hereby appeals to the United States Circuit Court of Appeals for the Second Circuit from the final decree entered in the office of the Clerk of this Court in the above entitled
139 cause on the 24th day of April, 1907.

Dated New York City, July 31, 1907.

Yours respectfully, ELISHA K. CAMP,
Solicitor for Complainant.

PHILIP MAURO,
C. A. L. MASSIE,
Of Counsel.

Due service of the foregoing notice is hereby admitted this 2d day of August, 1907.

WHITRIDGE, BUTLER & RICE.
Solicitors and of Counsel for Defendants.

(Endorsed:) In the Circuit Court of the United States for the Southern District of New York.—Rumford Chemical Works *vs.* Hygienic Chemical Co., James E. Heller and Adolph Hirsh.—In Equity, No. 8812.—Notice of Appeal.—Philip Mauro, C. A. L. Massie, Of Counsel for Complainant, Tribune Building, New York City.—A copy of the within paper has been this day received at this office, Aug. 2, 1907, Whitridge, Butler & Rice.—U. S. Circuit Court, Southern District, New York.—Filed Aug. 2, 1907.—John A. Shields, Clerk.

140 In the Circuit Court of the United States for the Southern District of New York.

In Equity. No. 8812.

RUMFORD CHEMICAL WORKS
vs.
HYGIENIC CHEMICAL COMPANY, JAMES E. HELLER, and ADOLPH HIRSH.

Appeal.

The above named complainant, the Rumford Chemical Works, conceiving itself aggrieved by the final decree made and entered herein on April 24, 1907, does hereby appeal from said final decree to the United States Circuit Court of Appeals for the Second Circuit, for the reasons specified in the assignment of errors herewith, and prays that this its appeal may be allowed, that a transcript of the records and papers upon which said decree was made, and of all the proceedings in the case, duly authenticated, may be sent to the United States Circuit Court of Appeals for the Second Circuit.

Dated New York City, July 31, 1907.

ELISHA K. KAMP,
Solicitor for Complainant.

PHILIP MAURO,
C. A. L. MASSIE,
Of Counsel.

141 The foregoing appeal is allowed.
Dated New York City, July 31, 1907.

E. H. LACOMBE,
U. S. C. Judge.

(Endorsed:) In the Circuit Court of the United States for the Southern District of New York.—Rumford Chemical Works *vs.* Hygienic Chemical Co., James E. Heller and Adolph Hirsh.—In Equity, No. 8812.—Appeal.—Philip Mauro, C. A. L. Massie, of Counsel for Complainant, Tribune Building, New York City.—A copy of the within paper has been this day received at this office. Aug. 2, 1907. Whitridge, Butler & Rice.—U. S. Circuit Court, Southern District, N. Y.—Filed Aug. 2, 1907.—John A. Shields, Clerk.

In the Circuit Court of the United States for the Southern District of New York.

In Equity. No. 8812.

RUMFORD CHEMICAL WORKS
vs.
HYGIENIC CHEMICAL COMPANY, JAMES E. HELLER, and ADOLPH HIRSH.

Assignment of Errors.

And now comes the said complainant, the Rumford Chemical Works, by its solicitor, and having prayed an appeal to the United States Circuit Court of Appeals for the Second Circuit from
142 the final decree of the said Circuit Court, entered in this cause on April 24, 1907, respectfully represents as grounds of appeal and as an assignment of errors herein that the Circuit Court erred in the following particulars:

1. In ordering the bill of complaint dismissed, with costs to the defendants to be taxed.

2. In not sustaining the bill of complaint in all respects, with costs to complainant to be taxed.

3. In not holding that the patent in suit has been infringed by each one of the defendants herein, and in not awarding an injunction and an accounting, with costs against each one of the defendants.

4. In not holding that the patent in suit has been infringed by the defendant, Hygienic Chemical Company, and awarding an injunction and an accounting against the said defendant, with costs.

5. In not holding that the patent in suit has been infringed by the defendant James E. Heller, and in not awarding an injunction and an accounting, with costs, against him.

6. In not holding that the patent in suit has been infringed by the defendant Adolph Hirsh, and in not awarding an injunction and an accounting, with costs, against him.

7. In not holding that for the purpose of this suit the defendant Hygienic Chemical Company is a mere shield or cloak or trade-name for the individual defendants Heller and Hirsh, and in not holding that the said defendants Heller and Hirsh (and the said defendant corporation) were jointly and severally privies to the defense of a certain suit formerly pending in this Court, entitled "Rumford Chemical Works *vs.* New York Baking Powder Company *et al.*," and decided by the United States Circuit Court of Appeals
143 for the Second Circuit, as reported in 134 Fed. Rep., 385.

8. In not admitting the testimony of the deceased witness Clotworthy, who testified in the former suit, and in not admitting Arnold's testimony as to what Clotworthy said in the former suit.

9. In not finding that the testimony of the defendant Heller herein (and his testimony in the said former suit) proves that the defend-

ants herein, and each of them, have infringed the patent here in suit.

10. In not holding that the evidence shows that the individual defendants, acting individually and through the defendant corporation, have made and sold acid phosphate, essentially granular, for the purpose and with the intention that the same should be used as an ingredient of a baking preparation, thereby constituting contributory infringement of the patent in suit.

11. In not holding that there is no proof that acid phosphate essentially granular (and such as made and sold by the defendants) has any use, or was ever used, except as an ingredient for baking powders or baking preparations, and in not holding that the sale by defendants of such form of acid phosphate constitutes contributory infringement of the patent in suit.

12. In not awarding three-fold damages in favor of the complainant and against each of the three defendants.

1v. In not awarding to complainant its counsel fees, on account of these defendants having constrained complainant to bring a separate suit in the Circuit Court of the United States for the District of New Jersey against the Hygienic Chemical Company (of
144 New Jersey); or, at least, in not awarding a suitable allowance as counsel fees and disbursements on account of said suit in New Jersey.

Wherefore, the complainant prays that the final decree aforesaid may be reversed, and that the said Court may be directed to enter a decree sustaining the bill of complaint and awarding a perpetual injunction and an accounting against each of the three defendants herein, directing that the damages ascertained be tripled, and awarding to complainant not only its costs but counsel fees.

Dated New York City, July 29, 1907.

ELISHA K. CAMP,
Solicitor for Complainant-Appellant.

PHILIP MAURO,
C. A. L. MASSIE,
Of Counsel for Complainant-Appellant.

Office and Post Office address, 154 Nassau Street, Borough of Manhattan, City of New York.

(Endorsed:) In the Circuit Court of the United States, for the Southern District of New York.—Rumford Chemical Works *vs.* Hygienic Chemical Co., James E. Heller and Adolph Hirsh.—In Equity, Docket No. 8812.—Assignment of Errors.—Philip Mauro, C. A. L. Massie, of Counsel for Complainant, Tribune Building, New York City.—U. S. Circuit Court, Southern District, N. Y.—Filed Jul- 29, 1907.—John A. Shields, Clerk.

145 In the Circuit Court of the United States for the Southern District of New York.

In Equity. No. 8812.

RUMFORD CHEMICAL WORKS
vs.
HYGIENIC CHEMICAL COMPANY ET AL.

It is hereby stipulated by and between the solicitors for the respective parties hereto, that, whereas the above named complainant is about to appeal to the United States Circuit Court of Appeals for the Second Circuit from a decree entered herein on or about the 24th day of April, 1907, the entry of a bond as security for costs by the appellant on said appeal is hereby waived.

Dated July 11, 1907.

ELISHA K. CAMP,
Solicitor for Complainant.

(Sgd.) WHITRIDGE, BUTLER & RICE,
Solicitors for Defendants.

Ordered accordingly.

E. H. LACOMBE,
U. S. C. J.

(Endorsed:) In the Circuit Court of the United States for the Southern District of New York.—Rumford Chemical Works *vs.* Hygienic Chemical Co., James E. Heller and Adolph Hirsh.—In Equity, Docket No. 8812.—Stipulation and Order waiving Bond on Appeal.—Philip Mauro, C. A. L. Massie, of Counsel for Complainant, Tribune Building, New York City.—U. S. Circuit Court, Southern District, N. Y.—Filed Aug. 2, 1907.—John A. Shields, Clerk.

146 By the Honorable E. Henry Lacombe, one of the Judges of the Circuit Court of the United States for the Southern District of New York, in the Second Circuit.

To Hygienic Chemical Company, a New York Corporation, James E. Heller and Adolph Hirsh, and each of you, Greeting:

You are hereby cited and admonished to be and appear before a United States Circuit Court of Appeals for the Second Circuit, to be holden at the Borough of Manhattan, in the City of New York, in the District and Circuit above named, on the 29th day of August, 1907, pursuant to an appeal filed in the Clerk's office of the Circuit Court of the United States for the Southern District of New York, wherein Rumford Chemical Works is complainant-appellant, and you are defendant appellees, to show cause, if any there be, why the decree in said appeal mentioned should not be corrected and speedy justice should not be done in that behalf.

Given under my hand at the Borough of Manhattan, in the City

of New York, in the District and Circuit above named, this 31st day of July, in the year of our Lord one thousand nine hundred and seven, and of the Independence of the United States the one hundred and thirty-second.

E. H. LACOMBE,
Judge of the Circuit Court of the United States for the Southern District of New York, in the Second Circuit.

(Endorsed:) United States Circuit Court of Appeals for the Second Circuit.—Rumford Chemical Works, Complainant-Appellant, *vs.* Hygienic Chemical Company, James E. Heller and Adolph Hirsh, Defendants-Appellees.—Citation.—A copy of the within paper has been this day received at this office, Aug. 2, 1907, Whitridge, Butler & Rice.—U. S. Circuit Court, Southern District, N. Y.—Filed Aug. 2, 1907.—John A. Shields, Clerk.

147 UNITED STATES OF AMERICA,
Southern District of New York, ss:

I, John A. Shields, Clerk of the Circuit Court of the United States of America for the Southern District of New York, in the Second Circuit, do hereby certify that the foregoing pages, numbered from 1 to 148 inclusive, contain a true and complete transcript of the record and proceedings had in said Court, in the cause entitled Rumford Chemical Works, Complainant-Appellant, against Hygienic Chemical Company, James E. Heller and Adolph Hirsh, Defendants-Appellees, as the same remain of record and on file in my office.

In testimony whereof, I have caused the seal of the said Court to be hereunto affixed, at the City of New York, in the Southern District of New York, in the Second Circuit, this — day of August, in the year of our Lord one thousand nine hundred and seven and of the Independence of the said United States the one hundred and thirty-second.

[SEAL.] JOHN A. SHIELDS, *Clerk.*

148 In the Circuit Court of the United States for the Southern District of New York.

In Equity. No. 8812.

RUMFORD CHEMICAL WORKS
vs.
HYGIENIC CHEMICAL COMPANY ET AL.

To Messrs. Whitridge, Butler & Rice, Solicitors for Defendants, 59 Wall St., New York City.

GENTLEMEN: Please take notice that upon the calling of this cause for final hearing we shall ask leave to offer in evidence *nunc pro tunc* and read a certified copy of the Final Decree now on file in this Court in the suit entitled Rumford Chemical Works *vs.*

New York Baking Powder Company, *et al.*,—a copy of which has this day been served upon you.

C. A. L. MASSIE,
Of Counsel for Complainant.

Dated Sept. 21, 1906.

Service of the foregoing notice and copy of the above-mentioned decree is hereby admitted this 21st day of September, 1906.

WHITRIDGE, BUTLER & RICE,
Solicitors for Defendants.

149 At a Stated Term of the Circuit Court of the United States for the Southern District of New York, held in the Court Room thereof in the Post Office Building in the Borough of Manhattan and City of New York, this 10th day of May, 1905.

Present: Hon. E. Henry Lacombe, U. S. Circuit Judge.

In Equity. No. 7532.

RUMFORD CHEMICAL WORKS, Complainant,
vs.
NEW YORK BAKING POWDER COMPANY, PROVIDENT CHEMICAL WORKS, and FRANKLIN P. GORDON, Defendants.

Final Decree.

An Interlocutory Decree having been entered herein on or about October 1, 1904, sustaining the validity of the Catlin patent No. 474,811, here in suit, and complainant's exclusive ownership thereof, finding infringement by the two corporations defendant, and awarding a perpetual injunction with a reference for an accounting of profits and damages, together with taxable costs;

And the said cause coming on to be heard further on this day, upon consent of both parties corporations, and it being represented to the Court that defendant corporations have paid to said complainant and that said complainant has received in full its taxable costs herein, and full satisfaction of all claims for damages and profits decreed to be paid by the interlocutory decree hereinbefore recited, and the fees of the Master and all costs upon said accounting having been paid;

150 Now, upon motion of complainant's solicitor and upon the annexed consent by the solicitors for the corporations defendant, the Court doth make this its final decree, viz: It is hereby

Adjudged, ordered, and decreed that the complainant Rumford Chemical Works is a corporation of the State of Rhode Island entitled to maintain this suit, and is possessed of the sole and exclusive right, title and interest in and to the said letters patent No. 474,811; that the said letters patent No. 474,811, granted May 17, 1892, for Improvement in Baking Preparations, are good and valid in law; and that the defendants New York Baking Powder Company and Provident Chemical Works have infringed upon said letters patent and upon the complainant's rights thereunder, by making and

using and vending to others to be used, baking preparations made according to and employing or containing the invention described and set forth in said letters patent No. 474,811, and claimed in the Claims thereof; it is further

Adjudged, ordered, and decreed that there shall be no further costs to either party corporation as against the other; and it is further

Adjudged, ordered, and decreed that the perpetual injunction heretofore granted herein be and the same hereby is confirmed and continued.

(Signed) E. H. LACOMBE, *U. S. C. J.*

We hereby consent to the entry and filing of the foregoing final decree.

(Signed) BRIESEN & KNAUTH,
Solicitors for Defendants, New York Baking Powder Co., and Provident Chemical Works.

(Signed) ELISHA K. CAMP,
Solicitor for Complainant.

(Filed May 10, 1905.)

151 UNITED STATES OF AMERICA,
Southern District of New York, ss:

I, John A. Shields, Clerk of the Circuit Court of the United States in and for the Second Circuit and Southern District of New York,

Do hereby certify that I have compared the preceding with the original decree on file and of record in my office, and that the same is a true and correct transcript therefrom, and of the whole of said original.

In testimony whereof, I have hereunto set my hand and affixed the Seal of said Court, at the City of New York, in the District and Circuit above named, this 21st day of Sept., in the year of our Lord, one thousand nine hundred and six and of the independence of the United States the one hundred and thirty-first.

[SEAL.] JOHN A. SHIELDS, *Clerk.*

Endorsed: In the Circuit Court of the United States for the Southern District of New York. Rumford Chemical Works, *vs.* Hygienic Chemical Company, James E. Heller and Adolph Hirsh. In Equity Docket No. 8812. Notice and Certified Copy of Final Decree in Rumford Chemical Works *vs.* N. Y. Baking Powder Co., *et al.* Philip Mauro, of counsel for Complainant, 90 West Broadway, New York City. To Whitridge, Butler & Rice, Esqs., Solicitors for Defendants. U. S. Circuit Court, Southern District of New York, Filed Apr. 12, 1907, John A. Shields, Clerk.

152 In the Circuit Court of the United States for the Southern District of New York.

In Equity. No. 8812.

RUMFORD CHEMICAL WORKS
vs.
HYGIENIC CHEMICAL COMPANY, JAMES E. HELLER, and ADOLPH HIRSH.

Messrs. Whitridge, Butler & Rice, Solicitors and of Counsel for Defendants, 59 Wall Street, New York City.

GENTLEMEN: Please take notice that at the argument of the case we shall produce a printed copy of the entire deposition of the deceased witness Clotworthy given in the former suit pending in this Court entitled Rumford Chemical Works against the New York Baking Powder Company *et al.* and now on file in this Court, said printed copy being a part of the official transcript on appeal in the Court of Appeals for this District, and found on pages 201-229, and 252-265 thereof. A copy of the same is herewith handed to you.

Yours respectfully, C. A. L. MASSIE,
Of Counsel for Complainant.

Dated Jan. 9, 1907.

Endorsed: "A copy of the within paper has been this day received at this office Jan. 9, 1907, Whitridge, Butler & Rice, Sol'rs for D'f'ts." In the Circuit Court of the United States for the Southern District of New York. Rumford Chemical Works *vs.* Hygienic Chemical Co. *et al.* In Equity Docket No. 8812. Notice of Motion and Affidavit. Philip Mauro and C. A. L. Massie of Counsel for Complainant, 90 West Broadway, New York City. To Whitridge, Butler & Rice, Esqs., Solicitors & of Counsel for Def'ts. U. S. Circuit Court, Southern District of New York, Filed Apr. 12, 1907, John A. Shields, Clerk.

153 UNITED STATES OF AMERICA,
Southern District of New York, ss:

I, John A. Shields, Clerk of the Circuit Court of the United States of America for the Southern District of New York, in the Second Circuit, do hereby certify that the foregoing pages, numbered from one to five, inclusive, are a part of the transcript of the record and proceedings had in said Court, in the cause entitled Rumford Chemical Works, complainant-appellant, against Hygienic Chemical Company, James E. Heller and Adolph Hirsh, defendants-appellees, as the same remain of record and on file in my office; and that as a part of the records and proceedings had in said Court in said cause the foregoing five pages should have been included in the transcript of the record and proceedings originally certified by me to the Circuit Court of Appeals, for the Second Circuit, but were omitted

from the said original transcript through accident, inadvertence, or mistake.

In testimony whereof, I have caused the seal of the said Court to be hereunto affixed, at the City of New York, in the Southern District of New York, in the Second Circuit, this second day of April, in the year of our Lord One thousand Nine Hundred and Eight, and of the independence of the United States the one hundred and thirty-second.

[SEAL.] JOHN A. SHIELDS, *Clerk.*

Endorsed: Rumford Co. *v.* Hygienic Co. Additional record. United States Circuit Court of Appeals, Second Circuit. Filed Apr. 3, 1908. William Parkin, clerk.

154 United States Circuit Court of Appeals for the Second Circuit.

No. 148, October Term, 1907.

Argued January 21, 1908; Decided February 11, 1908.

RUMFORD CHEMICAL WORKS, Complainant-Appellant,
vs.
HYGIENIC CHEMICAL COMPANY ET AL., Defendants-Appellees.

Appeal from the Circuit Court of the United States for the Southern District of New York.

Before Judges Lacombe, Coxe, and Noyes.

On appeal from a decree of the Circuit Court for the Southern District of New York dismissing the bill in equity suit based upon Letters Patent, No. 474,811, granted to Charles A. Catlin for an improvement in baking powders. The patent was sustained by the court in a suit by complainant against New York Baking Powder Company *et al.*, (134 *Fed.* 385). The bill was dismissed because of the failure to prove infringement, the Circuit Court being of the opinion that a decision of the Circuit Court for the District of New Jersey in *Rumford Chemical Works v. Hygienic Chemical Company* (148 *Fed.* 862), was controlling upon the question of infringement.

Philip Mauro, for the Appellant.

W. P. Butler and E. T. Rice, for the Appellees.

155 COXE, *Circuit Judge:*

The defendants charged with infringement are Hygienic Chemical Company of New York, James E. Heller and Adolph Hirsh, the first two defendants contributing to the defense in the so-called test case against the New York Baking Powder Company in which the validity of the Catlin patent was upheld by this court. In that case Heller testified that he was interested in the defense financially

and otherwise and that the Hygienic Chemical Company located at Elizabethport, New Jersey, manufactured acid phosphate for baking powder and other purposes. He testified further as follows: "We are manufacturers of granulated acid phosphate, and are selling it to the trade in the same way as the parties who are sued in this case, the Provident Chemical Works of St. Louis."

Heller was sworn in the case at bar and says his answers in the former case were true.

Whether intended to be so or not, there is no doubt that the suit against the New York Baking Powder Company was, in fact, a test case and is controlling in this court upon all questions there decided. If there were any doubt as to what those questions are we could take judicial notice of the records of our own court for the purpose of informing ourselves, but there is no doubt upon any issue now in controversy.

We are of the opinion that their participation in the defense of the test suit made the defendants, Heller and the New York Hygienic Company, parties privy to that suit and that the testimony of Clotworthy given therein may properly be read against these defendants—Clotworthy having died prior to the hearing. From this testimony it appears that March 13, 1901, the Clotworthy Chemical Co. bought of the Hygienic Chemical Co. a barrel of *special* phosphate and paid for it March 25, 1901, the receipt being signed by The Hygienic Co. It is true that the billhead describes the Hygienic Co. as "of New Jersey, Manufacturing Chemists, Offices 62 & 64 William St., New York City." But in view of the undisputed fact that the New Jersey Co. manufactured and did not sell and the New York Company sold and did not manufacture, we think enough appeared to put the defendants upon their proof. The presumption is that the sale was made by the New York Co. The defendants say in their brief, that "The Hygienic Chemical
156 Company of New York is a selling company as distinguished from a manufacturing company, and sells the product of the defendant and other manufacturers."

Clotworthy testified in the former suit that he was a baking powder manufacturer at Baltimore and that he purchased a barrel or two of granular phosphate from the Hygienic Chemical Company of New York and sold it to the complainant, the price being about eight and a half cents per pound for the granular and five and a half cents for the ordinary commercial phosphate.

The Catlin patent was upheld because the inventor had succeeded in getting rid of the fine powder which was supposed to be indispensable to success, and used a powder in a uniformly granulated condition. It is, therefore, the use of such powder which constitutes infringement and when a manufacturer of acid phosphates sells a manufacturer of baking powder a barrel of granular acid phosphate the presumption is not unfair that he expects it to be used for baking powder.

There is testimony tending to show that "special" phosphate is specially adapted for use in making baking powder.

It is unnecessary to pursue the subject farther, as we are of the

opinion, in view of all the facts and circumstances of the case, that a *prima facie* case of contributory infringement is established.

The case differs from the New Jersey suit in the very important particular that the New Jersey corporation made no contribution to the defense of the test case and is not privy thereto.

The incorporation of two companies under the same name has tended to create confusion but for this the complainant can hardly be held responsible.

In the case of *Hutter v. Stopper Co.*, (128 *Fed.* 283), this court having under consideration a somewhat similar situation said, at page 286, "If the complainant's witnesses were mistaken, a few words of denial would have saved years of protracted and expensive litigation. The fact that no denial was vouchsafed is persuasive that it could not have been made truthfully."

157 The decree is reversed with costs against the defendants Heller and Hygienic Chemical Company of New York and the cause is remanded to the Circuit Court with instructions to enter a decree against these defendants for an injunction and an accounting with costs.

158 At a Stated Term of the United States Circuit Court of Appeals, in and for the Second Circuit, held at the Court Rooms in the Post Office Building in the City of New York, on the 21st day of February one thousand nine hundred and eight.

Present: Hon. E. Henry Lacombe, Hon. Alfred C. Coxe, Hon. Walter C. Noyes, Circuit Judges.

RUMFORD CHEMICAL WORKS, Complainant-Appellant,

vs.

HYGIENIC CHEMICAL COMPANY ET AL., Defendants-Appellees.

Appeal from the Circuit Court of the United States for the Southern District of New York.

This cause came on to be heard on the transcript of record from the Circuit Court of the United States, for the Southern District of New York, and was argued by counsel.

On consideration whereof, it is now hereby ordered, adjudged and decreed that the decree of said Circuit Court be and it hereby is reversed with costs against the defendants Heller and Hygienic Chemical Company and cause remanded to the Court below with instructions to enter a decree against these defendants for an injunction and an accounting with costs.

It is further ordered that a Mandate issue to the said Circuit Court in accordance with this decree.

A. C. C.
W. C. N.

159 Endorsed: United States Circuit Court of Appeals, Second Circuit. Rumford Chemical Works *vs.* Hygienic Chemical Co. Order for Mandate. United States Circuit Court of Appeals Second Circuit Filed Feb. 21, 1908 William Parkin Clerk.

160 UNITED STATES OF AMERICA,
Southern District of New York, ss:

I, William Parkin, Clerk of the United States Circuit Court of Appeals for the Second Circuit do hereby Certify that the foregoing pages, numbered from 1 to 159 inclusive, contain a true and complete transcript of the record and proceedings had in said Court, in the case of Rumford Chemical Works against Hygienic Chemical Company et al. as the same remain of record and on file in my office, and as agreed by counsel.

In Testimony Whereof, I have caused the seal of the said Court to be hereunto affixed, at the City of New York, in the Southern District of New York, in the Second Circuit, this 3d day of April in the year of our Lord One Thousand Nine Hundred and Eight and of the Independence of the said United States the One Hundred and thirty-second.

[Seal United States Circuit Court of Appeals, Second Circuit.]

WM. PARKIN, *Clerk.*

161 UNITED STATES OF AMERICA, *ss:*

The President of the United States of America to the Honorable the Judges of the United States Circuit Court of Appeals for the Second Circuit, Greeting:

[Seal of the Supreme Court of the United States.]

Being informed that there is now pending before you a suit in which The Rumford Chemical Works is appellant and The Hygienic Chemical Company, James E. Heller, and Adolph Hirsh, are appellees, which suit was removed into the said Circuit Court of Appeals by virtue of an appeal from the Circuit Court of the United States for the Southern District of New York, and we, being willing for certain reasons that the said cause and the record and proceedings therein should be certified by the said Circuit Court of Appeals and removed into the Supreme Court of the United States, Do
162 hereby command you that you send without delay to the said Supreme Court, as aforesaid, the record and proceedings in said cause, so that the said Supreme Court may act thereon as of right and according to law ought to be done.

Witness the Honorable Melville W. Fuller, Chief Justice of the United States, the 6th day of May, in the year of our Lord one thousand nine hundred and eight.

JAMES H. McKENNEY,
Clerk of the Supreme Court of the United States.

163 [Endorsed:] File No. 21,102. Supreme Court of the United States. No. 699, October Term, 1907. Hygienic Chemical Co. *et al. vs.* Rumford Chemical Works. Writ of Certiorari. Filed May 12, 1908. United States Circuit Court of Appeals, Second Circuit. Wm. Parkin, Clerk.

164 United States Circuit Court of Appeals for the Second Circuit.

RUMFORD CHEMICAL WORKS, Complainant-Appellant,
against
HYGIENIC CHEMICAL COMPANY, JAMES E. HELLER, and ADOLPH HIRSH, Defendants-Appellees.

It is stipulated herein by the parties, through their respective attorneys, that the certified transcript of the record herein filed in the office of the Clerk of the Supreme Court of the United States, at Washington, D. C., on the 11th day of April 1908, on the petition of the Hygienic Chemical Company, James E. Heller, and Adolph Hirsh, for a writ of certiorari herein, may be taken as the return of this Court to the writ of certiorari granted herein by the Supreme Court of the United States on the 4th day of May 1908, and that a copy of this stipulation may be sent by the Clerk of the Circuit Court of Appeals for the Second Circuit, to the Supreme Court of the United States as the return of said Circuit Court of Appeals to the aforesaid writ.

Dated May 7th, 1908.

PHILIP MAURO,
C. A. L. MASSIE,
Attorneys for Complainant-Appellant.
WHITRIDGE, BUTLER & RICE,
Attorneys for Defendants-Appellees.

Endorsed: Circuit Court of Appeals for the Second Circuit. Rumford Chemical Works Complainant-Apllt. against James E. Heller and Adolph Hirsh, Defendants-Appellees. Original stipulation. Whitridge, Butler & Rice, attorneys for Deft.-Appellees, Borough of Manhattan, New York, 59 Wall Street. United States Circuit Court of Appeals Second Circuit Filed May 12 1908 William Parkin Clerk.

165 To the Honorable the Supreme Court of the United States, Greeting:

The record and all proceedings whereof mention is within made, having lately been certified and filed in the office of the Clerk of the Supreme Court of the United States, a copy of the stipulation of counsel is hereunto annexed and certified as the return to the writ of certiorari issued herein.

Dated New York, May 12, 1908.

[Seal United States Circuit Court of Appeals, Second Circuit.]

WM. PARKIN,
Clerk of the United States Circuit Court of Appeals for the Second Circuit.

166 [Endorsed:] 699 21102 United States Circuit Court of Appeals, Second Circuit. Rumford Chemical Works *v.* Hygienic Chemical Co., *et al.* Return to Writ of Certiorari. 1.90.

167 [Endorsed:] File No. 21,102. Supreme Court U. S. October Term, 1907. Term No. 699. Hygienic Chemical Co. *et al. vs.* Rumford Chemical Works. Writ of certiorari and return. Filed May 14th, 1908.

OFFICE OF THE CLERK
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MAY 18 1908
SUPREME COURT U. S.

Supreme Court of the United States.

No. ~~140~~ 9

OCTOBER TERM, 1907.

RUMFORD CHEMICAL WORKS,
Petitioner,

vs.

HYGIENIC CHEMICAL COMPANY,
Respondent.

Notice of Motion, Motion, and Petition for Rehearing of Petition for a Writ of Certiorari to the United States Circuit Court of Appeals for the Third Circuit.

PHILIP MAURO,
Attorney for Petitioner.

C. G. Burdorff, 71 to 73 Spring Street, New York.

Supreme Court of the United States,

No. 412, OCTOBER TERM, 1907.

RUMFORD CHEMICAL WORKS,
Petitioner,

vs.

HYGIENIC CHEMICAL COMPANY (of New Jersey),
Respondent.

Notice of Motion.

To HYGIENIC CHEMICAL COMPANY (OF NEW JERSEY), RESPONDENT:

Please take notice that on Monday, May 18, 1908, the annexed Petition for Writ of *Ceritorari* to the Circuit Court of Appeals for the Third Circuit will be submitted to the Supreme Court of the United States, at the Court Rooms thereof, in the City of Washington, D. C., at the opening of Court on that day or as soon thereafter as counsel can be heard.

PHILIP MAUBO,
Attorney and of Counsel for Petitioner.

Due service of the foregoing Notice and annexed Motion and Petition is hereby admitted this 12th day of May, 1908.

WHITRIDGE, BUTLER & RICE,
Attorneys for Respondent.

SUPREME COURT OF THE UNITED STATES,

No. 412, OCTOBER TERM, 1907.

RUMFORD CHEMICAL WORKS,
Petitioner,

vs.

HYGIENIC CHEMICAL COMPANY (of New Jersey),
Respondent.

Motion.

And now comes the Rumford Chemical Works, the above-named Petitioner, a corporation organized and existing under and by virtue of the laws of the State of Rhode Island, by its attorney, Philip Mauro, upon the certified Transcript of Record herein, and upon the proceedings already had herein in this Court, and upon the annexed Petition for Rehearing, and moves this Honorable Court for a Rehearing upon its said former Petition for a Writ of *Certiorari* to the U. S. Circuit Court of Appeals for the Third Circuit, directing the said Court to bring before this Honorable Court the above-entitled cause, lately decided by said Circuit Court of Appeals for the Third Circuit, and for such further proceedings and for such relief to your Petitioner as to this Court may seem just.

PHILIP MAURO,
Attorney for Petitioner.

SUPREME COURT OF THE UNITED STATES.

No. 412, October Term, 1907.

Rumford Chemical Works,
Petitioner,

vs.

Hygienic Chemical Company (of New Jersey),
Respondent.

Petition.

The Petition of the Rumford Chemical Works, of Providence, Rhode Island, a corporation duly organized and existing under and by virtue of the laws of the State of Rhode Island, respectfully shows as follows:

1. That on April 26, 1907, the Circuit Court of Appeals for the Third Circuit handed down its decision affirming the lower Court, and dismissing the bill, in a suit between the above-named parties wherein your Petitioner was complainant. Your Petitioner thereupon, on Oct. 21, 1907, presented to this Court a Petition for a Writ of *Certiorari* directed to the said Circuit Court of Appeals for the Third Circuit, which Petition was denied during the present Term of October, 1907, namely, on Oct. 28, 1907, so that said cause is still under the control of this Court.

2. That on Feb. 11, 1908, the Circuit Court of Appeals for the Second Circuit handed down its decision reversing the Court below, and sustaining the bill, in a suit wherein your Petitioner was complainant and the Hygienic Chemical Company (of New York) *et al.* were defendants. Thereupon the defendants in said New York suit, on Apr. 27, 1908, presented to this Court a Petition for a Writ of *Certiorari* directed to the Circuit Court of Appeals for the Second Circuit, which Petition, docketed in this Court as No. 699, was granted during the present Term of October, 1907, namely, on May 4, 1908.

3. Your petitioner respectfully refers to the Petition, Answer, and Transcript now on file in this Court in the cause brought from the Circuit Court of Appeals for the Second Circuit, docketed in this Court as No. 699, to show that the main ground upon which the Writ of *Certiorari* directed to the said Circuit Court of Appeals for the Second Circuit was asked was the existence of a conflict between the decision herein of the Circuit Court of Appeals for the Third Circuit, and the said decision of the Circuit Court of Appeals for the Second Circuit, between the same interests and upon the same testimony; and to show further that the questions which the Petitioners for said Writ directed to the Circuit Court of Appeals for the Second Circuit desire to have reviewed by this Court are as much involved in this cause in the Third Circuit as in the cause in the Second Circuit.

4. It follows that, whatever decision may be reached by this Court will affect the issues in this cause in the Third Circuit equally with those in the Second Circuit, it being conceded that the questions of law and the testimony in the two causes are identical.

5. Your Petitioner respectfully submits that, the questions and testimony presented in the two causes being identical, every reason for granting the Petition for Writ of *Certiorari* in the cause in the Second Circuit applies with equal force and effect to the granting of a Petition in this cause in the Third Circuit.

WHEREFORE, your Petitioner prays, in order that the entire controversy may be brought to a single uniform determination, that this Court will re-consider your Petitioner's said Petition submitted on Oct. 21, 1907, and issue its Writ of *Certiorari* to the Circuit Court of Appeals for the Third Circuit, as well as to the Circuit Court of Appeals for the Second Circuit.

And your Petitioner will ever pray.

RUMFORD CHEMICAL WORKS,
By PHILIP MAURO,
Its Attorney.

1

Supreme Court of the United States

October Term, 1907.

No. 412.

RUMFORD CHEMICAL WORKS,
Petitioner,

vs.

HYGIENIC CHEMICAL COMPANY OF NEW JERSEY,
Respondent.

2

The answer of the Hygienic Chemical Company of New Jersey to the petition of the Rumford Chemical Works, sought to be filed herein on May 18, 1908, respectfully shows:

I. The respondent, Hygienic Chemical Company of New Jersey, admits that on April 26, 1907, the Circuit Court of Appeals for the Third Circuit, rendered its decision affirming a decree of the Circuit Court of the United States for the District of New Jersey, dismissing the bill of complaint in this cause, and further admits that on October 21, 1907, the Rumford Chemical Works presented to this Court a petition for a writ of certiorari directed to the said Circuit Court of Appeals for the Third Circuit, which application was on or about October 28, 1907, denied by this Court. The Hygienic Chemical Company of New Jersey denies that the said cause is still under the control of this Court, and alleges that after the said application for a writ of certiorari had been denied by this Court, the mandate of the Cir-

3

4 cuit Court of Appeals for the Third Circuit issued to the United States Circuit Court for the District of New Jersey, was duly filed in the office of the Clerk of said Court on the 14th day of November, 1907, and thereafter the defendant's costs were taxed herein and thereupon this cause was thereby finally terminated, and is no longer pending.

II. The Hygienic Chemical Company of New Jersey admits that on February 11, 1908, the Circuit Court of Appeals for the Second Circuit rendered a decision in a cause in which the Rumford Chemical Works was complainant and the Hygienic Chemical Company of New York, with James E. Heller and Adolph Hirsh were defendants,
5 which reversed a decree of the Circuit Court of the United States for the Southern District of New York, dismissing the bill of complaint therein, and that thereafter the defendants in said New York suit presented to this Court a petition for a writ of certiorari directed to the United States Circuit Court of Appeals for the Second Circuit, No. 699, October Term, which petition was granted by this Court on May 4, 1908, and that said writ of certiorari thereafter duly issued, in accordance with the prayer of such petition.

III. For the grounds upon which the said writ of certiorari was granted in the New York suit, reference is made to the petition and answer filed in said cause and the
6 briefs submitted on behalf of the parties thereto. One of the grounds upon which it was urged that the writ of certiorari should issue, was that the Circuit Court of Appeals in the Second Circuit in rendering its decision had taken judicial notice of the record of the United States Circuit Court for the Southern District of New York, in a cause to which the defendants in the said suit were not parties, and had thereby undertaken to supplement the complainant's proofs, which had been held by the United States Circuit Court for the Southern District of New York to be defective.

IV. The Hygienic Chemical Company of New Jersey denies that any decision which may be reached by this Court in the said New York cause, will affect the issues in the cause formerly pending in the Circuit Court of the United States for the District of New Jersey, for the reason that the parties to the suit in New Jersey were different from the parties in New York, and that the grounds upon which the decision of the New Jersey courts proceeded, did not include any consideration of the records of the United States Circuit Court for the Southern District of New York in any former action or proceeding. 7

V. The Hygienic Chemical Company of New Jersey, respectfully urges that inasmuch as the application of the Rumford Chemical Works for a writ of certiorari in this cause was denied, and the bill of complaint in this cause pending in the United States Circuit Court for the District of New Jersey has been dismissed, this cause is no longer before this or any other Court. 8

WHEREFORE, the Hygienic Chemical Company of New Jersey respectfully prays that the petition of the Rumford Chemical Works herein be denied.

HYGIENIC CHEMICAL COMPANY OF NEW JERSEY,
Respondent,

9

By

JAMES E. HELLER,
President.

WHITRIDGE, BUTLER & RICE,
Solicitors for Respondent,
59 Wall Street,
N. Y. City

WILLARD PARKER BUTLER,
Of Counsel.

10 STATE OF NEW YORK,
Southern District of New York, } *ss.:*
County of New York,

JAMES E. HELLER, being duly sworn, says:

I am the President of the Hygienic Chemical Company of New Jersey, the respondent named in the foregoing answer. I have read the foregoing answer and know the contents thereof, and the same is true of my own knowledge except as to the matters therein stated to be alleged on information and belief, and as to those matters I believe it to be true.

11 The reason why this verification is made by deponent and not by the respondent personally, is that said respondent is a corporation and deponent is the President thereof.

JAMES E. HELLER,

Sworn to before me this 14th day of May, 1908.

JOHN FRENCH,
[L. S.] Notary Public,
N. Y. County.

12 Due service of three copies of the foregoing answer is hereby admitted this 14th day of May, 1908.

PHILIP MAURO,
Attorney for Petitioner.

Supreme Court of the United States

OCTOBER TERM, 1917

HYGIENIC CHEMICAL COMPANY OF NEW YORK, ARMIN
L. BRUNS and ADOLPH HIRSCH,

Plaintiffs

vs.

PROMONT CHEMICAL WORKS,

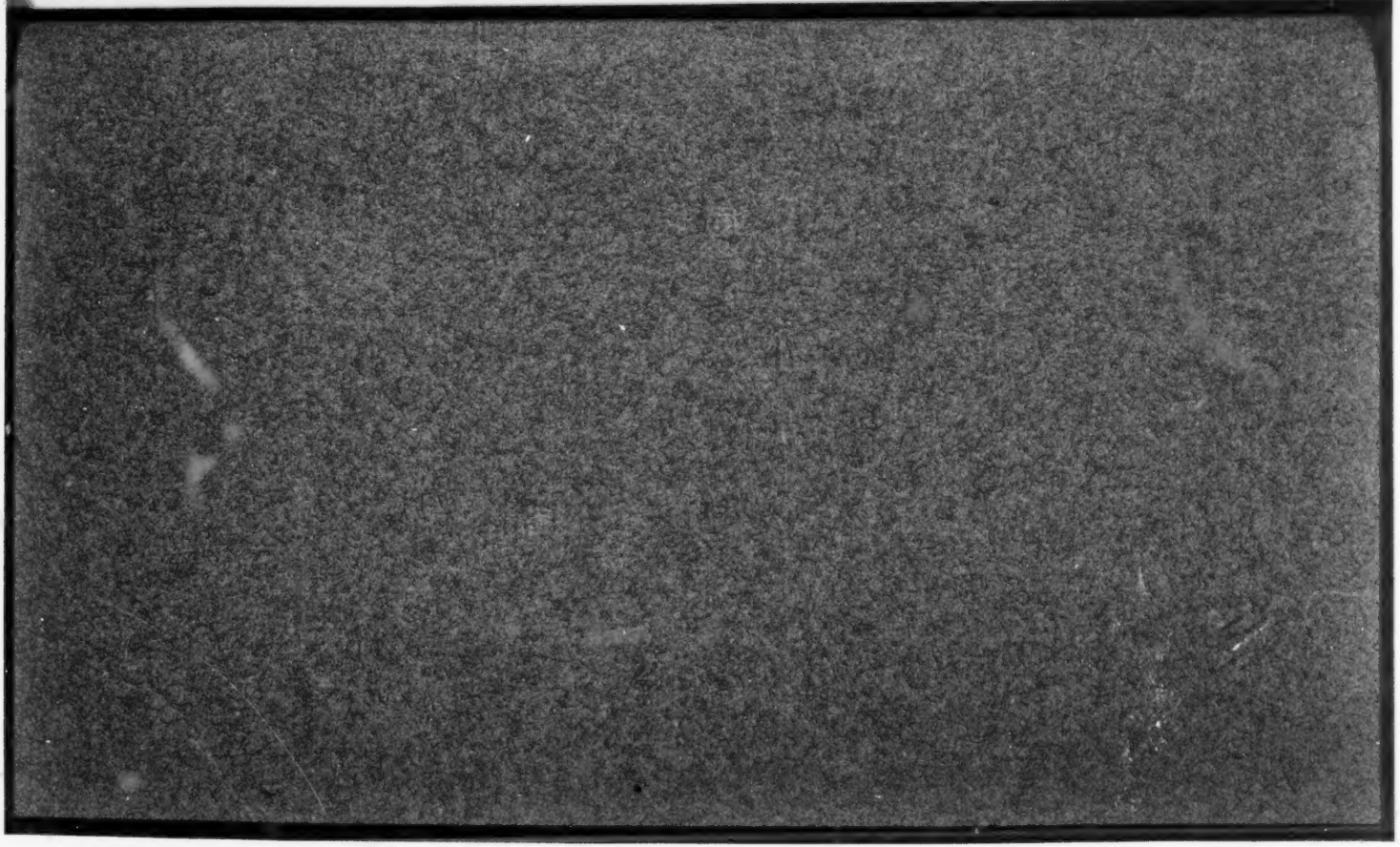
Defendant

NOTICE OF MOTION, MOTION AND PETITION FOR
WRIT OF CERTIORARI TO THE UNITED STATES
CIRCUIT COURT OF APPEALS FOR THE
SECOND CIRCUIT,

AND

BRIEF IN SUPPORT OF PETITION

[redacted]



Supreme Court,

OCTOBER TERM, 1907.

HYGIENIC CHEMICAL COMPANY OF NEW YORK, JAMES E. HELLER and ADOLPH HIRSCH, Petitioners, vs. RUMFORD CHEMICAL WORKS, Respondent.	NOTICE OF MOTION.

TO THE RUMFORD CHEMICAL WORKS,
Respondent.

Please take notice that on Monday, April 27th, 1908, the annexed petition for writ of *certiorari* will be submitted to the Supreme Court of the United States, at the Court Rooms thereof, in the City of Washington, D. C., at twelve o'clock in the forenoon of that day or as soon thereafter as counsel can be heard. In support of said petition a brief will be filed, whereof a copy is hereto annexed.

Dated New York, March 19, 1908.

WHITRIDGE, BUTLER & RICE,
Attorneys for Petitioners.

WILLARD PARKER BUTLER,
Of Counsel for Petitioners.

Due service of the foregoing notice and of the accompanying motion, petition and brief is hereby admitted this 27th day of March, 1908.

PHILIP MAURO,
Attorney for Respondent.

SUPREME COURT OF THE UNITED STATES,

OCTOBER TERM, 1907.

HYGIENIC CHEMICAL COMPANY OF NEW YORK, JAMES E. HELLER and ADOLPH HIRSH, Petitioners, vs. RUMFORD CHEMICAL WORKS, Respondent.	MOTION.

Now comes the said Hygienic Chemical Company of New York, a corporation organized and existing under and by virtue of the laws of the State of New York, James E. Heller and Adolph Hirsh, the above named petitioners, by their attorneys, Whitridge, Butler & Rice, and move this Honorable Court, upon the certified transcript of record herein and upon the annexed petition, for a writ of *certiorari* to the United States Circuit Court of Appeals for the Second Circuit, directing the said Court to bring before this Honorable Court the above entitled cause lately decided by said Circuit Court of Appeals, for such further proceedings and for such further relief to petitioners as to this Court may seem just.

WHITRIDGE, BUTLER & RICE,
Attorneys for Petitioners.

Willard Parker Butler
of Counsel

SUPREME COURT OF THE UNITED STATES,

OCTOBER TERM, 1907.

HYGIENIC CHEMICAL COMPANY OF NEW YORK, JAMES E. HELLER and ADOLPH HIRSH, Petitioners,

AGAINST

RUMFORD CHEMICAL WORKS, Respondent.

Petition.

The petition of Hygienic Chemical Company of New York, a corporation organized and existing under and by virtue of the laws of the State of New York, and of James E. Heller and Adolph Hirsh, of the City and State of New York, citizens of said State, respectfully shows as follows:

I.—The Rumford Chemical Works, the complainant above named, as your petitioners are informed and verily believe, is a corporation of the State of Rhode Island.

II.—On or about the 2d day of August, 1904, the said complainant brought suit in the United States Circuit Court for the Southern District of New York, against your petitioners, alleging infringement of Letters Patent of the United States No. 474,811, dated May 17, 1892 (hereinafter called the Catlin patent), for an improvement in baking preparations. The said bill of complaint alleged the institution of a prior suit by the complainant against the New York Baking Powder Company *et al.* for infringement of the Catlin patent, the dis-

missal of the bill by Judge Lacombe, after proofs had been taken, and the subsequent reversal of Judge Lacombe's decision by the Circuit Court of Appeals in the Second Circuit. The bill also alleged that your petitioners participated in the defense of the suit against the New York Baking Powder Company, financially and otherwise.

III.—Issue was joined by your petitioners, by separate answers which alleged the invalidity of the Catlin patent, which denied the infringement of such patent, and denied participation in the defense of the suit of the Rumford Chemical Works against the New York Baking Powder Company, financially or otherwise.

IV.—Simultaneously with the suit in the United States Circuit Court for the Southern District of New York, the Rumford Chemical Works, the complainant herein, brought suit against the Hygienic Chemical Company of New Jersey, its bill of complaint alleging infringement of the Catlin patent, and containing substantially the same allegations regarding the prior suit against the New York Baking Powder Company, and the participation of the defendant in the defense therein, as were contained in the bill of complaint in this cause. Issue was joined in the said New Jersey suit, by the service of an answer on behalf of the said Hygienic Chemical Company of New Jersey, substanially identical with the answers of the defendants in the New York suit.

V.—After joinder of issue in both the New York and New Jersey causes, proofs were taken on behalf of the complainant, under a stipulation that the same record might be used in both the New York and New Jersey cause. After the complainant's *prima facie* proofs had been completed, your petitioners, being advised and believing that the complainant had not proved a cause of action, offered

no evidence, and the defendant Hygienic Chemical Company of New Jersey also offered no evidence in the New Jersey cause. In the case pending in New Jersey, the complainant insisted in the first place, that the defendant in that case, the Hygienic Chemical Company of New Jersey, was bound by the decree entered in the Circuit Court of the United States for the Southern District of New York, in a certain case pending between it and the New York Baking Powder Company and others, which decree had adjudicated the validity of the Catlin patent and adjudged the New York Baking Powder Company to have infringed it, for the reason that the Hygienic Company of New Jersey had contributed financially to and otherwise aided in the defense of that suit, and that consequently it was a privy thereto and was bound thereby; and, in the second place, that by reason of such privity the deposition of a witness in that case, one Clotworthy (since deceased), was admissible in this case, for the purpose of showing infringement of the patent by the Hygienic Chemical Company of New Jersey.

The New Jersey case came on first for hearing in the Circuit Court of the United States for the District of New Jersey, and was heard before Judge Joseph Cross, at Trenton, New Jersey. On December 7, 1906, Judge Cross rendered a decision dismissing the bill, with costs (148 Fed. Rep., 862).

In his opinion Judge Cross held, first, that the Hygienic Chemical Company of New Jersey was not a privy to the earlier litigation, for the reason that there was no evidence whatever that it, through its president, sought to control, had the power to control, or did in anywise control the litigation, and the mere fact that the president of the Hygienic Chemical Company of New Jersey gave testimony in that litigation did not show such control over the suit, nor any such interest as would make the corporation a privy thereto. Judge Cross found, second, that there was no evidence of any agreement

between the Hygienic Chemical Company of New Jersey and your petitioners, as to the joint defense of the suit aforesaid, and it did not appear that the said corporation, or your petitioners, had the right to control the proceedings, assume any active part therein, cross-examine the witnesses, or appeal therefrom. Judge Cross also found that even if the contribution had been made, it did not have the effect of making the Hygienic Chemical Company of New Jersey a privy. As the result of the aforesaid decision, Judge Cross found that the deposition of the deceased, Clotworthy, in the earlier case, was not admissible in evidence, and that in the absence of the deposition there was no evidence of infringement before the Court. He further found that there was no evidence of any contributory infringement, for the reason that in order to establish contributory infringement, it had to be convincingly shown that a granular acid phosphate manufactured by the defendant, went into a baking powder which infringed the patent in suit, and also shown that the defendant manufactured and sold said phosphate, knowing or having reasonable cause to know that it was to be used in an infringing powder, and that there was no evidence on these points whatever.

Speaking of this part of the case, Judge Cross said:

> "Nor do I find any evidence of infringement of the complainant's patent by the defendant. The only evidence offered upon that point worthy of review was the introduction under objection of the evidence of a deceased witness, one Clotworthy, who was examined in Rumford Chemical Works *v.* New York Baking Powder Company, *supra.* Assuming that the issues in the two cases are substantially the same, although the record was not offered and there is no evidence that they are, still the evidence would only be admissible in a subsequent suit between the same parties or their privies, a situation which we have found does not exist, but

waiving that and assuming that my conclusion in that respect is unwarranted, the testimony was not admissible in the form in which it was offered. The witness produced to prove the testimony of the deceased witness did not attempt to give all of his testimony, or all of his testimony upon any given point. He testified that the printed record in the New York case which he had read or examined was a correct transcript of what the deceased witness testified to in his presence, whereupon counsel for the complainant, without offering the record, if indeed it were admissible, or having the witness testify to its contents at length, gave notice that he could print as a part of the complainant's record herein the deposition referred to, or at least so much thereof as related to the point at issue; and in the record herein, two or three pages of the testimony of the deceased witness, taken from the printed record, appear. I think the introduction of the testimony into the record in this manner was improper, and as objection was made thereto, it should be stricken out. The witness should himself have testified into the record what the deceased witness swore to, or the substance thereof, and it should not have been left to counsel to pick out and introduce such portions only as he might deem relevant or important to his case. It is for the Court to say whether the testimony or any part of it was relevant. Counsel has evidently incorporated in this record, as appears by the numbered questions and cross-questions, only fragmentary and disjointed selections from the testimony of the deceased witness."

The complainant appealed to the United States Circuit Court of Appeals for the Third Circuit, from the decree dismissing the bill, and the decree of dismissal was unanimously affirmed by *Judges Dallas, Gray* and *Buffington* (154 Fed. Rep., 65).

The Court, by *Buffington, J.*, said:

"The Court below held there was no proof of infringement, and there is no error in its so holding, if the testimony of one

> Clotworthy was rightfully excluded. This excluded deposition of Clotworthy, now deceased, was taken in a suit in the Circuit Court for the Southern District of New York (125 Fed., 231, and 134 Fed., 385, 67 C. C. A., 367), wherein the Rumford Chemical Works, the present appellant, was complainant, and the New York Baking Powder Company, *et al.*, respondents. It is alleged the respondent in the present case aided in, and contributed to, the defense of that case. On that point, however, the proofs fail. There is no proof that the present respondent, the Hygienic Chemical Company of New Jersey contributed to the expense of the New York suit or bore the relation of privy or party to that litigation. While the Hygienic Chemical Company of New York did contribute to the defense, and one Heller, who was President of both Companies, was a witness in that case, there is no sufficient proof to connect the present respondent with the defense of that case. We are therefore of opinion the Court below rightly excluded Clotworthy's testimony."

An application was then made by the complainant to this Court, for a writ of *certiorari* to review the decree of the Circuit Court of Appeals for the Third Circuit, but the same was denied at this term of the Court, October 21, 1907.

VI.—After the argument of the appeal to the United States Circuit Court of Appeals for the Third Circuit in the New Jersey suit, the cause in which this petition is filed, was brought to hearing before Judge Holt, sitting at Circuit in the Southern District of New York, upon the same record, so far as the evidence is concerned, as in the New Jersey suit, and the complainant's counsel in this suit urged upon the Court the same considerations and arguments that were submitted to Judge Cross in the New Jersey action, and to the Circuit Court of Appeals for the Third Circuit.

The proofs and issues in the New York suit were identical with those in the New Jersey suit, save that the New Jersey corporation, defendant in the New Jersey suit, was a manufacturing corporation, whereas your petitioner, the Hygienic Chemical Company of New York, one of the defendants herein, is a selling corporation. Prior to the decision of the Circuit Court of Appeals for the Third Circuit, Judge Holt, April 12, 1907, filed a decision dismissing the bill, with costs, and writing an opinion as follows:

> "The decision of Judge Cross in the New Jersey suit, although not technically *res adjudicata*, ought in my opinion to be held to be controlling by this Court. Moreover, I concur with the conclusions of Judge Cross on the merits."

From the decree of dismissal entered upon this decision the complainant appealed to the Circuit Court of Appeals for the Second Circuit, which, on the 13th day of February, 1908, entered a decision (Judge Coxe writing the opinion) reversing Judge Holt's decision, and directing the entry of a decree adjudging that your petitioners had infringed the Catlin patent.

In reaching this conclusion, as appears from the opinion of Judge Coxe, the learned Judge considered that the case heretofore pending in the Circuit Court of the United States for the Southern District of New York, between the Rumford Chemical Works, complainant, and the New York Baking Powder Company and others, defendants, was a test case, and the Court discussed the matter as follows:

> "The defendants charged with infringement are Hygienic Chemical Company of New York, James E. Heller and Adolph Hirsh, the first two defendants contributing to the defense in the so-called test case against the New York Baking Powder Company in which the validity of the Catlin patent was

upheld by this Court. In that case Heller testified that he was interested in the defense financially and otherwise and that the Hygienic Chemical Company located at Elizabethport, New Jersey, manufactured acid phosphate for baking powder and other purposes. He testified further as follows: 'We are manufacturers of granulated acid phosphate, and are selling it to the trade in the same way as the parties who are sued in this case, the Provident Chemical Works of St. Louis.' Heller was sworn in the case at bar, and says his answers in the former case were true."

But the Court failed to consider further the degree of participation upon which it based its conclusion that your petitioners were privy to that suit, merely adding:

> "We are of the opinion that their participation in the defense of the test suit made the defendants Heller and the New York Hygienic Company parties privy to that suit, and that the testimony of Clotworthy given therein may properly be read against these defendants—Clotworthy having died prior to the hearing."

The only evidence in either case, on the subject of contribution to the defense of the so-called test case, or of participating in the defense, financially or otherwise, is found in the deposition of James E. Heller, at pages 36 to 38 of the record in the New York case before the Circuit Court of Appeals for the Second Circuit, which is as follows:

> "Q. 53. Are you the James E. Heller who gave testimony for the defense in a suit in the Circuit Court of the United States for the Southern District of New York, entitled 'The Rumford Chemical Works against the New York Baking Powder Co. *et al.*'?
>
> Objected to as immaterial and irrelevant.
>
> A. Yes, sir.
>
> Q. 54. I produce a copy of the transcript of record printed under the direction of the Clerk of the United States Circuit Court of Appeals

for the Second Circuit, and show you on page 1142 thereof the following questions and answers:

'Q. 2. Where is the Hygienic Chemical Company located? A. At Elizabethport, New Jersey.

Q. 3. What does it manufacture? A. It manufactures acid phosphate.

Q. 4. For baking powder purposes? A. For baking powder and other purposes.'

Q. Are these answers true? A. Certainly.

Q. 55. On the next page (1143) occur the following questions and answers:

'Q. 7. Are you interested in this suit? If so, in what manner? A. We are manufacturers of granulated acid phosphate and are selling it to the trade in the same way as the parties who are sued in this case, the Provident Chemical Works of St. Louis.

Q. 8. Have you undertaken to assist in bearing the burdens of this defense? A. We have, most surely.

Q. 9. Contributing to the defense financially and otherwise? A. We have financially and otherwise.'

Are these answers true?

A. I cannot answer these questions all in one, as I have to answer each separately. In answering question 7 I desire to say what I said then, that the Hygienic Chemical Company of New Jersey were manufacturing an acid phosphate which contained a large percentage of very fine powdered material, and some percentage of coarser material, which I then designated as granulated acid phosphate, because, as I understood it then and understand it now, granulated means to have been ground, and in grinding some of it is extremely fine and some of it coarser.

In reply to question 8 the Hygienic Chemical Company of New York assisted in the burden of the defense.

To question 9 the same answer.

Q. 56. Were any experiments or tests made at the establishment of the Hygienic Chemical Company of New Jersey for the purpose of assisting in the defense of the suit against the New York Baking Powder Co. *et al.*?

Objected to as immaterial and irrelevant.

A. I do not remember at this moment whether there had been.

Q. 57. Do you remember whether or not the Hygienic Chemical Company of New Jersey contributed to the defense of the suit against the New York Baking Powder Co. *et al.*, either financially or otherwise? A. As near as I remember I don't think they did financially and I don't remember whether they did otherwise."

It will be apparent therefore, that upon substantially the same record the two Circuit Courts of Appeals have disagreed to some extent in their consideration of this important question, and have reached quite different conclusions in their respective decisions, and from the decisions of the learned Judges who heard the two cases at Circuit. Judge Cross held that there was not enough evidence to connect either of the Hygienic companies with the defense of the so-called test case in such a way as to make either a privy thereto. Judge Holt concurred in this view. The Circuit Court of Appeals for the Third Circuit, held that on the facts it was your petitioner Hygienic Chemical Company of New York and not the New Jersey corporation which contributed, but it did not hold that the participation was of such a character as would make it a privy to the earlier case, and the Circuit Court of Appeals for the Second Circuit has held that a contribution like that shown by the evidence above quoted, was sufficient to make your petitioner a privy; but it also held that upon the identical record, there was not sufficient proof to connect the New Jersey Company with the defense of the test case, or to make it a privy.

Hence we have the same record insufficient to establish privity as against one company in the opinion of one Circuit Court of Appeals, and yet sufficient to establish privity as against the other company in another Circuit Court of Appeals. In other words, there is a direct conflict between two

Circuit Courts of Appeal, as to the degree and extent of proof necessary to establish privity in a patent litigation on a record which is precisely the same so far as both companies are concerned save only that it appears that it was the New York Company which, "*assisted in the burden of the defense*" (whatever that may mean), and not the New Jersey Company.

In reaching this conclusion as appears from the opinion of Judge Coxe, the Circuit Court of Appeals also went outside of the record in the present suit, and took judicial notice of the record of the prior suit brought by the complainant against the New York Baking Powder Company *et al.*, of which no evidence had been offered in the suit against your petitioners.

The only portion of the record in the prior suit, which was sought to be introduced by the complainant, was certain extracts, uncertified and unauthenticated, from the deposition of a deceased witness named Clotworthy, who had been called on behalf of the complainant in the prior suit. Your petitioners objected to the introduction of these extracts, or to their consideration by the Court, and relied upon the complainant's failure to introduce any evidence regarding the prior suit, or the issues involved therein, which had been held by Judge Cross to be fatal to the complainant's case, and as there was no suggestion of the existence of any other evidence of infringement, your petitioners were entitled to an affirmance of the decree of dismissal herein. Inasmuch, however, as Judge Coxe had heard the prior suit by complainant against the New York Baking Powder Company *et al.*, and had rendered the decision which reversed Judge Lacombe's decree dismissing the bill of complaint in such prior suit, he obviously considered the record in the present suit in the light of the issues involved in said prior suit, which were in no way proved herein, and thereby

departed from the well known rules of evidence established by this Court. This is apparent from the following statement of Judge Coxe found in his opinion:

> "Whether intended to be so or not, there is no doubt that the suit against the New York Baking Powder Company was, in fact, a test case, and is controlling in this Court upon all questions there decided. If there were any doubt as to what those questions are we could take judicial notice of the records of our own Court for the purpose of informing ourselves, but there is no doubt upon any issue now in controversy."

Upon this statement of facts, and upon the record of the cause, your petitioners submit that this cause should be brought up for review by this Court—

(1.) To define the matters necessary to be proved in a patent cause to establish such relation of privity between a defendant in a later cause and a defendant in an earlier cause upon the same patent, as to make the decision in the earlier case binding upon a defendant in the later cause;

(2.) To determine the legal effect of the alleged participation by your petitioner Heller in the prior suit against the New York Baking Powder Company *et al.;*

(3.) To correct the error of the Court below in taking judicial notice of matters in litigation in an earlier action not offered in evidence, and in holding that the complainant was entitled to read and to have considered the so-called extracts from the Clotworthy deposition, which were printed by the complainant's solicitors as a part of the record, without, however, having the same authenticated or certified in any way;

(4.) To correct the error of the Court below in holding that there was any evidence whatever of any contributory infringement by any of your petitioners;

(5.) To correct the error of said Court in not holding that the decree of Judge Holt, dismissing the bill, should have been affirmed for failure of proof on the part of the complainant.

Wherefore, your petitioners pray that this Honorable Court will grant its writ of *certiorari*, directed to said Circuit Court of Appeals for the Second Circuit, requiring the record of said cause in said Court, and its decree, to be certified to this Court, and that this Court will thereupon proceed to correct the errors therein complained of, reverse the said decree, and remand said cause with a direction that the bill of complaint be dismissed, and give to your petitioners such other and further relief as the nature of the cause may require and to the Court may seem proper in the premises.

NEW YORK, March 19, 1908.

HYGIENIC CHEMICAL COMPANY
OF NEW YORK,
[L. S.] by JAMES E. HELLER,
President.
JAMES E. HELLER,
ADOLPH HIRSH.

WILLARD PARKER BUTLER,
Of Counsel.

STATE OF NEW YORK, }
County of New York, } ss.:

JAMES E. HELLER, being duly sworn, deposes and says:

I am President of the Hygienic Chemical Company of New York, one of the petitioners named in the foregoing petition. I have read the foregoing petition and know the contents thereof, and the same is true of my own knowledge, except as to the matters therein stated to be alleged upon information and belief, and as to those matters I believe it to be true.

The reason why this verification is made by deponent and not by the petitioner personally, is that said petitioner is a corporation, and deponent is an officer thereof.

The sources of my information and the grounds of my belief as to all matters not therein stated of my own knowledge are the records of the company, correspondence, &c.

JAMES E. HELLER.

Sworn to before me this 26th day of March, 1908.

JOHN FRENCH,
Notary Public,
New York County.

[L. S.]

STATE OF NEW YORK, }
County of New York, } ss.:

JAMES E. HELLER, being duly sworn, deposes and says:

I am one of the petitioners named in the foregoing petition. I have read the foregoing petition and know the contents thereof, and the same is true of my own knowledge, except as to the matters therein stated to be alleged on information and belief, and as to those matters I believe the same to be true.

JAMES E. HELLER.

Sworn to before me this 26th }
day of March, 1908. }

JOHN FRENCH,
[L. S.] Notary Public,
New York County.

STATE OF NEW YORK, }
County of New York, } ss.:

ADOLPH HIRSH, being duly sworn, deposes and says:

I am one of the petitioners named in the foregoing petition. I have read the foregoing petition and know the contentst hereof, and the same is true of my own knowledge, except as to the matters therein stated to be alleged on information and belief, and as to those matters I believe the same to be true.

ADOLPH HIRSH.

Sworn to before me this 26th }
day of March, 1908. }

JOHN FRENCH,
[L. S.] Notary Public,
New York County.

SUPREME COURT OF THE UNITED STATES,

OCTOBER TERM, 1907.

HYGIENIC CHEMICAL COMPANY OF NEW YORK, JAMES E. HELLER and ADOLPH HIRSH, Petitioners,

AGAINST

RUMFORD CHEMICAL WORKS, Respondent.

BRIEF OF THE PETITIONERS IN SUPPORT OF THEIR PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

The bill of complaint alleged infringement by the petitioners, and particularly by the Hygienic Chemical Company of New York, of Letters Patent 474,811, issued to the Rumford Chemical Works as assignee of one Catlin for an alleged inprovement in baking powders. The petitioners' answers denied infringement, and put in issue substantially all the material allegations of the bill.

A record substantially identical with that herein was before this Court on the application of the complainant for a writ of *certiorari*, in the case of Rumford Chemical Works, complainant, against the Hygienic Chemical Company of New Jersey, respondent, decided in the Circuit Court of Appeals for the Third Circuit, on appeal from the Circuit Court of the United States for the District of New Jersey. That case and the present case were heard by stipulation upon the same record. In the New Jersey case the bill of complaint was dismissed; the

Circuit Court of Appeals in the Third Circuit affirmed the decree of dismissal, and this Court denied the complainant's application for a writ of *certiorari* (October 21, 1907).

The present case was heard by Hon. George C. Holt, District Judge, sitting in the Circuit Court of the United States for the Southern District of New York, upon the pleadings, and the same proofs on behalf of the complainant as were submitted in the New Jersey case, and, as in that case, no evidence was submitted herein on behalf of the defendant. Judge Holt, in a short opinion, followed Judge Cross' decision in the New Jersey case, and dismissed the bill.

From the decree dismissing the bill, an appeal was taken by the Rumford Chemical Works to the Circuit Court of Appeals for the Second Circuit, which (Judges Coxe, Lacombe and Noyes sitting) unanimously directed the reversal of the decree entered on Judge Holt's decision.

The contention of the petitioner is, that this decision of the Circuit Court of Appeals presents two matters for the consideration of this Court: first, a conflict between the decisions of the Circuit Court of Appeals for the Second Circuit and the Circuit Court of Appeals for the Third Circuit, upon substantially the same record; and, second, an important question of evidence and procedure of general interest, namely, that the Circuit Court of Appeals for the Second Circuit erred in taking judicial notice of the record and issues in an earlier suit theretofore pending in said Court, which had not been introduced in evidence in the present case. The petitioner urges that this was in violation of the well-known rules of evidence.

It is insisted that on these two grounds, a case for granting a writ of *certiorari* within the rule laid down in

Fields against The United States, 205 U. S., 292,

has been made out.

I.

There is a sharp conflict between the decisions of the Circuit Court of Appeals in the Third Circuit and the Circuit Court of Appeals in the Second Circuit. Upon substantially the same record, opposite conclusions were reached by those courts.

The record in the New Jersey case in which the complainant's bill was dismissed is identical with the record in this case. Said the complainant, the Rumford Chemical Works, in the petition filed in this said Court on application for a writ of *certiorari* in October, 1907, said:

> "The record in said New York suit is iden-
> " tical with that in the present case" (par. 9 of Petition of Rumford Chemical Works).

The complainant further, in its application for a writ of *certiorari*, contended that there was no pertinent decision by this Court upon the important question of what degree of participation in the defense of a suit upon a patent, will render the person so participating a privy to the litigation, in such sense that the decree in such earlier suit will be binding upon him in later litigation upon the same patent. It is the absence of an authoritative decision by this Court which has led the two Circuit Courts of Appeals in the Second and Third Circuits to different conclusions upon this same record.

In the case at bar, the complainant, in its attempt to make out a case against the defendants, relied wholly upon a prior suit, brought in the United States Circuit Court for the Southern District of New York, by the complainant against the New York Baking Powder Company *et al.*, in which the

Circuit Court of Appeals for the Second Circuit reversed a decree of dismissal, and awarded the complainant a decree sustaining the bill (134 Fed. Rep., 385). No evidence was submitted by the complainant in the case at bar regarding this earlier litigation, or the issues therein involved, or the parties thereto; but without any preliminary evidence of this nature, the complainant, for its sole proof of infringement, sought to read in evidence uncertified extracts from the deposition of a witness named Clotworthy, who had been examined in the case against the New York Baking Powder Company, and had died prior to the trial of the issues herein. If the privity of the defendants herein to the prior litigation, was not established, of course the Clotworthy deposition, whether regularly or irregularly proved, would have been inadmissible; and without the Clotworthy deposition, there was concededly no possible evidence of infringement by any of the defendants. The vital question in the case was, therefore, the admission or exclusion of the Clotworthy deposition. The New Jersey courts excluded it, and this ruling was followed by the United States Circuit Court in the Southern District of New York, but reversed by the Circuit Court of Appeals for the Second Circuit, upon the ground that there had been such participation by the defendants, or some of them, in the litigation against the New York Baking Powder Company as to make them privy thereto, and hence to make the Clotworthy deposition admissible in the case at bar.

As already stated, it is conceded by the complainant that the question is an open one in this Court, in the absence of an authoritative decision; and on behalf of the petitioners it is urged, that by a long line of cases in the United States District Courts and Circuit Courts of Appeal the rule is settled that it is only where an acknowledged test case is defended by several persons jointly interested in the subject-matter, who have the right to made defense, control proceedings, examine and cross-examine witnesses,

and appeal from the judgment, that they become thereby precluded by the judgment.

Theller v. *Hershey*, 89 Fed. Rep., 575:

> "The law is well settled that parties and "privies include all who are directly interested in the subject matter, and who had "the right to make defense, control the proceedings, examine and cross-examine witnesses, and appeal from the judgment."

The line of cases above referred to are as follows:

United States & Foreign Salamander Felting Co. vs. *Asbestos Felting Co.*, 4 Fed. Rep., 816;

American Bell Tel. Co. vs. *National Improved Tel. Co.*, 27 Fed. Rep., 663, 665;

Miller v. *Tobacco Co.*, 7 Fed. Rep., 91, 93;

Eagle Mfg. Co. vs. *David Bradley Mfg. Co.*, 50 Fed. Rep., 193, 195; *Id.*, 6 C. C. A., 661, 57 Fed. Rep., 980, 990, and authorities there cited;

Morss v. *Knapp*, 37 Fed. Rep., 351.

National Folding Box & Paper Co. vs. *Dayton Paper Novelty Co.*, 95 Fed. Rep., 991.

Sacks v. *Kupferle*, 127 Fed. Rep., 569.

Penfield v. *Potts & Co.*, 126 Fed. Rep., 475.

Australian Knitting Co. v. *Gormly*, 138 Fed. Rep., 92.

Lane v. *Welds*, 99 Fed. Rep., 286.

Birdsall v. *Hagerstown A. I. Mfg. Co.*, 1 Bann. & Ard., 426.

Yale & Towne Mfg. Co. v. *The Consolidated Time Lock Co.*, 38 Fed. Rep., 917.

In view, therefore, of the conflict between the decisions of the Circuit Courts of Appeal in the Second and Third Circuits, in the suits above referred to, and in view of the apparent departure by the Circuit Court of Appeals in the Second Circuit from the doctrine of the long line of cases above referred to, it is now urged on behalf of the petitioners, that this Court should review the entire subject of privity, especially in patent causes, and for the guidance of the Circuit Courts and Circuit Courts of Appeal, lay down a rule which shall finally determine this branch of the law.

II.

The Circuit Court of Appeals for the Second Circuit erred in taking judicial notice of matters outside of the record.

As is alleged in the petition, Judge Coxe, writing the opinion in the case at bar, took judicial notice of the earlier case between Rumford Chemical Works and the New York Baking Powder Company, in which he had written the opinion of the Circuit Court of Appeals for the Second Circuit. It is well settled, however, that while courts will take notice of their own orders or prior proceedings in the same case, they will not take notice of the pendency of another action in the same or another court, nor will they take notice of a former judgment or a decree between the same or other parties in the same or in another court.

Stanley vs. *McElrath*, 86 Cal., 449.
Downing vs. *Howlett*, 6 Colo. App., 291, 40 Pac., 505.
Adler vs. *Lang*, 26 Mo. App., 226.

Grace vs. Ballou 4 S. D., 333.
Stewart vs. *Masterson*, 131 U. S., 151.
In re Manderson, 51 Fed. Rep., 501.
Streeter vs. *Streeter*, 43 Ill., 155.
Taylor vs. *Adams*, 115 Ill., 570.
Loomis vs. *Griffin*, 78 Ia., 482.
Granger vs. *Griffin*, 78 Ia., 759.
Banks vs. *Burnham*, 61 Mo., 76.
Spurlock vs. *Mo. Pac. Rway.*, 76 Mo., 67.
Daniel vs. *Bellamy*, 91 N. C., 78.
People vs. *De La Guera*, 24 Cal., 73.
State vs. *Edwards*, 19 Mo., 674.
Baker vs. *Mygatt*, 14 Ia., 131.
Allison vs. *Fid. Mutual Fire Ins. Co.*, 104 N. W., 753.
In re Osborne, 115 Fed., 1.
Bank of Montreal vs. *Taylor*, 86 Ill. App., 388.
Ralphs vs. *Hensler*, 97 Cal., 296.
McCormick vs. *Herndon*, 67 Wis., 648.
Schuler vs. *Israel*, 120 U. S., 506.
Enix vs. *Miller*, 54 Ia., 551.
Eyster vs. *Gaff*, 91 U. S., 521.
State vs. *Wilson*, 39 Mo. App., 114.
In Wharton on Evidence, Vol. 1, Sec., 326.
Lake Merced Water Co. v. *Cowles*, 31 Cal., 216, and many others.

These cases merely establish the well-known rule of evidence laid down in

Wharton on Evidence, Vol. I., Sec. 326, where the learned author says:

> "While a court takes notice of its own records, it cannot travel for this purpose out of the records relating to the particular case. Thus, in one case the Court cannot take notice of the proceedings in another case, unless such proceedings are put in evidence."

1 Jones on Evidence, Sec. 124 (1896), where the learned author says:

> "The Court in which a cause is pending will take judicial notice of *all its own records* in such cause and of the proceedings in the Court relating thereto. * * * But in a given case the Court is not held to have judicial knowledge of the pendency of *proceedings in other causes* in the same Court, much less of those in other courts, for example that there has been a former adjudication; nor does the Court take notice of the contents of a record in another action then pending; nor that the pending case has connection with another formerly decided by the Court; nor that in another action there has been a conviction or an acquittal; nor that another action is pending involving similar questions."

A single glance at the list of cases above cited will show how universal this rule of evidence is, for these cases are taken from the reports of the courts of a large number of the States of the United States. We desire specially to invite the attention of the Court to certain of them.

(a.) As to not taking judicial notice by a court of matters previously pending in the same Court in the absence of proper proof, see

McCormick vs. *Herndon*, 67 Wis., 648.

This was an action of ejectment, and the Court said:

> "It is claimed that the questions of title and possession here involved had been adjudicated by the same Court in a former action of ejectment, in which this plaintiff recovered from this defendant the possession of another piece of land of twenty acres as to which the title was the same as to the land in question except as to the tax deed. But as no such former adjudication was either pleaded

or proved, we do not regard the question before us for consideration. It is said that records of the Court in such other case were present and that the Court took judicial notice of them; and besides that the facts shown by such records stood admitted. We fail to find in the record any such admission or that the Court took such judicial notice; besides, we are not aware of any rule of law authorizing such judicial notice. If plaintiff relied upon such former adjudication she should at least have proved it as a fact in the case."

Downing vs. *Howlett*, 6 Colo. App., 291.

Here the Court said:

"There is some suggestion in the record that the trial Court was referred to a case in the Supreme Court of the State which would throw some light on the controversy and tend to show Howlett had been guilty of the acts complained of. While the decisions of that Court are matters of which all tribunals in the State take notice, we do not understand that there is any rule of evidence or any rule of practice which would make the record in any other suit evidence in a cause without its production and offer. Nor do we understand how the record in any other suit can be resorted to by any Court for the purposes of proof or the ascertainment of facts essential to charge defendant with a liability, unless in some one of the ways known to the law the record is produced and legitimately brought to the Court's attention."

Spurlock vs. *Missouri Pacific Ry.*, 76 Mo., 67 (1882).

Here the trial Court decided for the defendant on the ground that that case had been decided in favor of defendant in a former suit between same parties. That judgment did not, however, appear in the record. The Court said:

"It may be that the former judgment is a
" bar to recovery in the present action, but a
" plea of *res adjudicata* should be supported
" by proof that the matters in issue and de-
" cided in the first suit are the same as that
" presented for determination in the second,
" as neither the Circuit Court nor this Court
" can take judicial notice of such matters."

(*b.*) As to taking judicial notice by a judge in a case *pending before* him of matters in an earlier case, previously pending before him, see

State vs. *Edwards*, 19 Mo., 674 (1854),

where the Court said:

"Defendant's counsel * * * contends in this Court, that the Court below ought to have admitted these persons as witnesses because the fact of the conviction of one and a *nolle prosequi* as to the other were known to the Court before which the trial was going on; the Judge thereof having been the same Judge before whom, as a court in another county, these proceedings were had. To state this proposition is enough to make the absurdity thereof apparent."

Ralphs vs. *Hensler*, 97 Calif., 296 (304).

"Appellant further contends that the evidence does not justify the findings that Hardy died before the commencement of this action, that his will was admitted to probate, that letters testamentary were issued to plaintiff or that plaintiff ever qualified to act as executor." There is no evidence of these facts; nor is it claimed by counsel for respondent that there is. "But it is claimed that the Court took judicial notice of them, inasmuch as the probate proceedings in the matter of the estate of Hardy were in the same Court. In the first place, there is no evidence of any such proceedings in any court; and in the second place, it is too clear to admit of question that

> the judicial knowledge of the Court does not extend to the contents of its records in former actions or proceedings."

Baker vs. *Mygatt*, 14 Iowa, 131.

In this case the plaintiff sought to have an affidavit admitted in evidence, and insisted that the Court ought to take judicial notice of it, because it had been used in a previous case. The Court said:

> "The Court could not take judicial notice of the fact that the affidavit had been admitted in another case, nor could it be properly admitted on the ground that the Judge of the Court recollected that it was in that case and stated that it would be evidence against Mygatt in this case."

Lake Merced Water Co. vs. *Cowles*, 31 Calif., 216.

In this case the Judge of the lower Court refused to appoint commissioners to condemn land, on the ground that there was another petition pending before him for the condemnation of the same land at the suit of another water company. The Court said:

> "The pendency of the Clear Lake petition seems to have become known to the County Judge incidentally. No allusion was made to it in the petition filed by the Lake Merced Company, nor was its pendency proved at the hearing, and we apprehend that the Court could not under any circumstances take judicial notice of the fact, except it were for mere calendar purposes."

As will be seen from the report of the decision in the case of *Rumford Chemical Works* vs. *New York Baking Powder et al.*, 134 Fed. Rep., 385, the opinion was written by Judge Coxe, and was concurred in

by Judges Wallace and Townsend. Judge Wallace has retired, and Judge Townsend is dead, and obviously the only member of the Court upon the bench at the present time who has any personal knowledge of that case is Judge Coxe. The present opinion, as has been seen, is written by Judge Coxe, and it does not appear therefrom who was sitting, but in the petition it is averred that Judges Lacombe and Noyes also sat.

In the case at bar, it is obvious on the face of the record, that there was a failure by the complainant to prove anything whatsoever regarding the former litigation against the New York Baking Powder Company *et al.* It did not even appear who the parties were to that litigation, or what was involved therein, or what the outcome of it was. Judge Coxe, however, held that the Circuit Court of Appeals could supply these omissions by examining the records of the Court, and taking judicial notice of such essential matters as the complainant had omitted to prove. On behalf of the petitioners it is urged that this was error, in view of the decisions cited above, and error of such a nature that this Court should review the entire cause and authoritatively declare a rule which will prevent the extension of such procedure. If, in a cause between private suitors, the complainant's failure to prove a cause of action can be cured by permitting the Court to take judicial notice of the records in another suit between private suitors, it would obviously be quite impossible for a defendant to know in advance what matters might be considered by the Court in rendering a decision, and such loose procedure will inevitably lead to endless confusion. It is therefore urged that this is a question of great and general concern, and it is important that this Court should review the proceedings in the Circuit Court of Appeals for the Second Circuit, upon this question of evidence.

III.

A writ of certiorari should issue in this case to the Circuit Court of Appeals for the Second Circuit to review its decision herein.

Respectfully submitted,

WHITRIDGE, BUTLER & RICE,
Solicitors for Petitioners Hygienic Chemical Company and James E. Heller. and Adolph Hirsh

EDWIN T. RICE,
WILLARD PARKER BUTLER,
Of Counsel.

121.

No. [redacted]

FILED
APR 25 1908
JAMES H. McKENNEY,
CLERK

Supreme Court of the United States.

OCTOBER TERM, 1907.

HYGIENIC CHEMICAL CO. (OF NEW YORK), JAMES E. HELLER, and ADOLPH HIRSH,

Petitioners,

vs.

RUMFORD CHEMICAL WORKS,

Respondent.

RESPONDENT'S ANSWER TO PETITION FOR WRIT OF CERTIORARI.

PHILIP MAURO,
C. A. L. MASSIE,
Attorneys for Respondent.

C. G. Burroughs, Walker and Centre Streets, N. Y.

PRIOR DECISIONS ON CATLIN PATENT IN SUIT.

Rumford Chemical Works vs. New York Baking Powder Co., and Provident Chemical Works (Judge LACOMBE, at Circuit), 125 F. R., 231;

Same vs. Same (on appeal, Judges WALLACE, TOWNSEND and COXE), 134 F. R., 385;

Same vs. Same (Judge LACOMBE, holding Provident Chemical Works contributory infringer), 136 F. R., 873;

Same vs. Hygienic Chemical Works (Judge CROSS, in New Jersey), 148 F. R., 862;

Same vs. Same (on appeal, Judges DALLAS, GRAY and BUFFINGTON), 154 F. R., 65;

Same vs. Hygienic Chemical Works et al. (Judge HOLT, in New York), not yet reported;

Same vs. Same (on appeal, Judges LACOMBE, COXE and NOYES), not yet reported, but the subject of this Petition herein.

Supreme Court of the United States.

OCTOBER TERM, 1907.

HYGIENIC CHEMICAL COMPANY (of New York), JAMES E. HELLER, and ADOLPH HIRSH, Petitioners,

AGAINST

RUMFORD CHEMICAL WORKS, Respondent.

The Answer of the Rumford Chemical Works, Respondent, to the Petition of the Hygienic Chemical Company (of New York), James E. Heller, and Adolph Hirsh, Petitioners, for a Writ of *Certiorari*, to the Honorable the United States Circuit Court of Appeals for the Second Circuit, respectfully shows to this Honorable Court upon information and belief as follows:

I.

The respondent, the Rumford Chemical Works, is a corporation of the State of Rhode Island as alleged in the Petition.

II.

The respondent admits the correctness of the allegations in paragraph II. of the Petition, and the truth of the allegations therein attributed to respondent's Bill of Complaint; but the full truth in this regard is as follows:

First, the decision of the Court of Appeals in the suit against the *New York Baking Powder Co. et al.* (hereinafter called the

"test suit") is reported in Vol. 134 of the Federal Reporter, page 385. In the course of its decision, the Court of Appeals says:

> "Broadly stated, the invention consists of a baking preparation in which the phosphoric acid element is, practically, in a granular condition essentially free from pulverulent phosphatic material. [Bottom of page 385] * * * Catlin's invention resulted in "changing the properties of the powder so that it was transformed from a preparation which spoiled when exposed to the astmosphere into a successful commercial article" (page 388).
>
> "A percentage of coarse particles was found in the former [the prior art] and a percentage of fine particles is found in the latter [the patented product], but the predominating characteristics are that the former was essentially fine and the latter essentially granular (middle of page 387).
>
> "The invention, then, briefly stated consists in substituting granular for pulverulent phosphatic material in baking preparations" (middle of page 386). * * *

Second, the defendants in the said test suit made application to this Honorable Court for the Writ of *Certiorari* to correct the Decree entered in accordance with the foregoing decision,—the said application being docketed in this Court as No. 432 of the October Term, 1904; and on or about December 5, 1904, this Court *denied* the said application.

Third, one of the defendants in the said test case was the Provident Chemical Works, which manufactured the phosphatic-acid element, but did not itself combine the same with the soda to produce the complete baking preparation; but the Provident Chemical Works supplied this phosphatic-acid element to the New York Baking Powder Co. *et al.*, a joint defendant, which latter concern incorporated the phosphatic-acid element into the baking preparation. The effect of the decision by the Court of Appeals (134 F. R., 385) was to hold the said Provident Chemical Works a *contributory infringer*. Subsequent to the refusal of the Writ of *Certiorari*, a controversy arose in said test suit as to the accounting; and on January 3, 1905, his Honor Judge LACOMBE rendered a decision expressly holding that the said Provident Chemical Works was a contributory infringer as to the acid phosphate made by it and sold to the New York Baking Powder Co. *et al.*, and was liable equally

with the latter for profits and damages resulting from the sale of baking powder in which the acid contributed by the Provident Chemical Works had entered as an element. This decision is reported in Vol. 136 of the Federal Reporter, page 873.

Fourth, thereafter the amount of damages and profits was settled between this respondent and the defendants in said test cause, and on or about May 10, 1905, a final decree was entered therein and still remains in full force and effect. A copy of this Decree was served upon the petitioner herein more than six months prior to the final hearing in the Circuit Court, and a copy of the Notice and of the said Final Decree appear in the Transcript of Record at pages 148–151.

Fifth, James E. Heller, one of the petitioners herein and President of both of the Hygienic Chemical Companies named in the Petition, was active in assisting the defendants in the said test suit against the *New York Baking Powder Co., et al.* On or about May 28, 1901, he appeared as a witness for the defense therein. His testimony begins at printed page 1142 of the Transcript of said test cause (brought before this Court as stated under the docket No. 432 of the October Term, 1904). In the present suit it appears, from the quotations on page 11 of the Petition herein, that said Heller swore that the Hygienic Chemical Company is located at Elizabethport, *New Jersey*, where it "manufactures acid phosphate", "for baking powder purposes"; and that "*we* are manufacturers of granulated acid phosphate *and are selling it to the trade in the same way as the parties who are sued in this case, the Provident Chemical Works of St. Louis*"; and that "we have, most surely, *undertaken* to assist in bearing the burdens of this defense," "contributing to the defense financially and otherwise."

Sixth. The information being thus volunteered that the said Heller and his associates were doing the very same things that the Provident Chemical Works was being sued for, this respondent undertook to hold them also liable as infringers of its Catlin patent; and accordingly, on or about May 20, 1902, brought its Bill of Complaint against the said Heller and his associates (hereinafter called the "original Hygienic suit"), naming in all *four* defendants, viz.:

1. Hygienic Chemical Company (a New Jersey corporation);
2. Hygienic Chemical Company (a New York corporation);
3. James E. Heller; and
4. Adolph Hirsh,

the two last named being sued not only as officers of the two corporations but also individually and as members of the firm of "Heller, Hirsh & Company." Appearances was duly entered for all four of the defendants just named by Messrs. Briesen & Knauth, who were at the same time solicitors and of counsel for the defendants in the said test suit against the *New York Baking Powder et al.;* and on or about Aug. 26, 1902, an Answer was filed by the said Messrs. Briesen & Knauth on behalf of the said four defendants in the said original Hygeinic suit. At that time there were pending throughout the United States a number of other suits brought by this respondent against various infringers of its Catlin patent aforesaid; and pending the determination of the said test suit against the *New York Baking Powder Company et al.*, the prosecution of the other suits was suspended by agreement with Messrs. Briesen & Knauth aforesaid.

Seventh, after the decision by the Court of Appeals, reported in 114 F. R., 385, and after this Court had refused the Writ of *Certiorari* to correct the Decree entered in the said test suit, this respondent moved for preliminary injunction against the defendants in the said original Hygienic suit; and upon the return day of said motion, this respondent learned that an *ex parte* order had recently been entered, on behalf of the defendants therein, dismissing the Bill of Complaint therein for want of Replication to the Answer. Thereupon, this respondent caused a new bill to be filed (being the Bill of Complaint herein, that is referred to in paragraph II. of the Petition), naming the same four defendants; and, upon motion for preliminary injunction, his Honor Judge LACOMBE on or about September 6, 1904, granted a preliminary injunction against the New York corporation defendant known as the "Hygienic Chemical Company," with leave to renew the motion against the other defendants upon further proofs.

III.

The respondent admits the correctness of the allegations in paragraph III. of the Petition.

IV.

The allegations in paragraph IV. of the Petition are substantially correct, except that the two suits there referred to were *not*

brought "simultaneously" as stated in the Petition, nor was this respondent responsible for there being *two* suits. The facts in this regard are as follows:

As above stated, the Bill of Complaint herein named *four* defendants, one of which was the *New Jersey* corporation known as the "Hygienic Chemical Company," which this respondent's said Bill averred to have a regular and established place of business within the Southern District of New York and an authorized agent in said District (to wit: the New York corporation of the same name,—"Hygienic Chemical Company"), and to have committed within the said District the acts of infringement complained of. But a Plea to the jurisdiction was filed on behalf of the said New Jersey corporation, verified under oath, and asserting that the said New Jersey corporation had no place of business whatever within the said Southern District of New York. Thereupon, and solely for that reason, this respondent caused its said Bill of Complaint, without prejudice, to be dismissed as to the said New Jersey corporation, by an order filed on or about October 26, 1904 (page 9 of the Transcript herein); and the next day this respondent caused its new Bill of Complaint to be filed in the Circuit Court of the United States for the District of New Jersey against the said New Jersey corporation,—this last named suit being the suit referred to in paragraph IV of the Petition—and the same Messrs. Briesen & Knauth entered their appearance therein as solicitors and of counsel for the said New Jersey corporation.

Thus the prosecution of two separate suits simultaneously was due to the defendants' own conduct, which thereby inflicted upon this respondent a doubled burden of litigation in two different circuits.

Long subsequent to filing the New Jersey suit, the present counsel and solicitors, Messrs. Whitridge, Butler & Rice, were substituted in place of Messrs. Briesen & Knauth in each of the two suits (see page 133 of the Transcript herein).

V.

In answer to paragraph V. of the said Petition, this respondent avers that since 1879 the said James E. Heller and the said Adolph Hirsh (two of the Petitioners herein) have been and still are engaged in business as a copartnership under the name of "Heller, Hirsh

& Company" as Brokers and Commission Merchants handling *fertilizers*, which they admit is entirely distinct from the business of manufacturing and selling acid phosphates; that prior to 1890 the said Heller, Hirsh & Company (still consisting of the said Petitioners James E. Heller and Adolph Hirsh) commenced as a new and separate enterprise the manufacture and sale of *acid phosphate* for baking powders and other purposes, but primarily and particularly for baking powder purposes, their factory being located at Elizabethport, N. J.; and that on or about April 17, 1893, the said Heller and the said Hirsh incorporated under the laws of the State of New Jersey their said business of manufacturing acid phosphate, giving the corporation the name "Hygienic Chemical Company"; and five days later, the said Heller and the said Hirsh, under the laws of the State of New York, created a corporation to which they gave the same name, "Hygienic Chemical Company," for the purpose of selling the acid phosphate manufactured by their New Jersey corporation of the same name.

With the exception of a few shares held by others for the purpose of qualifying them as directors, the said Heller and the said Hirsh held all the shares of each of the two Hygienic Chemical Companies, and they still hold a majority thereof and control the two corporations; the said Heller is still President and the said Hirsh is still Treasurer of the two Hygienic Chemical Companies, and the said Heller and Hirsh are still directors of the two Companies. Moreover, the said Heller and the said Hirsh are still in absolute control of the business carried on by each of the two Companies and dictate the policies thereof. The said Hygienic Chemical Companies have held themselves out by advertisements and particularly by their letter heads as *manufacturers of acid phosphate for baking powder purposes*, and the said Heller in particular has made it his business to keep posted as to the requirements of the baking-powder trade, and endeavored as far as he could to satisfy those requirements by the kind and quality of acid phosphate manufactured by one of his Companies and sold through the other. And when this respondent instituted its said test suit against the *New York Baking Powder Co., et al.* (above referred to as the "test suit"), the said Heller and Hirsh and the said Hygienic Chemical Companies thereupon, feeling their interests at stake, undertook to assist in the defense of said test suit, because they were manufacturing a granular acid phosphate (complained of in the

test suit) and were selling it to the trade *in the same way* as the Provident Chemical Works, which was being sued in said test suit for manufacturing granular acid phosphate and selling it to the baking powder concerns. The said Heller and others of his associates in said business appeared as witnesses for the defense in the said test suit and admitted voluntarily that they had undertaken to assist in bearing the burden of that defense, and that they were contributing financially and otherwise to the said defense, and the said Heller admitted that he had promised the President of the said Provident Chemical Works to give the case of those defendants all the attention he could.

It is true as stated in the Petition that the *New Jersey* Hygienic Chemical Company is a manufacturing concern, and it sells its product only through the New York concern of the same name; while the *New York* Hygienic Chemical Company is not a manufacturing concern but a selling concern only, and it sells the product of the New Jersey concern. During some part of the time of the commission by the two Hygienic Chemical Companies of the acts complained of by this respondent as infringements, the *New Jersey* Hygienic Chemical Company had a regular and established office for the transaction of business in the Borough of Manhattan and City of New York, to wit, the main office of the *New York* concern of the same name, whence bills were rendered in the name of the *New Jersey* Hygienic Chemical Company for its product sold by the *New York* Hygienic Chemical Company on behalf of said *New Jersey* manufacturing concern (see Hygienic Bill on page 98 of the Transcript herein).

Such being the facts of the case, this respondent brought a single Bill of Complaint in the Southern District of New York against all of the defendants named, upon the ground that they were identical in interest so far as the manufacture and sale of the infringing article is concerned; but when the New Jersey corporation filed its Plea to the jurisdiction, this respondent, in order not to delay the prosecution of the cause, brought the companion suit in the District of New Jersey (as already stated). And it was then stipulated that the same record should be taken simultaneously in each of the two causes; and the record was so taken, as stated in the Petition.

Upon the facts as above stated, which appear in the Transcript herein, this respondent contended and still contends that all four of the concerns named (viz., the two Hygienic Chemical Companies and the two individuals Heller and Hirsch, constituting the firm of

Heller, Hirsh & Company) were *identical* in interest ; and that the manufacture by the New Jersey concern, under the directions of Heller and Hirsh, of acid-phosphate especially adapted for use in baking preparations and the sale to baking-powder manufacturers, by the *New York* concern on behalf of the *New Jersey* concern, also under direction of the said Heller and Hirsh, of said granular acid phosphate—rendered all four equally liable as contributory infringers of the patent in suit ; and that the admitted participation in the defense of the said test suit by any one of the four concerns named rendered all four of them privies to the defense of said test suit. And this respondent contends further that the said Heller participated personally and actively in the defense of the said test suit, and that each of the two Hygienic Chemical Companies contributed financially and otherwise, under an agreement with the Provident Chemical Works, in the defense of said test suit ; and that the said Adolph Hirsh, since he is not only one of the managing directors and one of the two principal officers and one of the two joint owners of practically all of the stock of the two Hygienic Chemical Companies, but also since he is the *partner* of the said Heller, was likewise a privy to the defense of the said test suit. And as already stated, any act of participation by any one of the four, sufficient to render him a privy, renders all the others privies also ; and any proof of privity as against any one of the four is competent and sufficient proof as against all four of them.

And further answering the said paragraph V. of the Petition, this respondent says, *First*, the said James E. Heller testified both in the test suit and also in the present suit that he was president of the Hygienic Chemical Co. of Elizabethport, N. J. ; that he felt that the said test suit was directed against his interests, and that he, therefore, undertook to assist in the defense therein by contributing financially and otherwise, and that he personally gave a great deal of attention to the conduct of the defense, and that he was under agreement with the President of the said Provident Chemical Works to do so. Moreover, *Second*, the said Heller admitted in the present suit his testimony in the former suit that the Hygienic Chemical Company was located at Elizabethport, N. J., and that "we" were *manufacturing* and *selling* to the trade (thus including *both* Hygienic Chemical Companies with himself), selling to the trade in the same way as the Provident Chemical Works ; and that the same "we" *had undertaken* to assist in the defense of said test suit, and that the same "we" *were* so assisting financially and other-

wise. In the *Third* place, the said Heller in the present suit testifies that the *New York* Hygienic Chemical Company was the participator in the defense of the test suit; but he '*did not remember*' whether any experiments or tests had been made by the *New Jersey* concern for the purpose of assisting in the defense of the test suit, and 'as near as he remembers,' *he doesn't think* the New Jersey concern assisted financially, and he '*doesn't remember*' whether they assisted otherwise in the defense of the test suit.

Further answering said Paragraph V. of the Petition this respondent shows to the Court that the said Heller and one Walter E. Wadman, the factory Superintendent of the *New Jersey* Hygienic Chemical Company, appearing as unwilling witnesses for this respondent (under *subpœna*), testified that the said *New Jersey* Hygienic Chemical Company had been manufacturing acid phosphate in granular form, which was sold through the *New York* Hygienic Chemical Company, and which was put up in the granular form for the express purpose of adapting it for baking-powder purposes,—because 'it *had* to be granular before it could be used for baking-powder'; and that they discontinued this when they had notice of the above-mentioned injunction granted by Judge LACOMBE. And the said Wadman testified further that the said granular acid phosphate put out by said Hygienic Chemical Companies, under the designation "Special" Hygienic Phosphate, had been put up in granular form for the very purpose of adapting it for use in baking preparations, being the very purposes recited in the Catlin patent in suit.

Furthermore, there appears on pages 98, 99 of the transcript herein a bill and receipt that *prima facie* emanated from the Hygienic Chemical Company *of New Jersey;* although the same are dated *New York*, which documents specify a certain barrel of granular acid phosphate which (together with the two documents) came into the possession of this respondent's witnesses, whose testimony shows that the contents of the said barrel constituted an infringement of the Catlin patent in suit. And the said Heller, being twice given an opportunity to deny the genuineness of the Hygienic bill and receipt aforesaid, was unable to do so.

Further answering paragraph V. of the Petition, particularly the quotations from the opinion of his Honor Judge CROSS, this respondent refers to the full opinion of Judge CROSS appearing in Volume 148 of the Federal Reporter, beginning at page 862 thereof, and also appearing in the transcript now on file in this Honorable

Court in connection with this respondent's Petition for *Certiorari* to the Honorable United States Circuit Court of Appeals for the Third Circuit, referred to at the close of Paragraph V. of this Petition.

This respondent further shows that upon receipt of Judge CROSS' opinion (148 F. R., 862) it had petitioned his Honor for a rehearing, but without success. A copy of the said Petition appears in the transcript annexed to the respondent's aforesaid application to this Honorable Court for *Certiorari* to the Court of Appeals for the Third Circuit, beginning on page 119 thereof; and this respondent respectfully refers to its said petition to the Circuit Court in New Jersey for rehearing, as a part of this Answer.

And, in answer to the last paragraph of paragraph V. of the said Petition, this respondent admits that it made application to this Honorable Court for the Writ of *Certiorari* to review the decision of the Court of Appeals for the Third Circuit (reported in 154 F. R., 65), as alleged in the Petition, and that the same was denied by this Court on or about October 21, 1907,—*during the present Term.* And this respondent is advised and believes, and therefore avers, that this Court *still has power*, upon the presentation *now* made, to reconsider and grant this respondent's said Petition for the Writ of *Certiorari* to the Court of Appeals for the Third Circuit,—since the October, 1907, Term of this Court (during which the respondent's said petition was presented and refused) has not yet expired, and the matter still remains within the control of this Court.

VI.

This respondent says that the allegations of the first three paragraphs of paragraph VI. of the said Petition (including the first quotation therein) are substantially true. But, moreover, as already shown, the identical proofs in the two causes show not only that the *New Jersey* Hygienic Chemical Company is the manufacturing concern, but also that it sells its product only through its New York namesake, the affiliated *New York* Hygienic Chemical Company; and not only is the *New York* Hygienic Chemical Company a selling-concern, but also that it is the selling agent for the product manufactured for it by the *New Jersey* Hygienic Chemical Company; and in addition that the peculiar predominating characteristic of the acid phosphate complained of was given to it intentionally, at

the suggestion of Mr. Wadman, Superintendent of the New Jersey concern, and under authorization of said James E. Heller, the President and half owner of both Hygienic Chemical Companies, for the express purpose of adapting it for use in baking preparations; and that as soon as Judge LACOMBE's preliminary injunction was issued, the output of the said granular acid phosphate was discontinued.

In answer to the remainder of the said paragraph VI. of the Petition, this respondent shows first that three months before the hearing before Judge HOLT, the respondent served on the Petitioners herein, under date of January 9, 1907, a notice that at the final hearing therein, it would produce the official printed copy of the entire deposition of the deceased witness Clotworthy (referred to in paragraph VI. of the Petition). The notice and the admission of service thereof appear on page 152 of the Transcript herein. The complete testimony of the said witness Clotworthy is now on file in this Honorable Court in connection with the first-named application for *Certiorari* under the docket No. 432 of the October Term, 1904—appearing on printed pages 201-229, 252-265 thereof.

VII.

Further answering the Petition herein, this respondent respectfully shows that—the two Hygienic Chemical Companies and the two individuals (Heller and Hirsh) being all four of them identical in interests as above pointed out—the following decisions have been rendered in this litigation upon the very same proofs:

1. The Court of Appeals for the SECOND Circuit has sustained the proofs as sufficient to hold liable the *New York* corporation and Heller (nothing appearing affirmatively as to Heller's partner Hirsh, who nevertheless joins in the Petition): but since the *New Jersey* concern was not before the said Court of Appeals for the SECOND Circuit, that Court had no authority to say whether or not the New Jersey corporation was liable to this respondent.

2. The Court of Appeals for the THIRD Circuit had before it only the *New Jersey* corporation, yet it held that the *New York* corporation and Heller were privies to the test suit (which question was not properly before *that* Court); and it

regarded the proofs as insufficient to hold the *New Jersey* concern liable, saying nothing as to the real identity of all the defendants.

3. In other words, the two Courts of Appeals are *in harmony* in holding that the New York corporation and James E. Heller (Petitioners herein) were privies to the former test suit; and the two Courts of Appeals are *in harmony* in not holding the proofs sufficient to render the New Jersey concern (when *separately* considered) also liable. But the Court of Appeals for the Second Circuit has pointed out that the confusion has arisen because of the identity in name of the two corporations for which this respondent was not responsible; and neither Court has discussed the evidences of identity of interests. But, "The Court, when necessary, will look beyond the name of a corporation to the individuals whom it represents" (*McKinley vs. Wheeler*, 130 U. S., 630, 636. See, also, *Hall vs. Safe Co.*, 143 F. R., 231, 237).

VIII.

Nevertheless, if the respective decisions by the two Courts of Appeals should remain unmodified, the situation will present a conflict; and this respondent fears and has reason to fear that when it undertakes the accounting awarded it against the defendants in the New York case (the Petitioners herein), then they will undertake (with much success) to make it appear that all the "profits" due to the infringement have been received by the *New Jersey* corporation, the manufacturing concern, and that all or the greater part of the "damages" caused your respondent in the premises have been caused by the said *manufacturing* concern—against which latter this respondent would be without redress if the decision of the Court of Appeals for the Third Circuit remains unreversed.

Wherefore, upon the record of this cause as above shown, and also upon the record of the cause arising in New Jersey (which is now before this Honorable Court under this respondent's recent application aforesaid for writ of *Certiorari* to the Court of Appeals for the Third Circuit), this respondent respectfully submits that this Honorable Court should do either one of two things:

1. *Refuse* the Writ of *Certiorari* to the Court of Appeals for the SECOND Circuit, prayed for herein by the present Petitioners, upon

the ground that there is no pertinent want of harmony between the decisions of the respective Courts of Appeal ; *or*

2. Issue not only its Writ of *Certiorari* directed to the Court of Appeals for the SECOND Circuit (as prayed for by the present Petitioners), but also issue a similar Writ directed to the Court of Appeals for the THIRD Circuit, in order that the entire matter may be brought to a single uniform determination, so that all four of the infringers may be held liable to us, and that complete justice may be done in the premises.

Dated, April 23, 1908.

Respectfully submitted,

RUMFORD CHEMICAL WORKS,
By PHILIP MAURO,
C. A. L. MASSIE,
Attorneys.

Service of three (3) copies of the foregoing Answer admitted this 23rd day of April, 1908.

WHITRIDGE, BUTLER & RICE,
Solicitors for Petitioners.

FILED
OCT 26 1909
JAMES H. McKENNEY

No. 121.

SUPREME COURT OF THE UNITED STATES

HYGIENIC CHEMICAL CO. (OF NEW YORK), JAMES E. HELLER AND ADOLPH HIRSH

Petitioners

vs.

RUMFORD CHEMICAL WORKS

Respondent.

ON WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT

BRIEF FOR THE HYGIENIC CHEMICAL CO. (OF NEW YORK), JAMES E. HELLER AND ADOLPH HIRSH, PETITIONERS

WHITRIDGE, BUTLER & RICE
Solicitors for Hygienic Chemical Company of New York et al.

WILLARD PARKER BUTLER
EDWIN T. RICE
Of Counsel

THE EVENING POST JOB PRINTING OFFICE, 156 FULTON ST., N. Y.

Supreme Court of the United States.

HYGIENIC CHEMICAL COMPANY OF NEW YORK, JAMES E. HELLER and ADOLPH HIRSH, Petitioners, v. RUMFORD CHEMICAL WORKS, Respondent.	October Term, 1908. No. 339.

On writ of certiorari to the Circuit Court of Appeals for the Second Circuit.

Brief for the Petitioners.

The brief heretofore filed in behalf of the defendants states the principal grounds upon which the defendants rely. Since the preparation of that brief, counsel for the petitioners has received the brief of the counsel for the Rumford Chemical Company, entitled in the above case and also in case No. 149, Rumford Chemical Company *v.* Hygienic Chemical Works of New Jersey.

As this brief contains statements outside of the record, and also misstatements of matters within the record, counsel for the petitioners in No. 339 desires to file the following brief supplementary to that now on file.

I.

The verified answers of the defendants in the New York suit, as well as in the New Jersey suit, contain the fullest, explicit denials of the charges of infringement contained in the bills of complaint.

Not only, therefore, is the statement of complainants' counsel that infringement is made out by the defendants' own admissions, entirely without foundation, but it is entirely clear from the well-settled rules of equity pleading and procedure that these verified answers require the testimony of at least two witnesses, or of one witness and corroborating circumstances to make out a *prima facie* case and to entitle the complainant to a decree.

Carpenter *v.* Providence Washington Insurance Co., 45 U. S., 184.
Hughes *v.* Blake, 6 Wheaton, 453.
Morrison *v.* Durr, 102 U. S., 518.
Latta *v.* Kilbourne, 150 U. S., 524.

II.

Infringement is denied not only in the verified answers, but also in the sworn testimony of the witnesses Heller and Wadman.

Heller testified that the complainant's exhibit, Hygienic Special, "does not resemble any of the product manufactured by the Hygienic Chemical Company of New Jersey, as all of the product made

by them, as near as I can remember, contained very large percentage of extremely fine material" (Record, 339, p. 20). The witness Wadman, on being shown this exhibit, also testified that it was different from the product of the Hygienic Chemical Company (Record, 339, p. 37).

Again Wadman testified: "Q. Is the Hygienic Chemical Company, the New Jersey concern, at this time manufacturing an acid phosphate containing some finely powdered material and some in a coarser condition? A. Yes, and at no time did it make any other" (R., No. 339, p. 37).

So far, therefore, from admitting the manufacture and sale of an infringing phosphate, both witnesses expressly deny it.

III.

The proof of the identity of the barrel of acid phosphate said to have been sold by the defendants to the Clotworthy Chemical Co., from which the sample, Complainants' Exhibit, Hygienic Special, is said to have been obtained, is entirely insufficient.

Even if the Clotworthy deposition be admitted, all that it proves is that Clotworthy bought of one of the defendants a barrel of acid phosphate. Whether this barrel was opened by Clotworthy in Baltimore, or whether it was received by the complainants' witnesses in Rhode Island in the condition in which it was sold by the defendants, nowhere appears; and as the inquiry is a very narrow one, and as both Heller and Wadman deny

that the sample put in evidence is a fair sample of the defendants' product, it is clear that no reliance should be placed by the Court upon this branch of the complainants' case.

If the acid phosphate sold by the defendants or any of them to the Clotworthy Company contained at the time of its shipment any sufficient amount of fine or pulverulent material, the defendants did not infringe.

Nothing would be easier than to screen out a portion of the finely divided material, or to take unfair samples for the purpose of making a test, and, in the absence of any evidence as to how this part of the inquiry was safeguarded, it would be entirely unjust and improper to receive this as evidence of the defendants' infringement.

IV.

The judgment in Rumford Chemical Works vs. New York Baking Powder Company et al., even if otherwise sufficiently proved, has no effect as an estoppel, except as to matters directly there in issue.

Presumably all that was adjudicated in that suit is that the defendants, or some of them, infringed the complainants' patent. What the infringing substance was has not been proved in this suit, nor its resemblance to the acid phosphate alleged to have been sold by the defendants.

It is entirely clear that the judgment in the New York Baking Powder Company case is not an estoppel as to the defendants in the cases at bar, except as to the validity of the patent. The Clot-

worthy deposition, so far as it has been sought to be read in evidence, relates apparently to acid phosphate said to have been sold by one of the defendants to the Clotworthy Chemical Company, a matter which was not in issue in the New York Baking Powder Company case.

The defendants in the present litigation, therefore, had no interest in examining the witness Clotworthy, or of testing or limiting the effect of any evidence which Clotworthy may have given in the prior suit. The Clotworthy deposition should, therefore, not be received against the defendants in the present suits, which are upon other causes of action, and relate to other matters than those in issue in the New York Baking Powder Company case.

Cromwell *vs.* County of Sac, 94 U. S., 351-3.

Respectfully submitted,

WHITRIDGE, BUTLER & RICE,
Solicitors for the Defendants.

WILLARD PARKER BUTLER,
EDWIN RICE,
Of Counsel.

OCT 19 1909
JAMES H. McKENNEY

Supreme Court of the United States.

OCTOBER TERM, 1909.

RUMFORD CHEMICAL WORKS, *Petitioner,*
vs.
HYGIENIC CHEMICAL CO. (of New Jersey).

No. 9.

ON WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE THIRD CIRCUIT.

HYGIENIC CHEMICAL CO. (of New York), JAMES B. HELLER and ADOLPH HIRSH, *Petitioners,*
vs.
RUMFORD CHEMICAL WORKS.

No. 121.

ON WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

BRIEF OF ARGUMENT FOR RUMFORD CHEMICAL WORKS.

PHILIP MAURO,
C. A. L. MASSIE,
Of Counsel.

C. G. Henderson, 70 to 76 Spring street, New York.

PRIOR DECISIONS ON CATLIN PATENT IN SUIT.

Tarr Case:

Rumford Chemical Works vs. New York Baking Powder Co. and Provident Chemical Works (Judge Lacombe—2d Circuit), 135 F. R., 281;

Same vs. Same (Judges Wallace, Townsend, and Coxe—on appeal), 134 F. R., 985;

Same vs. Same (Judge Lacombe, holding Provident Chemical Works "a Contributory Infringer"), 136 F. R., 978;

Same vs. Same, Defendants' Petition for Certiorari denied December 5, 1904, 198 U. S., 605;
Case No. 429, October Term, 1904.

New York Case (No. 339):

Same vs. Hygienic Chemical Co., Heller, and Hirsh (Judge Hole—2d Circuit),
Not yet reported; (see Tr. No. 339, p. 30);

Same vs. Same (Judges Lacombe, Coxe, and Noyes—on appeal), 150 F. R., 498;

Same vs. Same, Defendants' Petition for Certiorari granted May 4, 1908, 209 U. S., 550;
Case No. 339, October Term, 1908.

New Jersey Case (No. 149):

Same vs. Hygienic Chemical Co. (Judge Coxe—2d Circuit), 145 F. R., 1;

Same vs. Same (Judges Dallas, Gray, and Buffington—on appeal), 154 F. R., 65;

Same vs. Same, Complainant's Petition for Certiorari denied October 28, 1907, 207 U. S., 593;

Same vs. Same, Complainant's Petition for Certiorari granted June 12, 1908, 210 U. S., 435;
Case No. 149, October Term, 1908.

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Supreme Court of the United States,

OCTOBER TERM, 1908.

RUMFORD CHEMICAL WORKS, Petitioner, vs. HYGIENIC CHEMICAL CO. (of New Jersey).	No. 149.

ON WRIT OF CERTIORARI TO CIRCUIT COURT COURT OF APPEALS FOR THE THIRD CIRCUIT.

HYGIENIC CHEMICAL CO. (of New York), JAMES E. HELLER, and ADOLPH HIRSH, Petitioners, vs. RUMFORD CHEMICAL WORKS.	No. 339.

ON WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

BRIEF OF ARGUMENT FOR RUMFORD CHEMICAL WORKS.

I.

Statement.

The two causes entitled as above were tried, the one in the Third Circuit, and the other in the Second, on proofs which were identical; and the records of the two causes in this Court are

identical in nearly all matters of substance, the differences being mainly in the respective decisions reached by the two trial Courts and the two Courts of Appeal, and in the proceedings thereon.

The portions of the record common to the two causes are omitted from the printed Transcript of No. 149. The citations in this brief will therefore be from the Transcript of No. 339, unless otherwise noted.

History of the Litigation.

These suits were prosecuted by the Rumford Chemical Works for the purpose of getting the benefit of the decision of the Circuit Court of Appeals, Second Circuit, in *Rumford Chemical Works vs. New York Baking Powder Co., Provident Chemical Works, et al.* (134 F. R., 385; 67 C. C. A., 367; see 136 F. R., 873), sustaining the Catlin patent No. 474,811, dated May 17, 1892, for Improvement in Baking Preparations. (*Certiorari* denied by this Court Dec. 5, 1904; see Docket No. 432, October Term, 1904, and 195 U. S., 635.)

That case was one of a number of suits brought on the same patent, and was prosecuted to hearing as a test case. For sake of brevity we will refer to it herein as the "test case."

One of the witnesses and active participants in the defense of the test case was Mr. J. E. Heller, who was the President of both the Hygienic Chemical Companies, and who with his co-partner Adolph Hirsh (composing the firm of Heller, Hirsh & Co.) organized both said Companies, and jointly owned, at the time of their organization, all the capital stock therein, except a few shares required to qualify some "dummy" directors. (See Exhibit Certificates of Incorporation, Tr. 339, pp. 50, 52.)

One of the issues to be decided by this Court is the legal effect of the participation by said Heller in the defense of the test case, it being the contention of the Rumford Chemical Works that the facts in that regard render both Hygienic Companies privy to the test case, at least for the purposes necessary to give the Rumford Chemical Works the relief prayed in its bills of complaint herein.

In his testimony in said test case, said Heller testified (Tr., 339, p. 21), *inter alia*, as follows:

> "Q. 7. Are you interested in this suit? If so, in what manner?
>
> "A. We are *manufacturers* of granulated acid phosphate and are *selling* it to the trade *in the same way as the parties who are sued in this case*, the Provident Chemical Works of St. Louis.
>
> "Q. 8. Have you undertaken to assist in bearing the burdens of this defense?
>
> "A. We have, most surely.
>
> "Q. 9. Contributing to the defense financially and otherwise?
>
> "A. We have, financially and otherwise." (Italics ours.)

These answers were given voluntarily in response to questions of defendants' own counsel in that case. The statements are explicit, and the only question left open is, for whom besides himself did Mr. Heller speak in making these admissions? Who are included in the "*we* are manufacturers of granulated acid phosphate and are selling it to the trade," etc.?

The Twin "Hygienic" Companies.

Among the matters referred to in the testimony in the test case was a barrel of "Special Phosphate" purchased from the "Hygienic Chemical Co." by one W. P. Clotworthy, then of Baltimore, now deceased. This purchase was made by Mr. Clotworthy on behalf of the Rumford Chemical Works, and the barrel of Hygienic "Special" granulated phosphate so purchased by him was sent to the latter, and it formed the basis of complainant's technical proof of infringement in the present suits.

There were also introduced in evidence in the test case the Hygienic Chemical Company's original invoice and its original receipt for payment for this barrel of "Special" phosphate, and photolithographic copies thereof have been introduced in these cases, said copies, by stipulation, being accepted in lieu

of the originals (Stipulation, Tr. 339, p. 49). By reference to these papers (following p. 58 of the Transcript) it will be seen that the invoice reads:

" NEW YORK, March 13, 1901,

Clotworthy Chemical Co., Baltimore, Md.
Bought of Hygienic Chemical Co.
of New Jersey.
Manufacturing Chemists.
Offices 62 and 64 William St.,
New York City.
Bbl. Special Phosphate" etc.

And the receipt for payment reads:

" Hygienic Chemical Co.
New York, N. Y." &c.
[with a rubber stamp impression reading]
" Received Payment
Mar. 25 1901
The Hygienic Chemical Co."

On investigation by complainant concerning the "Hygienic Chemical Company" it was found that there were *two* Companies of identical name, both organized and owned by Heller and Hirsh, as already stated, one incorporated under the laws of New Jersey, April 14, 1893 (p. 53), and the other under the laws of New York, April 21, 1893 (p. 51). These twin companies replaced an earlier company of the same name which had been incorporated by Heller and Hirsh under the laws of West Virginia (p. 22, Qs. 61, 62). In all this there is much opportunity to confuse any one having occasion to seek relief against the single interest which had so many distinct corporate existences.

It was elicited by the deposition of Heller (Tr., 339, p. 15, bottom) that the New Jersey company *manufactured* the phosphate and other products, and that the New York twin did the *selling* of the articles manufactured by the former.

The existence of these two companies of identical name, organized by the same persons, and jointly engaged in the same business, conducted at the same office (which is also the office of the firm of Heller, Hirsh & Co.), has created the confu-

sion and difficulty presented by this case, and furnishes the chief basis for the technical defense which has been set up. Defendants seek to have it appear that the sale of the barrel of "Special" phosphate to Clotworthy was made by the Hygienic Company of *New Jersey;* and that it was the Hygienic Company of *New York* which participated in the test case. Hence (it is contended) complainant could not produce against the New Jersey corporation secondary evidence of matters testified by Clotworthy, deceased, because it was the New York corporation that was privy to the test case; whereas such evidence is unavailing (so they say) against the New York Hygienic Co., because the infringing act (it is contended) was that of its New Jersey twin and namesake.

Complainant originally joined both Hygienic Companies in one bill with Heller and Hirsh individually, and as members of the firm Heller, Hirsh & Co., in the suit brought in the Southern District of New York (Tr., 339, p. 1); but on technical objection to jurisdiction as to the *New Jersey* Hygienic Co., it was necessary to dismiss the bill as to that Company and bring a separate bill against it in the District of New Jersey.

Thus the litigation divided into two branches.

The New Jersey Suit (No. 149).

Complainant took the same *prima facie* proofs in both cases. It called Heller and his factory manager, Wadman, (both of whom gave testimony in the test case), and secured what admissions were possible from these adroit and evasive witnesses.

Complainant also undertook to prove the purchase of the aforesaid barrel of "Special" phosphate from the Hygienic Chemical Company, and it made (by stipulation) the usual expert proof that the said "Special" phosphate was, when used as or in a baking preparation, the granular acid phosphate of the Catlin patent (Stipulation, pp. 45, 46).

One of the links of the chain of facts connecting the Hygienic Chemical Companies with the manufacture and sale of this barrel of "Special" phosphate, was the purchase of the barrel of "Special" phosphate by said Clotworthy, as was testified in the deposition of Mr. Clotworthy

given in the test case. He being deceased, complainant produced Mr. Arnold, who was present when Mr. Clotworthy gave his deposition, and Arnold deposed that said Clotworthy had testified to his purchase from the Hygienic Chemical Co. of said barrel of "Special" phosphate, and to his (Clotworthy's) shipping it, together with the said Exhibits "Hygienic Company Bill" and "Hygienic Company Receipt" to said Arnold (Tr., pp. 48, 49).

To complainant's *prima facie* proofs defendants made no reply in either case, but relied upon alleged defects in complainant's proofs.

The New Jersey case came first to hearing before Judge CROSS (D. J.) who dismissed the bill, holding that complainant's proofs did not make out a *prima facie* case of infringement against the New Jersey Co. Judge CROSS held that the proofs did not show that the *New Jersey* Hygienic Co. was privy to the test case; that hence proof of what Clotworthy had testified therein was not admissible against said New Jersey Corporation; and that without Clotworthy's testimony a *prima facie* case was not made (148 F. R., 862; Tr. 149, p. 17).

On appeal this decision was affirmed by the Court of Appeals for the Third Circuit (154 F. R., 65; Tr. No. 149, p. 38). That Court held that the lower Court had properly decided that there was insufficient proof of infringement by the *New Jersey* defendant, "*if the testimony of one Clotworthy was rightfully excluded*"; and further held that—

> "While the Hygienic Chemical Company of *New York* did contribute to the defense, and one Heller, who was President of both Companies, was a witness in that case, there is no sufficient proof to connect the present respondent (the Hygienic Chemical Co. of *New Jersey*) with the defense of that case."

Thus the Circuit Court of Appeals for the Third Circuit refused to hold that the two Hygienic Companies are, for the purposes of this case, identical in interest; and refused to hold that Heller's deposition connects the *New Jersey* corporation with the test case; and refused to hold that there is sufficient proof of infringement *without* the Clotworthy deposition.

The New York Suit (No. 339).

The New York case came to trial before Judge HOLT (D. J.) and was argued before the decision of the Court of Appeals for the Third Circuit was rendered. In an opinion of a few lines (Tr. 339, p. 80) Judge HOLT followed Judge CROSS, directing dismissal of the bill.

On appeal this decision was reversed by the Court of Appeals for the Second Circuit, who ordered that a decree be entered for complainant (159 F. R., 436; Tr. 339, p. 90).

It is worthy of note that in the *New Jersey* case Judge CROSS said the weight of the testimony was that the participation in the test suit was by the *New York* corporation (p. 18, of No. 149), and that it was not certainly shown whether the sale of the infringing barrel of "Special" was by the New York concern or by the New Jersey defendant (*Id.*, p. 20); that the Court of Appeals for the *Third* Circuit also held that the *New York* defendant *did* contribute to the defense (*Id.*, p. 38); that in the *New York* suit Judge HOLT, after saying that Judge CROSS' decision in New Jersey ought to be controlling in the New York suit, and that moreover he concurred with Judge CROSS' conclusions, yet dismissed the bill as against the New York defendants (middle of p. 80 in Tr. No. 339); while the Court of Appeals for the *Second* Circuit concurred with Judge CROSS and the Court of Appeals for the Third Circuit, in holding that the *New York* corporation (and the individual defendants) had participated in the test suit (*Id.*, middle of p. 91).

In short, the Circuit Court in New Jersey, the Court of Appeals for the Third Circuit, and the Court of Appeals for the Second Circuit, all concur in holding the New York corporation privy to the former litigation; while in the Third Circuit it was held that the proofs do not connect the New Jersey concern therewith. One object of our discussion is to show that, for all the purposes of this litigation, the two Hygienic Chemical Companies are identical in interest.

II.

Assignment of Errors.

We respectfully submit that the Circuit Court of Appeals for the Third Circuit (No. 149) erred:

1. In holding that the proofs herein do not connect the Hygienic Chemical Company of *New Jersey* with the test case, for the purpose, at least, of entitling complainant to offer proof of what a witness, now deceased, testified to in that test case; particularly when the deposition of said deceased witness was given in the presence of the President of said Hygienic Company of *New Jersey*, and said deposition related to the purchase of a barrel of phosphate from that Company—a matter fully within its knowledge.

2. In not holding that the Hygienic Company of New Jersey is identical in interest, at least for the technical purpose above stated, with the Hygienic Company of New York.

3. In not holding that the proofs, independent of the Clotworthy deposition, make out a *prima facie* case of infringement, sufficient to put the defendant to its answering proofs, and in the absence of answering proofs, to entitle complainant to an interlocutory decree for injunction and reference to a master.

Further, we respectfully submit that the Court of Appeals for the Second Circuit (No. 339) has given the correct decision.

III.

Brief of Argument.

Our contentions (briefly stated) are :

1. That a *prima facie* case against both Companies, and against the individual defendants, is made out by the admissions of Mr. Heller and his superintendent, Wadman, without the aid of other proofs.

2. That infringement is established by the proofs, regardless of the Clotworthy deposition.

3. That both the Hygienic Companies were privy to the test case, and bound by the decree therein under the doctrine of *res adjudicata*.

4. That the *New Jersey* Hygienic Co. is sufficiently connected with the test case to render proof of what Clotworthy testified therein available against it in the present suit; and that, *with* the Clotworthy testimony, infringement by the New Jersey concern as well as by the other three defendants is conclusively shown.

I. Infringement Admitted.

It is to be remembered, as having a material bearing upon the sufficiency of complainant's proofs—

First. That the matters in question are peculiarly within the knowledge of defendant, and the truth regarding them could have been readily shown by defendant ; and

Second. That the Court has only to inquire whether complainant has shown enough to put the defendants to their replying proofs.

Touching the first point, the Court below in the New York case said (Tr., p. 92) :

> " In the case of *Hutter v. Stopper Co.* (128 Fed., 283) this court having under consideration a somewhat similar situation said, at page 286, 'If the complainant's witnesses were mistaken, a few words of denial would have saved years of protracted and expensive litigation. The fact that no denial was vouchsafed is

persuasive that it could not have been made truthfully.' "

We have already quoted Heller's sworn and voluntary admission in giving testimony for the defendants in the test case, his statement being—" We are manufacturers of granulated acid phosphate and are selling it to the trade in the same way as the parties who are sued in this case, the Provident Chemical Works of St. Louis " (p. 21, Q. 7).

There is no question as to which of the Hygienic twins was meant by the word " we " (even if this Court considers that it can distinguish between them), for Heller has testified herein that the New Jersey Hygienic Company *manufactures* the acid phosphate " for baking powder and other purposes " (p. 21, Qs. 3, 4) ; and that the New York twin sells the bulk of the product of the New Jersey Company, he cannot say *all*, " because it may be the Hygienic Company of New Jersey may sell some of their product direct" (p. 23, Qs. 64, 65). This statement applies to the special " granulated " phosphate (Q. 66).

Here then is a *direct admission* by Heller, president of the *New Jersey* Hygienic Company, that that Company manufactured and sold granulated acid phosphate to the trade in the same way as the manufacturer sued in the test case.

We confidently submit that this admission is sufficient to put defendant, the New Jersey Hygienic Co. to its proofs, and in the absence of proof to entitle complainant to an interlocutory decree.

Furthermore, if this Court finds (as we think it will) that the two Hygienic Companies are so related as that the participation of one of them in the test suit makes them both " parties " thereto, then under the settled rule of this Court stated in the leading case of *Cromwell vs. County of Sac*, 94 U. S., 351, and in many subsequent cases, both companies are bound by the decree in the test case under the principle of *res adjudicata*, and nothing remains open but the amount of the profits and damages which complainant is entitled to recover.

It was objected in the Court below that the opinion of the Circuit Court of Appeals in the test case (134 F. R., 385) does not expressly mention the Provident Chemical Works as a party, and that there is no direct proof herein as to the

alleged infringing acts of that Company. But this objection is destitute of merit, for Heller himself states what the Provident Company was doing (making acid phosphate and supplying it to the baking powder trade), and that his company was doing *the same thing*. Moreover Judge LACOMBE's decision in the test case, settling the final decree therein, expressly declares that the Provident Chemical Works was a contributory infringer as to the acid phosphate made by it and sold to the New York Baking Powder Co, (136 F. R., 873).

Furthermore, on September 21, 1906, six months before the New York suit was reached for argument in the Circuit Court, we served on defendants' counsel a copy of the final decree in the test case, and a copy of the said notice and a copy of said decree are printed in the transcript of No. 339, at page 87. Defendants being (as we contend) parties, through voluntary participation in the test case, are chargeable with knowledge of said decree; but in view of all the facts we submit that no technical defect of proof is chargeable against complainant.

In dealing with Heller's admissions volunteered by him in giving his testimony in the test case it should be noted that, in addition to saying "WE are manufacturers" etc. (which could only mean the New Jersey corporation, if they are to be distinguished), he also said "WE have most surely" undertaken to contribute to this defense. Mr. Heller thus identified the manufacturers of the acid phosphate with the participants in the test case. It suits his purposes now to make it appear, if he can, that the New Jersey Co. was not represented in the test case. Accordingly he says (p. 21, Q. 55, near bottom of page) that "the Hygienic Chemical Company of *New York* assisted in the burden of the defense." This is what the Court below in the Third Circuit accepted as proof that the New Jersey Hygienic Co. did not participate in the test case. *But Heller does not so state.* He merely says affirmatively that the New York corporation *did* so participate; and as to the *New Jersey* corporation, he says:

> "As near as I remember [note the convenient memory], I don't *think* they did financially, and I *don't remember* [!] whether they did otherwise." (Italics ours, Heller Q. 57, p. 22 of Transcript in No. 339.)

And he had already declared in the test case (where he appeared as the President of the *New Jersey Co.*, saying "*We* are manufacturers"), that "we have most surely" contributed to the defense of that suit, "financially and otherwise." This, we claim, is a direct admission that the New Jersey Co. participated in the defense of the test case.

The confusion (if any) sought to be raised by defendants-appellees, between the two Hygienic Companies, is like that found in another case before the Court of Appeals for the Second Circuit. In that case the bill named as defendants two individuals composing the firm of Beattie & Son, while the *prima facie* proofs showed that the machine alleged to infringe was made and sold by "Beattie's Machine Works"; defendants did not undertake, by proofs, to discriminate between the *firm* composed of the individuals named as defendants and *Beattie's Machine Works;* but in their argument they contended that infringement had not been proved against the defendants. For the reason that the defendants had not by proofs made the discrimination, when it lay in their power to do so, the Court of Appeals held that the *prima facie* showing was sufficient to connect the defendants with the infringement.

United Shirt & Collar Co. vs. Beattie, 149 F. R., 736, 742; 79 C. C. A., 442.

II. Direct Proofs of Infringement.

A very brief discussion of complainant's patent will suffice for the purposes of this case. The specification (see Tr. of No. 339, beginning at page 56) sets forth an improvement in baking preparations wherein acid phosphate is the active acid element. The improvement consists in using the phosphate in a "granular" condition, substantially free from pulverulent phosphate.

The Court of Appeals in the test suit (Judges WALLACE, TOWNSEND and COXE) held this to be a novel and highly meritorious invention, and that the patent was infringed by a granular acid phosphate containing as much as ten to twelve per cent. of pulverulent or fine phosphatic material. They also held that making such "granular"

acid phosphate, and selling it to manufacturers of baking-powders, constituted contributory infringement under well settled principles, which need not be discussed here (see Judge LACOMBE's decision in 136 F. R., 873, and the subsequent final decree in that test suit, p. 87 of Tr. 339).

1. *Proof from Conduct.*

(a) An important (and, in the absence of denial, a *conclusive*) evidence of infringement is that furnished by the conduct of the defendants in assisting actively in, and contributing financially to, the defense of the test case. Inasmuch as Mr. Heller was thoroughly conversant with the baking powder trade, and with what the Provident Chemical Works, a defendant in the test case, was doing, and had entered into an agreement with the president of that Company, Mr. Udell, to attend the taking of testimony whenever he could, for which he was paid nothing (Tr., 339, p. 34, Qs. 131–134), it must be assumed that Heller and his companies had the same interest in the case that the nominal defendants had. Certainly it would be reasonable to assume this in a case where he had an opportunity to make denial, and did not do so.

In this connection we invite the attention of the Court to Heller's amazing answer to Q. 129 (p. 34):

> "Why did you assist in the defense of the test suit against the New York Baking Powder Co. *et al?*
> "Objected to as immaterial and irrelevant.
> "A. I don't know now why I did."

We submit that this reply justifies every inference unfavorable to defendants that can be drawn from it. Nevertheless, Judge CROSS, in deciding that New Jersey case, disposed of this important item of proof by saying (Tr. 149, p. 19):

> "Such a contribution might well be made from charitable or other good and sufficient reasons."

But such a supposition cannot be entertained without disregard of the laws which govern human conduct. The conduct of the defendants, as represented by Mr. Heller, is competent and persuasive proof of infringement.

(b) But the record presents another convincing item of proof from conduct. The defendants were, at the time the test case was pending, admittedly manufacturing and selling to baking powder manufacturers a certain brand of acid-phosphate to which they gave the trade-name "Special" (the designation which appears on the invoice of the barrel sold to Clotworthy); and this "Special" phosphate was composed of particles of larger size than the ordinary phosphate (Wadman, p. 39, Q. 25; p. 30, Qs. 32, 33, Tr. No. 339). Heller testifies explicitly as to the PURPOSE for which the phosphate was put into granular form saying (p. 22, Qs. 59, 60), that "*it had to be granulated* before it could be used for *baking powder*," and that the purpose in making it granulated was to adapt it *for use in baking preparations.*

These statements, we submit, constitute direct and amply sufficient evidence of infringement to entitle complainant to an interlocutory decree.

But now comes the conclusive proof from conduct. After the decision of the test case we procured a preliminary injunction in the suit against the Hygienic Co. *et al.* of New York, enjoining defendants from infringing the Catlin patent: and thereupon *the New Jersey Co. ceased manufacturing the "Special" acid phosphate* (Wadman, p. 39, Q, 29). This, we submit, is proof of the highest value showing that the "Special" granulated acid phosphate was, and was recognized and intended by its makers to be, the granular acid phosphate for baking preparations described and claimed in the Catlin patent in suit. It is a decision by the defendants themselves that their "Special" phosphate infringed this patent.

Heller, also, testified herein to the discontinuance of the manufacture of the "Special" phosphate (p. 31, Qs. 98, 99).

2. *Defendants' "Special" accomplished the purposes of Catlin's Invention.*

Mr. Wadman, the manager of the New Jersey Hygienic Co., had been set up in the test case as a "prior inventor," and had testified in support of that defense, but without avail. When we put him on the stand in this case he gave evasive replies to most of our questions, but, in answering questions 21 *et seq.* (p. 38), he forgot his usual caution, being just at that time apparently under the influence of personal pride. Having

stated that the "Special" phosphate was his own suggestion (Q. 21), he was asked (Q. 22) what reason prompted him to put it on the market,—what advantage he expected to obtain from it,—to which he replied :

> "The reasons that I put that out are very fully expressed in the letter of mine to Mr. N. Waterbury dated about two years prior to the granting of the Catlin patent, the idea of that letter Mr. Catlin appropriated and the exact phraseology he borrowed for his specification."

As a matter of fact (Q. 25, p. 39), defendants' "Special" was not put on the market until 1898, about six years *after* the Catlin patent in suit. That Catlin was the original and first inventor was decided in the test case and is not (and cannot be) controverted here. The substance of Wadman's statements in Qs. 22 and 25 is that the purposes set forth in the Catlin patent were precisely those which induced the defendants to put their "Special" phosphate on the market six years after the grant of said patent ; or (as the wit ess puts it) "were among those [purposes] that led me to make the changes referred to" (Q. 25).

Here then is direct proof from defendants' own chemist and factory superintendent that the "Special" phosphate which they were making at the time the test suit was pending, and which they ceased from making when served with a preliminary injunction, was the same as the granular phosphate of the Catlin patent in suit, and was made and sold to accomplish *the results described in that patent.*

3. Defendants' Invoice and Receipt.

These documents (following p. 58, Transcript No. 339), and the proof connected with them, afford (as we submit) evidence sufficient to make a *prima facie* case. It has been already pointed out that the invoice specifies a "Bbl. Special Phosphate" and is on the bill-head of the Hygienic Co. of *New Jersey* although the invoice was made out *in New York City.* This, we submit, unless clearly explained away, connects *both* Hygienic Companies with this particular transaction, particularly in view of Heller's statement that the New Jersey cor-

poration does the manufacturing, and that the bulk of its products is sold by the New York corporation.

Mr. Arnold, the Treasurer and Manager of the Rumford Chemical Works, put these documents in evidence in the test case, where Heller was present and had every opportunity to examine and cross-examine witnesses. Photolithographic copies of these Exhibits are used herein, in lieu of the originals, by consent (Stip., p. 49). It was further stipulated herein, in lieu of proof (p. 45) that Mr. Arnold, if called as a witness, would testify that, in the year 1901, he received from William P. Clotworthy, since deceased, a barrel of acid phosphate, and with it the invoice or "bill," and receipt, above referred to, and that he delivered said barrel to Mr. C. A. Catlin. And in the same stipulation it is further stipulated between counsel that said Catlin, who is a competent chemical expert, etc., and one Walter N. Saunders, another chemical expert, if called as witnesses herein, would testify that they had examined samples of the contents of said barrel, and that it was granular acid phosphate suitable for use in baking powders. and contained less than five per cent. of pulverulent phosphate. Or, in a word, the stipulation embodies expert evidence (not contradicted) identifying the barrel of "Special" phosphate as containing what was adjudged in the test case to be an infringement of the Catlin patent.

4. *Defendants' failure to deny conclusive against them.*

We submit that the foregoing, *without refrence to what Clotworthy testified in the test case*, brings proof of infringement directly to defendants' door, and, in the absence of any denial or explanation, which defendants had full opportunity to make, seeing the matter is one whereof they have the best evidence in their possession, is sufficient in itself to entitle complainant to an interlocutory decree.

United Shirt & Collar Co. vs. Beattie, 149 F. R., 736, 742; 79 C. C. A., 442.

Municipal Signal Co. vs. Nat. Elec. Mfg. Co., 97 F. R., 810, 813; Affirmed 107 F. R., 284, 289; 46 C. C. A., 270.

Hutter vs. de Q. Bottle Stopper Co., 119 F. R., 190, 191; Affirmed 128 F. R., 283; 62 C. C. A., 652.

Hemolin vs. Harway Dyewood Co., 131 F. R., 483; Affirmed 138 F. R., 54; 70 C. C. A., 480; *Certiorari* denied, 199 U. S., 608.

5. *Clotworthy's testimony.*

In addition to the foregoing, Mr. Arnold was produced as a witness herein and testified (p. 47) that Mr. Clotworthy is now deceased; that said Clotworthy in his lifetime was President and Manager of the Clotworthy Chemical Co. (the purchaser of said barrel of "Special" phosphate); that Clotworthy had testified in the test case to having purchased one or more barrels of acid phosphate from the Hygienic Chemical Co. and to having sent them, together with the bill and receipt therefor to him (Arnold); that Heller was present when Clotworthy's deposition was taken; that he (Arnold) was also present; that he has examined the printed transcript of the Clotworthy deposition in said test case; and that according to his recollection such printed transcript is correct.

If this testimony be needed under the circumstances of this case in order to connect the Hygienic Chemical Co. of New Jersey, more explicitly than is done by the other proofs, with the barrel of "Special" phosphate examined by Catlin and Saunders (complainant's experts),—there is no question (we submit) but that we are entitled (in a suit against persons who were parties or privies to the suit in which the Clotworthy deposition was taken) to prove by Mr. Arnold the substance of the pertinent part of Clotworthy's testimony. But, while it is admitted by defendants' counsel, being expressly stated by Heller, that the New York Hygienic Co. participated in the said suit, it is claimed that its New Jersey twin, which manufactured the infringing article, did not so participate; and hence that we are not entitled, as against the latter, to show what Clotworthy testified in said test suit. To this we reply:

(a) The two Hygienic Companies are legally identical for the purpose in view.

(b) Heller admitted, when on the stand in the test case, that he appeared therein as representing *the New Jersey Co.*, and he has nowhere denied it in his testimony herein.

(c) What Heller did was, at that time admittedly, in the interest of the New Jersey Co.; and it is now found to have been in the interest of the New York Co. also.

(d) The relations between the two concerns, if not making them identical for all purposes, is at least such that the participation of one of them in a suit in which *both are equally interested* is enough to connect the other with such suit, making it a "privy" thereto.

Extracts from Clotworthy's Deposition.

In addition to the foregoing, we gave notice on the record (Tr., p. 49) that we would print as part of complainant's record herein "for the convenience of the court, the Clotworthy deposition referred to, or at least so much thereof as relates to the barrel of 'Special' acid phosphate referred to."

Pursuant to this notice we introduced the extracts printed on pages 55, 56, of the Transcript.

Defendants object to these extracts as not sufficiently proved and as being incomplete; and technically this objection may perhaps be valid. But the extracts are unnecessary, being introduced merely "for the convenience of the court," and for greater certainty, since Mr. Arnold's uncontradicted statement of the substance of Clotworthy's testimony is all that is required. We submit, however, that in view of *Heller's knowledge of the facts about this barrel of phosphate*, and *his knowledge of Clotworthy's testimony*, the objection should have no weight.

Furthermore, on January 9, 1907, we notified defendants' solicitors that we would refer to the entire Clotworthy deposition at the hearing of the New York case, and served them with a copy thereof (Tr., p. 89).

Finally, a copy of the entire record of the test case against *New York Baking Powder Co. et al.* (134 F. R., 385; 67 C. C. A., 367) is a part of the records of *this* Court, having been filed here in connection with the application for *certiorari* by the New York Baking Powder Co. *et al.* (Docket No. 432, October Term, 1904; *Certiorari* refused, Dec. 5, 1904). This Court may take judicial notice herein of its own records with regard to that test case; and, in like manner, the Court of Appeals for the Second Circuit was entitled, in No. 339, to take judicial notice of its own records of that test suit, had it been necessary to do so. But as we have seen, in Judge COXE's opinion it is stated that there was no necessity for doing so.

A Court of Equity may take judicial notice of its own records in a former litigation, and particularly in litigation in which the present parties were privies. In *Butler vs. Eaton*

it appeared that in the Circuit Court the defendant had interposed, as a defense, a prior adjudication in her favor rendered by the Supreme Court of the State of Massachusetts; thereupon, the Federal Court accepted that prior decision in evidence, and upon the doctrine of *res adjudicata*, decided the cause in favor of the defendant. Thereafter, on writ of error to the Supreme Court of Massachusetts, this Court reversed that earlier decision of the State Court. When the case in the Federal Court was brought up on appeal, this Court held, first, that the Circuit Court was correct in admitting in evidence the prior decision by the State Court, and, second, that upon such showing the Federal Court had decided correctly. But this Court held that they would take judicial cognizance of the fact that in the case coming from the Supreme Court of Massachusetts they had just reversed the decision of the State Court; and, taking such judicial notice of their own records in another litigation, they directed the reversal of the decision of the Federal Court at Circuit.

Butler vs. Eaton, 141 U. S., 240, 242.

The decision in *Butler vs. Eaton*, that a Court may take judicial cognizance of its own records in another suit, has been affirmed in—

Aspen Mining & Smelting Co. vs. Billings, 150 U. S., 31, 38.
Craemer vs. Washington State, 168 U. S., 124, 129.
In re Boardman, 169 U. S., 39, 44.

In a patent suit before the Court of Appeals for the First Circuit, that Court held that they would probably have been entitled to take notice of their own records in a previous patent suit, against a different defendant, although in that particular case such judicial notice was not necessary to a decision.

Bresnahan vs. Tripp Giant Leveller Co., 72 F. R., 920, 922; 19 C. C. A., 237.

Subsequently, the same Court of Appeals, and in a patent suit also, expressly held that they could refer to their own records in an earlier suit, particularly in a suit recently decided.

Cushman Paper Box Mach. Co. vs. Goddard, 95 F. R., 664, 666; 37 C. C. A., 221.

We confidently submit that all these proofs considered together make out an unusually strong *prima facie* case of infringement, clearly entitling complainant to an interlocutory decree for injunction and accounting. This is particularly urged as a proper conclusion in a case where the facts in question are all in the knowledge, and proof concerning the same is under the control of, the defendants, and the latter have offered no denial or reply.

III. The two Hygienic Companies were "parties" to the test case.

There can be no dispute that the Hygienic Co. of New York and Heller personally were "parties" to the test case according to a well settled principle which is thus stated in *Robinson on Patents*, Vol. 3, p. 566, Sec. 1176:

> "Parties include not only those whose names appear upon the record, but all others who participate in the litigation by employing counsel, or by contributing toward expenses, or who in any manner direct the course of the proceedings, as well as those who derive their rights from persons primarily interested in the suit."

In *Robbins vs. Chicago City*, 71 U. S., 657, this Court, speaking through Mr. Justice CLIFFORD (at p. 672), said:

> "Parties in that connection include all who are directly interested in the subject-matter, and who had a right to make defense, control the proceedings, examine and cross-examine witnesses, and appeal from the judgment. Persons not having those rights substantially are regarded as strangers to the cause, but all who are *directly interested in the suit and have knowledge of its pendency*, and who refuse or neglect to appear and avail themselves of those rights, are equally concluded by the proceedings" (citing *1 Greenleaf on Evidence*, 12th Ed., p. 559). (Italics ours.)

In that case there was no relation between the defendant (an individual) and the party sued in the previous case (a municipal corporation); yet the Court held it was not necessary to prove direct notice to the defendant calling upon him to appear and defend his interests in the prior suit. It was enough to show that he *had* an interest in said suit and knew of its pendency (citing *Lovejoy vs. Murray*, 3 Wall., 18).

The Court of Appeals for the Sixth Circuit in a recent case thus stated the rule:

> "The doctrine is well settled that one who, for his own interest, joins in the defense of a suit to which he is not a party of record is as much concluded by the judgment as if he had been a party thereto, provided his conduct in that respect was open and avowed, or otherwise well known to the opposite party."
>
> Penfield vs. Potts, 126 F. R., 475, 480; 61 C. C. A., 371.

It is deemed unnecessary to cite further authority on this point. A list of cases is given in our Brief in Support of Petition in No. 149, pages 12–15.

We have already quoted Heller's testimony in the test case saying "we are the manufacturers," etc., and "we have most surely" contributed to the defense financially and otherwise; also his promise to President Udell of the Provident Chemical Works that he (Heller) would attend the sessions of testimony whenever possible.

These statements, coupled with the facts that the New Jersey corporation was manufacturer of the granular acid phosphate, and that Heller appeared openly in its interest in the test case, and as its representative, constitute (we submit) clear proof of privity on the part of said New Jersey corporation.

We contend moreover that, for the purposes of determining the effect of the decree in the test case, the two Hygienic Companies cannot be legally distinguished. What Heller did in the interest of the one he *necessarily* did in the interest of the other; for not only were both corporations created and owned by himself and his partner Hirsh, but both were *jointly* carrying on the acid phosphate business, the manufacturing

being done in the name of the New Jersey Co. and the selling in the name of the New York Co. Whether Heller should charge the expenses incurred in the defense of the test case to one of these companies or to the other, or to both, is purely arbitrary, and a mere matter of book-keeping. It is a matter of absolute indifference so far as concerns third parties. The rights and remedies of the latter certainly cannot be affected thereby.

Heller appeared at a great many sessions for taking of testimony in the test case (p. 34, Q. 131). Can it possibly be held, for the sole purpose of defeating justice, that his appearances in that case, and the assistance he rendered the defendants in it, were on behalf of the New York corporation only, particularly when, in his testimony, he identified himself with the *manufacturing* concern, to wit, the Hygienic Co. *of New Jersey*, 'located at Elizabethport, New Jersey' (p. 21)? We feel confident that this Court will hold that both Companies, as well as Heller and Hirsh individually, are "parties" to the test case, at least for all purposes necessary in order to entitle complainant to an interlocutory decree in both cases.

Upon these facts, we submit that the doctrine of estoppel by judgment as to every matter adjudged in the test case applies to both corporations and to the individual defendants.

Cromwell vs. County of Sac, 94 U. S., 351.

But it has been held in some of the cases in the Circuit Courts that a person might be held to have been privy to an adjudicated case for some purposes without being *concluded* by the judgment therein. We would therefore point out that it is not here a question of enforcing the doctrine of *res adjudicata* in all its rigor against the defendants. It is only a question whether the New Jersey corporation was so connected with the test suit as to render a deposition given by a witness therein, since deceased, available against them in another case. As to this we conceive there can be no doubt.

IV. Defendants' contentions.

We have sufficiently noticed the objections of defendants directed to the alleged insufficiencies of our proofs. Counsel

for defendants make much commotion about what we have *not* proved herein, instead of meeting what we *have* proved. The latter (we submit) goes far beyond what is necessary in order to make a *prima facie* case against defendants.

Defendants' briefs below were full of statements like the following, quoted from page 29 of their Brief in Support of Petition in No. 339 :

> "In the case at bar, it is obvious on the face of the record that there was a failure by the complainant to prove anything whatsoever regarding the former litigation against the New York Baking Powder Company *et al.* It did not even appear who the parties were to that litigation, or what was involved therein, or what the outcome of it was."

But these statements are incorrect. We put Mr. Heller on the stand, and proved by his own lips that he was a party, by his own voluntary participation, to that litigation ; that the issue involved in it was the infringement of the Catlin patent ; and that he and his associates were doing the same thing as another party directly sued therein, to wit, the Provident Chemical Works. Certainly nothing more can be required in order to prove, as against Heller and his associates, matters which already lay in their knowledge as parties to the test case.

Defendants' counsel proceed to say :

> "Judge COXE, however, held that the Circuit Court of Appeals could supply these omissions by examining the records of the Court, and taking judicial notice of such essential matters as the complainant had omitted to prove."

This statement is likewise incorrect. What the Court of Appeals for the Second Circuit decided was as follows (Tr., p. 91) :

> "Whether intended to be so or not, there is no doubt that the suit against the New York Baking Powder Company was, in fact, a test case, and is controlling in this Court upon all questions there decided. *If there* WERE

any doubt as to what those questions are we *could* take judicial notice of the records of our own Court for the purpose of informing ourselves, *but there is* NO DOUBT *upon any issue now in controversy.*

"We are of the opinion that their participation in the defense of the test suit made the defendants, Heller and the New York Hygienic Company, parties privy to that suit, and that the testimony of Clotworthy given therein may properly be read against these defendants—Clotworthy having died prior to the hearing. From this testimony it appears that March 13, 1901, the Clotworthy Chemical Co. bought of the Hygienic Chemical Co. a barrel of *special* phosphate and paid for it March 25, 1901, the receipt being signed by The Hygienic Co. It is true that the billhead describes the Hygienic Co. as 'of New Jersey, Manufacturing Chemists, Offices 62 and 64 William St., New York City.' But in view of the undisputed fact that the New Jersey Co. manufactured and did not sell and the New York Company sold and did not manufacture, we think enough appeared to put the defendants upon their proof. The presumption is that the sale was made by the New York Co. The defendants say in their brief, that 'The Hygienic Chemical Company of New York is a selling company as distinguished from a manufacturing company, and sells the product of the defendant and other manufacturers'." (Italics ours.)

Thus the Court below, in No. 339, distinctly held that it was not necessary to go outside of the records of this case in order to decide every issue presented. Hence, the extent to which a court *may* consider its own records of a former suit is, in this case, a moot question; but in view of the authorities cited *supra* we conceive there can be no doubt of the propriety of a reference to the records of a former suit for information *against those who were parties or privies to that former suit.*

The unfounded statement that the Court below took judicial notice of the record of the prior suit appears again on page 13 of the same brief, and indeed is the prominent reason advanced in support of the petition for *certiorari.*

On the same page of that brief counsel say:

> "it appears that it was the New York Company which '*assisted in the burden of the defense*' (whatever that may mean), and not the New Jersey Company."

We have already pointed out that Heller's admissions in the test case directly connect the New Jersey corporation with the defense of that case; and that his testimony herein, while affirmatively asserting the connection of the New York corporation with that case, does not deny the connection of the New Jersey Company therewith.

Defendants' counsel cite many cases in support of the proposition that the Court below "erred in taking judicial notice of matters outside the record." We would note that the cases cited do not lend support to this proposition unless it be materially qualified; but it would be a sheer waste of time to discuss these authorities since the Court of Appeals for the Second Circuit has done nothing contrary to what is decided in them.

Conclusions.

1. For the purpose of this litigation all four of the defendants—the Hygienic Chemical Company of New Jersey (the manufacturing concern), and the Hygienic Chemical Company of New York (the selling concern), and the individuals Heller and Hirsh (who organized, own and continue to control the two corporations)—are identical in interest; and proof of privity or estoppel or infringement against one is proof against all.

2. The two corporations, and also the defendant Heller, both individually and as representing his corporations, participated in the defense of the test suit against the *New York Baking Powder Company et al.*, and were "privies" to that suit. Hence, the pertinent part of the testimony given in that suit by the witness Clotworthy, since deceased, may be read in evidence in these suits.

3. Even *without* the Clotworthy testimony, the *prima facie* proofs of infringement by the defendants, consisting of the admissions of Messrs. Heller and Wadman herein, also of the conduct of these defendants in defending the former suit and in discontinuing the manufacture of the "Special" after the preliminary injunction, and likewise of the "Hygienic Bill" and the "Hygienic Receipt," make out a sufficient showing of infringement by defendants to call for answering proofs; and in the absence of answering proofs constitute conclusive proof of infringement by the defendants.

4. The Clotworthy testimony (as presented by complainant's witness Arnold) is admissible in evidence against these defendants and conclusively establishes infringement.

5. The Court of Appeals for the Second Circuit did not refer to its records in the former suit in order to hold the defendants liable, but could lawfully have done so had it been necessary.

6. The decision of the U. S. Court of Appeals for the Second Circuit in No. 339 should be *affirmed* in all respects, with costs to complainant in this Court.

7. The decision of the U. S. Court of Appeals for the Third Circuit in No. 149 should be *reversed* and the cause remanded with directions that a decree be entered in the Circuit Court for the District of New Jersey in favor of complainant and against the Hygienic Chemical Company of New Jersey, with costs to complainant in all three Courts.

Dated New York City, February, 1909.

Respectfully submitted,

PHILIP MAURO,

C. A. L. MASSIE,

Of Counsel for Rumford Chemical Works.

Office Supreme Court, U.
FILED.
OCT 21 1909
JAMES H. McKENNEY
Cl.

Supreme Court of the United States.

OCTOBER TERM, 1908.

HYGIENIC CHEMICAL CO. (of New York), JAMES E. HELLER and ADOLPH HIRSH,
Petitioners,
vs.
RUMFORD CHEMICAL WORKS.

No. 121.

ON WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

BRIEF FOR RUMFORD CHEMICAL WORKS, RESPONDENT.

PHILIP MAURO,
C. A. L. MASSIE,
Of Counsel.

C. G. BURGOYNE, 72 to 78 Spring Street, New York.

Supreme Court of the United States.

OCTOBER TERM, 1908.

HYGIENIC CHEMICAL CO. (OF NEW YORK), J. E. HELLER and A. HIRSH,
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RUMFORD CHEMICAL WORKS.
No. 339.

CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

BRIEF FOR RUMFORD CHEMICAL WORKS, RESPONDENT.

Statement.

The Brief for petitioners herein is exceedingly difficult to analyze. Matters are therein discussed at great length which (as it seems to us) are quite irrelevant to the issues presented for adjudication by this Court. Other matters of relatively minor importance are brought into great prominence and paraded as the chief questions presented for review. Thus the question "what is a '*test case*' under a patent" is set forth as one upon which momentous consequences (the nature whereof is not revealed) are said to depend. The Court is warned that it would be "perilous" to declare any litigation to be a "test case" which was not made so by stipulation, &c.; and that to hold the case in which the validity of the Catlin Patent was tested to be a "test case" is likely "to produce confusion" (p. 21). The list of alleged "fundamental questions presented for review" is headed by the question—

"first, what is a *test case* under a patent, within the language employed by Judge COXE" (p. 19). In fact, an attentive reader of the brief could not fail to be impressed with the idea that the main purpose of these proceedings is to elicit from this Court an authoritative and much needed definition of a "test case."

Again, the other questions which occupy the positions of prominence in the brief for the Hygienic Companies, are (1) whether the defendants below (or any of them) were "privy" to the "test case"; (2) whether secondary evidence of matters testified by a now deceased witness (Clotworthy) in the "test case" is admissible in favor of complainant herein; (3) whether the Circuit Court of Appeals in the Second Circuit erred in taking judicial notice of its own records.

ARGUMENT.

1.

As to "Test Cases."

If there be any unique class of patent cases known or knowable as "test cases," we have no knowledge of its existence. We cannot conceive of any call for an authoritative definition of a "test case under a patent"; especially if there be no such class of cases in our judicial system. The term "test case" has been used by us and by the Court below (according to a usage by no means uncommon), as a convenient and apt designation of the case of Rumford Chemical Works against the New York Baking Powder Co., Provident Chemical Works *et al.* For the present purposes it may be taken to mean no more than a suit on a patent, in which the validity of that patent was exhaustively tried out upon a full defense, and which was carried to the Court of last resort.

We do not like to suggest that all the discussion touching "test cases" in our opponent's brief is for the purpose of clouding the true issues. That may not have been its *purpose;* but certainly is its *effect.*

2.

"Privity" and the Clotworthy Deposition.

The question of privity is important only as determining whether there is a basis herein for secondary evidence of Clotworthy's testimony, given in the test case, to the effect that he purchased the barrel of "Special" phosphate from the Hygienic Co. (of New Jersey). We have shown (as we think): *first*, that a *prima facie* case of infringement is established *without any reference at all* to the sale of the said barrel of "Special" phosphate; and, *second*, that the evidence of that sale afforded by the Hygienic invoice and receipt is, in the absence of any denial or explanation, and *without any aid from the Clotworthy deposition*, ample to establish *prima facie* that the Hygienic Co. is responsible for that sale. Further, we have shown that, if aid from the Clotworthy deposition be required, the foundation therefor has been properly laid, and the formalities duly observed. We need not extend the argument on that point.

Litchfield vs. Goodnow, 123 U. S., 549.

In support of their argument on the subject of privity, counsel seem to rely strongly upon the decision of this Court in *Litchfield vs. Goodnow*. That case, however, is readily distinguishable from the case at bar. In the Litchfield case the defendant relied upon a prior adjudication rendered in a suit between two other parties, as constituting a complete defense. But the cause of action in that case was a separate parcel of land, not involved in the prior suit. This Court said (p. 550):

> "Her lands were entirely separate and distinct from those of the actual parties. A decree in favor of or against them and their title was in no legal sense a decree in favor of or against her. She was indirectly interested in the result, but not directly."

Therefore, the Court held that the prior adjudication was not an estoppel against the plaintiff.

Likewise in the case at bar, the decree in the test case was not a decree against the Hygienic Company, and they were not

estopped to put in a valid defence herein, if they had one. But the Court in the Litchfield case did not hold either (1) that the parties to the prior suit, and Mrs. Litchfield as a privy though not a party, were not bound by the prior adjudication as to every matter that was or might have been disposed of therein, or (2) that the testimony of a since deceased witness in the first case might not be proved by secondary evidence in the second case.

3.

Judicial Notice of Court Records in Other Cases.

Much is made of the contention that Judge COXE, in writing the opinion of the Court below, erred in taking notice of the records of that Court in the "test case." What Judge COXE said was that there is no doubt that the former suit was "controlling in this Court of all questions there decided." And he added (Trans., p. 91):

> "If there *were* any doubt as to what those questions are, we *could* take judicial notice of the records of our own Court for the purpose of informing ourselves, but there is *no doubt* upon any issue now in controversy."

This surely makes the question whether or not the Court might, in case of doubt, have taken judicial notice of its own records in another case for the purpose of ascertaining what questions were therein decided, nothing more than a moot question in the present case.

But the decisions of this Court amply sustain the *dictum* of Judge COXE that the Court might, in case of doubt as to the matters decided in the former suit, refer to its own records therein for the purpose of information in respect thereto.

Likewise, in this Court, the records of said "test case" are available, having been brought here by petition for *certiorari* (No. 432, October Term, 1904). Therefore, if there be

any uncertainty as to who were parties, &c., to that suit, those records may be examined to remove such uncertainty; and the more so because the Hygienic Companies know all that said records contain, having been represented throughout the proceedings by Mr. Heller, and by their own counsel, Messrs. Briesen & Knauth.

Provident Chemical Works vs. Hygienic Chemical Co.

In this connection we beg to direct the attention of the Court to the recently reported case of *Provident Chemical Works vs. Hygienic Chemical Co.* (170 Fed. Rep., p. 523, advance sheets). This was a suit brought by the Provident Chemical Works, one of the defendants in said "test case," to enforce the provisions of a contract between that company and the Hygienic Chemical Co., which contract called for *the joint defense of the test case* brought by the Rumford Chemical Works, the two parties to the contract to share the "cost and expense of such defense." The *agreed state of facts* in that case sets forth, *inter alia*, that:

> "The Rumford Chemical Works commenced a TEST SUIT against the plaintiff and two of its customers,"

and proceeds to cite the result of that "test suit."

The decision of the Court showed that the Hygienic Co. attempted to escape payment of its share of the "cost and expense" of the "test case," but the Court (S. D. of New York) held defendant liable under the contract and gave judgment against it.

It strikes us that this reported decision in a case in which they were parties, and which arose out of the said test case, will make it rather difficult for our opponents to say in this Court that the suit in which the Catlin patent was sustained was not a "test case," or to argue that (as held by Judge CROSS) the contribution of the Hygienic Chemical Co. to the defense of that "test case" might have been prompted by charitable motives.

Des Moines Navigation & R. R. Co. vs. Iowa Homestead Co. (123 U. S., 552–554).

In connection with the Litchfield-Goodnow decision, cited by our opponents and discussed above, it is a noteworthy fact that this Court, on the same day, in deciding a suit between

two *other parties* (Des Moines N. & R. R. Co. v. Iowa Homestead Co.) felt called upon to refer to, and *did* refer to, the record in said Litchfield-Goodnow case, in order to supplement the evidence in the Des Moines case; and that, upon information thus obtained, this Court disposed of said Des Moines case, reversing the Court below. It happened that both the Litchfield case and the Des Moines case arose out of the old land grants to the Territory of Iowa, and that the decision below in the Des Moines case was based upon a finding that a certain contention had not been made in the Litchfield case. This court referred to the record in the Litchfield case to show that the finding in the later case was erroneous. The situation of the cases at bar is parallel.

Subsequently, in *United States vs. Des Moines Nav. & Ry. Co.* (142 U. S., 510), this Court discussed the history of eight prior litigations between *different parties*, in order to arrive at the proper determination of that subsequent controversy between parties who were *not privies to the earlier litigation.*

Our opponents, therefore, have called attention to a line of cases which, while not aiding them on the minor question of privity, is fatal to their whole contention. Their only defense has been, and is, that complainant below did not bring in properly certain matters relating to the test case. By these decisions it appears that we may refer to any part of that record for facts pertinent to the decision of the cases at bar.

We would refer, also, *National Co. vs. Dayton Co.* (95 F. R., pp. 991, 996), wherein Judge TAFT permitted the introduction, *after the argument*, of copies of the decree and record in another suit in *another Court.* The Court said:

> "The filing of other parts of the New York record can hardly be a prejudicial surprise to defendant, and the question of its effect, if admitted, has been fully argued upon the briefs of counsel."

Respectfully submitted,

PHILIP MAURO,

C. A. L. MASSIE,

Of Counsel for Respondent.

SUPREME COURT OF THE UNITED STATES

October Term, 1908

No. 9.

RUMFORD CHEMICAL WORKS

Petitioner

vs.

HYGIENIC CHEMICAL COMPANY

Respondent

October Term, 1908

No. 121.

HYGIENIC CHEMICAL COMPANY OF NEW YORK, JAMES E. HELLER AND ADOLPH HIRSH

Petitioners

vs.

RUMFORD CHEMICAL WORKS

Respondent

BRIEF FOR THE HYGIENIC CHEMICAL COMPANY, RESPONDENT IN CAUSE No. 149, AND FOR HYGIENIC CHEMICAL COMPANY OF NEW YORK, JAMES E. HELLER AND ADOLPH HIRSH, PETITIONERS IN CAUSE No. 929

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SUPREME COURT OF THE UNITED STATES.

RUMFORD CHEMICAL WORKS, Petitioner, vs. HYGIENIC CHEMICAL COMPANY, Respondent.	October Term, 1908. No. 149.
HYGIENIC CHEMICAL COMPANY OF NEW YORK, JAMES E. HELLER AND ADOLPH HIRSH, Petitioners, vs. RUMFORD CHEMICAL WORKS, Respondent.	October Term, 1908. No. 339.

Brief for the Hygienic Chemical Company, Respondent, in cause No. 149, and for Hygienic Chemical Company of New York, James E. Heller and Adolph Hirsh, Petitioners, in cause No. 339.

Statement.

These causes come up on writs of certiorari as follows:

In No. 149, to the United States Circuit Court of Appeals for the Third Circuit.

In No. 339, to the United States Circuit Court of Appeals for the Second Circuit.

Inasmuch as each cause presents substantially the same questions, and in anticipation of their being argued together as one case, a single brief is submitted in behalf of all the defendants. The evidence in each cause was identical, and in order to avoid a duplication of the records, a stipulation was made in cause No. 149 dispensing with the double printing (*Record*, No. 149, p. 16).

For brevity, cause No. 149, which arose in the Circuit Court of the United States for the District of New Jersey, will be referred to as the "New Jersey suit," while No. 339, which was brought in the United States Circuit Court for the Southern District of New York, will be mentioned throughout as the "New York suit."

Subject Matter.

Both suits are for infringement of Catlin letters patent No. 474,811, dated May 17, 1892 (Complainant's Exhibit—*Record*, No. 339, pp. 56-9), for alleged improvements in baking powders, the claims of which read as follows:

> "1: A baking preparation containing phosphoric acid or its compounds in granular condition essentially free from pulverulent phosphatic material, substantially as described.
>
> "2: A baking preparation composed of a phosphoric-acid element in granular form essentially free from pulverulent phosphatic material, in admixture with a carbonate or bicarbonate, as set forth."

It is not claimed, however, that any of the defendants made or sold any infringing baking powder. Contributory infringement is charged by reason of the alleged sale of "granular acid phosphate," which is one of the elements enumerated in the claims of the Catlin patent.

The undisputed evidence is that this acid phosphate was capable of being used and was used for a number of purposes besides the manufacture of baking powders, *c. g.*, candy manufacture, sugar boiling, druggists and soda water fountains (*Record*, No. 339, p. 307).

> "There is evidence," said Judge Cross in his opinion in the New Jersey suit, "that it was an article of commerce in general and common use for a number of specific purposes" (*Record*, No. 149, p. 20).

The Parties.

The complainant in both suits is Rumford Chemical Works, a Rhode Island corporation. The defendants in the New York suit are Hygienic Chemical Company of New York, a corporation of that state, and James E. Heller and Adolph Hirsch, copartners of the firm of Heller, Hirsh & Company. Joined with these defendants at the outset was the Hygienic Chemical Company of New Jersey; but the New York suit was discontinued as to the New Jersey Company, and a bill of complaint was subsequently filed by the complainant against said Company in the Circuit Court of the United States for the District of New Jersey.

The Hygienic Chemical Company of New York (which for brevity will be referred to as the "New York Hygienic Company") was organized in April, 1893, with an authorized capital stock of $3,000 (*Record*, No. 339, p. 50). The business of the New York Hygienic Company is that of selling the product of the New Jersey Hygienic Company, and also other merchandise (*Record*, No. 339, pp. 15-16). The defendants, James E. Heller and Adolph Hirsh, are two of the four partners of Heller, Hirsh & Company, a New York copartnership, whose business is that of brokers and commission merchants in fertilizing material (*Record*, No. 339, pp. 14-15).

The New Jersey Hygienic Company was organized in April, 1893, with an authorized capital stock of $150,000 (*Record*, No. 339, p. 52), and its business is wholly manufacturing (*Record*, No. 339, pp. 15-16). The product of the New Jersey Hygienic Company is sold by the New York Hygienic Company. Neither corporation has paid any dividends since its organization (*Record*, No. 339, p. 18). The amount of stock of either company, issued and outstanding at the time of trial, was not shown, nor was the holding of the stock by individual stockholders, except that it appeared that the New Jersey Hygienic Company did not hold any stock in the New York Hygienic Company, and it was testified by Mr. Heller that he and Mr. Hirsh did not own practically all the capital stock of the two Hygienic Companies (*Record*, No. 339, p. 15).

The New Jersey Suit.

Proofs having been taken simultaneously under a stipulation in both the New York and New Jersey suits, the latter was first brought on for hearing before Judge Cross, in the United States Circuit Court for the District of New Jersey. Deeming the complainant's proofs insufficient to make out a *prima facie* case, the defendant introduced no evidence; and on December 7, 1906, Judge Cross in a very full opinion, dismissed the bill of complaint with costs (*Record*, No. 149, pp. 17-21). A motion for re-hearing was filed by the complainant on December 28, 1906 (*Record*, No. 149, pp. 22-23), but a decree of dismissal was entered on that date (*Record*, No. 149, p. 32). On appeal to the Circuit Court of Appeals in the Third Circuit, this decree of dismissal was unanimously affirmed on April 29, 1907 (*Record*, No. 149, p. 39). The opinion of the Circuit Court of Appeals was written by Buffington, J., and concurred in by Judge Dallas and

Judge Gray (*Record*, 149, p. 38). The complainant then applied to this court for a writ of certiorari, which was denied in the first instance (207 U. S., 592), but upon a second application was granted (210 U. S. 435).

The New York Suit.

After the dismissal of the New Jersey suit by Judge Cross, the New York cause was brought on for argument (upon the same record as to evidence as in the New Jersey suit), before Judge Holt, who also directed the dismissal of the complaint (*Record*, No. 339, p. 80). The decree of dismissal was entered April 24, 1907, or prior to the decision of the Circuit Court of Appeals in the Third Circuit (*Record*, No. 339, pp. 80-81). On appeal to the Circuit Court of Appeals for the Second Circuit, this decree was reversed in an opinion filed by Judge Coxe and concurred in by Judges Lacombe and Noyes, and a decree of reversal was entered February 21, 1908 (*Record*, No. 339, pp. 90-92). The defendants then petitioned to this court for a writ of *certiorari*, which was granted (209 U. S., 550).

The Pleadings.

The bills of complaint and answers in both causes are substantially identical. Infringement is charged in both bills of complaint in respect of Catlin letters patent No. 474,811, dated May 17, 1892, for alleged improvements in baking powders. In the New York suit, the complaint was verified July 29, 1904 (the date of filing does not appear), and in the New Jersey cause the bill was filed October 27, 1904 (*Record*, No. 149, p. 1). In each complaint, allegations are set forth regarding a prior suit in the United States Circuit Court for the Southern District of New York, brought by Rumford Chemical Works against the New York Baking Powder Com-

pany *et al.*, on the *Catlin* patent, for alleged infringement, showing the dismissal of the bill in the first instance by Judge Lacombe on the ground of the invalidity of the patent sued on, and the subsequent reversal of the decree of dismissal by the Circuit Court of Appeals for the Second Circuit in July, 1904 (*Record*, No. 149, p. 3; No. 339, pp. 3 and 4). It is also averred that the defendants in both the New York and New Jersey suits participated in the defense of the suit against the New York Baking Powder Company "both financially and otherwise," and were at that time engaged in selling an acid phosphate like, or substantially like, the article put out by the New York Baking Powder Company (*Record*, No. 339, p. 4; No. 149, p. 4).

The answers in both the New York and New Jersey suits deny infringement, allege the invalidity of the complainant's patent, deny participation in the suit against the New York Baking Powder Company, either financially or otherwise, and deny that the defendants were engaged in manufacturing and selling granular acid phosphate like or similar to the article put out by the New York Baking Powder Company (*Record*, No. 149, pp. 6-15; *Record*, No. 339, pp. 60-69, 69-78).

The answer in the New Jersey suit also denies that at the time of the filing of the bill any final decree had ever been entered in the suit against the New York Baking Powder Company save the decree dismissing the bill of complaint (*Record*, No. 149, p. 15).

The Evidence.

The only evidence offered on behalf of the complainant in either suit was the *Catlin* patent (*Record*, No. 339, p. 56) and the depositions of James E. Heller, an officer of both the defendant corporations (*Record*, No. 339, pp. 13-35), and Walter

E. Wadman, chemist of the New Jersey Hygienic Company, who were called as witnesses for the complainant (*Record*, No. 339, pp. 35-44). These depositions were supplemented by a stipulation as to evidence which would be given by Newton D. Arnold as a witness for complainant (if called), to the effect that in 1901 he received a barrel of acid phosphate from one William P. Clotworthy, who has since died, with a paper which purported to be a bill and receipt showing payment for said barrel, which bill and receipt were offered in evidence as "Complainant's exhibit, Hygienic Company bill," and "Complainant's exhibit, Hygienic Company receipt," and that the barrel was then delivered to Charles A. Catlin, chemist of the Rumford Chemical Works; also regarding the evidence which would be given by Charles A. Catlin and Walter N. Sanders, if called (stipulation, *Record*, No. 339, pp. 45-47). The complainant then called Arnold as a witness, who testified that W. P. Clotworthy was dead; that he had been president of the Clotworthy Chemical Company; that he, Arnold, was familiar with the testimony taken in the United States Circuit Court for the Southern District of New York in the suit of Rumford Chemical Works against New York Baking Powder Company *et al.* Arnold was then shown what the complainant's counsel described as a printed transcript of the Clotworthy testimony, and answered that according to his best independent recollection the paper shown him was a correct transcript of what Clotworthy testified to in his, Arnold's, presence (*Record*, No. 339, pp. 47-9). The printed transcript shown the witness was not marked for identification or certified in any manner, and all of the evidence of the witness, Arnold, was objected to by the defendants as calling for testimony of a deceased witness in a previous action, not admissible under the rules of evidence as not being between the same parties.

The complainant's counsel did not read upon the record any portion of the evidence of the deceased witness Clotworthy, or cause it to be identified in any manner by Arnold, but gave notice that he would print as a part of the complainant's record "for the convenience of the court, the Clotworthy deposition referred to, or at least so much thereof as relates to the barrel of special acid phosphate referred to," all of which was objected to by defendant's counsel, for the reasons already stated (*Record*, No. 339, p. 49). Included in the complainant's record are certain questions and answers called "Extract from Clotworthy deposition," without any other title, purporting to have been taken in Washington, D. C., Monday, January 6, 1902, before Reeve Lewis, Esq., acting as Special Examiner by consent. The title of the cause in which this so-called Clotworthy deposition was taken, does not appear; the extracts were not certified or authenticated in any manner, and nothing appears upon the record in any way to show the authenticity of the extract printed by complainant's counsel, or its relation to the subject-matter of the litigation. The judgment roll in the suit of Rumford Chemical Works against New York Baking Powder Company *et al.*, in the United States Circuit Court for the Southern District of New York was not offered in evidence, and there was no evidence before the Court in either the New York suit or the New Jersey suit to show even the names of all the parties thereto, or the circumstances under which it was brought.

In the New York suit, notice was given by the complainant's counsel that upon the final hearing, he would ask leave to offer in evidence, *nunc pro tunc*, and read, a certified copy of the final decree entered in the suit of Rumford Chemical Works against New York Baking Powder Company *et al.*, which final decree purported to have been filed May 10,

1905, that is to say, ten months after the verification of the bill of complaint in the New York suit, and seven months subsequent to the filing of the bill in the New Jersey suit. This attempt to supplement the complainant's proofs was seasonably objected to by counsel for the defendants (*Record*, No. 339, pp. 86-8). Notice was also given by the complainant's solicitor in the New York suit, that on the argument of the case, the complainant would produce a printed copy of the entire deposition of the deceased witness, Clotworthy, from the files of the court (*Record*, No. 339, p. 89). This certified copy of the decree, and deposition of Clotworthy were no part of the original record of the case, and were not included in the original record as certified to by John A. Shields, Clerk. Upon April 2, 1908, however, a certificate was obtained from Mr. Shields, by the complainant's solicitor, certifying that the papers in question were on file in his office, but were omitted from the original transcript through accident, inadvertence or mistake (*Record*, No. 339, pp. 89-90). Upon the face of the record, however, it is evident that their inclusion in this record was irregular; that they were at no time made any portion of the evidence in support of the complainant's case; that no leave was ever obtained by the complainant to file the same in pursuance of its application, as no order to that effect has ever been entered, and they should, therefore, be disregarded by this Court. Moreover, it appears upon the face of the record, as already stated, that the final decree in the case against the New York Baking Powder Company *et al.* was not entered until months after the filing of the bill of complaint in both the New York suit and the New Jersey suit, and could not be regularly offered in evidence without the filing of a supplemental bill.

Judge Cross's Opinion.

The only exhaustive consideration of the questions arising in this litigation, appears in the opinion of Judge Cross, filed December 7, 1906 (*Record*, No. 149, pp. 17-21). In this opinion the relations of the Hygienic Chemical Companies are first considered, as follows:

> "It appears in the case that there are two corporations bearing the name Hygienic Chemical Company; that one is a New York corporation and the other, the defendant, a corporation of this State; that the New Jersey corporation is a manufacturing corporation chiefly, and the New York corporation its selling agent, although it also sells the product of other manufacturers" (*Record*, No. 149, p. 17).

Judge Cross then considers the complainant's claim that the defendant New Jersey Hygienic Company is bound by the decree entered in Rumford Chemical Works *vs.* New York Baking Powder Company *et al.*,

> "for the reason that the defendant herein contributed financially to, and otherwise aided in the defense of that suit, and that consequently it was a privy thereto and is bound thereby. It is true that Mr. Heller who is the president of and interested as a stockholder in both the Hygienic Chemical Companies, gave testimony in that suit, but how, for what purpose, in what character or under what circumstances, does not appear. There is no evidence whatever that he sought to control, had the power to control or did in any wise control that litigation; the mere fact that he was president of the Hygienic Chemical Company of New Jersey, and a witness in the suit, certainly shows no control over the suit, or any such interest as would make the corporation of which he was president, a privy thereto. As

to proof of any financial contribution by the defendant herein, to the expense of the New York litigation in which complainant's patent was sustained, I find none that is convincing. The weight of the testimony is that such contribution as was made, was made, not by the defendant but by the Hygienic Chemical Company of New York, Certainly the defendant herein cannot be concluded as a privy to that suit without satisfactory evidence appears of such facts as the law deems necessary to establish privity. For the purpose obviously of showing that the contribution to the defense of the primary suit, alleged to have been made by the New York corporation, was to all intents and purposes made by the defendant herein, evidence was adduced intended to show that the defendant and the Hygienic Chemical Company of New York, were one and the same corporation, and were practically controlled by the witness Heller, already referred to, and a Mr. Hirsh. It appears that these two men were largely instrumental in the organization of both corporations, and at that time controlled substantially all of the stock thereof, and this situation might have been presumed to continue, had not Heller, while under examination as a witness for the complainant testified that it was not a fact that he and Hirsh at the time of the examination owned practically all of the stock of the two corporations. Later, in reply to a question asking what proportion of the capital shares of the Hygienic Chemical Company the witness and Mr. Hirsh owned, the witness replied that he could not answer without examination, thereupon complainant's counsel requested the information for a later session, and the defendant's counsel expressed a willingness to produce the facts at a subsequent hearing. The matter however seems to have been dropped, as nothing further in that connection appears in the case. As already stated, the testimony shows that the New York cor-

> poration was the selling agent for the New Jersey corporation, but it also shows that the latter corporation does not own or control a single share of the stock of the former. The fact that the witness Heller is president of both corporations has already been adverted to. These are all the facts tending to show that the corporations are identical. At the time of their organization they seem to have been controlled by two men, but the situation was subsequently changed, as appears from the testimony of Heller above given, but to what extent or when is not made clear, through the failure of the complainant to prosecute the examination of the witness to a definite result. I think the testimony insufficient to show the oneness of the two corporations. There is no evidence of any agreement between the defendant herein and the defendants in the New York litigation (which established complainant's patent) as to the joint defense of the suit; nor does it appear that this defendant, or indeed the New York corporation, had the right to control the proceedings, assume any active part therein, cross-examine the witnesses or appeal from the judgment. I have found no case which goes to the length of saying that one who merely contributes to the defense of a suit is bound as a privy by the result thereof. * * * I am compelled to conclude that the defendant herein was not a privy to the litigation in the Southern District of New York, and was consequently not concluded thereby" (*Record*, No. 149, pp. 17-19).

Judge Cross then proceeds to consider the evidence of infringement in the following language:

> "Nor do I find any evidence of infringement of the complainant's patent by the defendant. The only evidence offered upon that point worthy of review, was the introduction under objection of the evidence of a deceased witness, one Clotworthy, who was

examined in Rumford Chemical Works *vs.* New York Baking Powder Company, *supra.* Assuming that the issues in the two causes are substantially the same, although the record was not offered and there is no evidence that they are, still the evidence would only be admissible in a subsequent suit between the same parties or their privies, a situation which we have found does not exist, but waiving that and assuming that my conclusion in that respect is unwarranted, the testimony was not admissible in the ferm in which it was offered. The witness produced to prove the testimony of the deceased witness, did not attempt to give all of his testimony or all of his testimony upon any given point. He testified that the printed record in the New York case which he had read or examined was a correct transcript of what the deceased witness testified to in his presence, whereupon counsel for the complainant, without offering the record, if indeed, it were admissible, or having the witness testify to its contents at length, gave notice that he could print as a part of the complainant's record herein, the deposition referred to, or at least so much thereof as related to the point at issue; and in the record herein two or three pages of the testimony of the deceased witness taken from the printed record, appear. I think the introduction of the testimony into the record in this manner was improper, and as objection was made thereto it shoud be stricken out. The witness should himself have testified into the record what the deceased witness swore to, or the substance thereof, and it should not have been left to counsel to pick out and introduce such portions only as he might deem relevant or important to his case. It is for the Court to say whether the testimony or any part of it was relevant. Counsel has evidently incorporated in this record, as appears by the number of questions and cross questions, only fragmentary and disjoined selections from the testimony of the deceased witness" (*Record,* No. 149, p. 20).

Judge Cross then holds that a *prima facie* case has not been made, that infringement must be proved, and that the sale of a barrel of acid phosphate even if in fact purchased by the deceased witness Clotworthy in 1901 from the defendant, could not be held to be an infringement of a patent for a baking powder, unless it affirmatively appeared that the sale was made for the purpose of having the acid phosphate used as an element in an infringing substance.

> "Assuming that the article in question was sold by the defendant to Clotworthy or others, there is no evidence showing for what purpose it was sold or used, or that it was only useful when combined in the manner provided in the patent in suit, on the contrary, there is evidence that it was an article of commerce in general and common use for a number of specific purposes; it is true it could be combined and used as claimed in the patent, but it could likewise be used and was sold and used for a variety of other purposes, and I find no evidence in the case to show that there was any agreement, knowledge or understanding that any acid phosphate sold by the defendant was to be combined with other articles to infringe the complainant's patent. The complainant made Heller his own witness and his testimony corroborated by Wadman to some extent as to the number of uses for which acid phosphate is manufactured, adapted and sold is uncontradicted" (*Record*, No. 149, pp. 20-21).

The Decision of the Circuit Court of Appeals for the Third Circuit.

On appeal from Judge Cross's decision, the Circuit Court of Appeals in the Third Circuit unani-

nously affirmed the decree of dismissal, and dis-cussed the issues briefly as follows:

> "The court below held that there was no proof of infringement, and there was no error in its so holding if the testimony of one Clotworthy was rightfully excluded. This excluded deposition of Clotworthy, now deceased, was taken in a suit in the Circuit Court for the Southern District of New York (125 Fed. Rep., 231, and 134 Fed. Rep., 385), wherein the Rumford Chemical Works, the present appellant, was complainant, and the New York Baking Powder Company *et al.*, respondents. It is alleged the respondent in the present case aided in, and contributed to, the defense of that cause. At that point, however, proofs fail. There is no proof that the present respondent, the Hygienic Chemical Company of New Jersey, contributed to the expense of the New York suit or bore the relation of privy or party to that litigation. While the Hygienic Chemical Company of New York did contribute to the defense, and one Heller, who was president of both companies, was a witness in that case, there is no sufficient proof to connect the present respondent with the defense of that case. We are therefore of opinion that the court rightfully excluded Clotworthy's testimony" (*Record*, No. 149, p. 38).

Judge Holt's Decision.

In dismissing the bill of complaint, Judge Holt wrote the following memorandum:

> "The decision of Judge Cross in the New Jersey suit, although not technically *res adjudicata*, ought in my opinion to be held to be controlling by this court. Moreover, I concur with the conclusions of Judge Cross on the merits. The bill is dismissed, with costs" (*Record*, No. 339, p. 80).

The Decision of the Circuit Court of Appeals for the Second Circuit.

The opinion of the Circuit Court of Appeals for the Second Circuit was written by Judge Coxe, who had also been a member of that Court at the time of the decision of Rumford Chemical Works *vs.* New York Baking Powder Company *et al.* (134 Fed. Rep., 385), and the opinion of Judge Coxe discusses the litigation between the Rumford Chemical Works and the New York Hygienic Company, *et al.*, in the light of the knowledge he obtained of the prior suit, thus:

"Whether intended to be so or not," says Judge Coxe,

> "there is no doubt that the suit against the New York Baking Powder Company was, in fact, a test case, and is controlling in this court upon all questions there decided. If there were any doubt as to what those questions are, we could take judicial notice of the records of our own court for the purpose of informing ourselves, but there is no doubt upon any issue now in controversy."

Having thus assumed that the prior suit against the New York Baking Powder Company was what he calls "a test case," Judge Coxe goes on to say:

> "We are of the opinion that their participation in the defense of the test suit made the defendants, Heller and the New York Hygienic Company, parties privy to that suit, and that the testimony of Clotworthy given therein may properly be read against these defendants—Clotworthy having died prior to the hearing."

Judge Coxe then goes on to consider the Clotworthy evidence and the grounds upon which the *Catlin* patent was upheld, although no evidence as to those grounds was introduced in the case. Dis-

regarding the evidence that the special phosphate made by the New Jersey Hygienic Company and sold by the New York Hygienic Company was adapted to several uses, and that there was no evidence in the case that the particular barrel of special phosphate sold to Clotworthy was sold by the New York Hygienic Company with any intention that it should be used in an infringing baking powder, Judge Coxe concluded that a *prima facie* case of contributory infringement had been established, and without any evidence whatever that the defendant Heller had ever sold or dealt in any special phosphate, the decree of the Circuit Court was reversed with costs as against the defendants Heller and the Hygienic Chemical Company of New York, and the cause remanded to the Circuit Court, with instructions to enter a decree against those defendants for an injunction and an accounting with costs (*Record*, No. 339, pp. 91-2).

The Defendants' Application for a Writ of Certiorari.

As there appeared to be a sharp conflict between the decisions of the Circuit Courts of Appeal in the Second and Third Circuits respectively, the defendants in the New York suit applied to this court for a writ of *certiorari*. In the petition for the writ it was urged that the cause should be reviewed by this court, in order

> (1.) To define the matters necessary to be proved in a patent cause to establish such relation of privity between a defendant in a later cause and a defendant in an earlier cause upon the same patent, as to make the decision in the earlier case binding upon a defendant in the later cause;
>
> (2.) To determine the legal effect of the alleged participation by the defendant Heller

in the prior suit against the New York Baking Powder Company *et al.;*

(3) To correct the error of the Court below in taking judicial notice of matters in litigation in an earlier action not offered in evidence, and in holding that the complainant was entitled to read and to have considered the so-called extracts from the Clotworthy deposition, which were printed by the complainant's solicitors as a part of the record, without, however, having the same authenticated or certified in any way;

(4.) To correct the error of the Court below in holding that there was any evidence whatever of any contributory infringement by any of the defendants;

(5.) To correct the error of said Court in not holding that the decree of Judge Holt, dismissing the bill, should have been affirmed for failure of proof on the part of the complainant.

The defendants' application for a writ of *certiorari* was granted upon this petition (209 U. S., 550).

The Complainant's Applications for a Writ of Certiorari.

After the affirmance by the Circuit Court of Appeals in the Third Circuit, of the decree dismissing the bill in the New Jersey suit, the complainant applied to this court for a writ of *certiorari*, which application was denied on October 28, 1907 (207 U. S., 592). Thereafter, the mandate of the Circuit Court of Appeals for the Third Circuit, issued to the Circuit Court of the United States for the District of New Jersey; the dismissal of the bill was thereupon affirmed and the litigation finally terminated. On June 1st, 1908, and after the issue of the mandate of the Circuit Court of Appeals in the Third Circuit, this court, on complainant's application, and notwithstanding the defendants' op-

position and answer that the suit had been finally terminated, set aside the former order and granted a writ of *certiorari* (210 U. S., 435). On behalf of the defendant in the New Jersey suit, it is, however, respectfully contended that the second application was too late, as the complaint had been finally dismissed and the mandate of the Circuit Court of Appeals in the Third Circuit had been duly issued and filed in the Circuit Court of the United States for the District of New Jersey.

The Questions Presented for Review.

The fundamental questions presented for review thus relate to the law of evidence and procedure in patent causes. This Court is asked to determine—first, what is a "test case" under a patent, within the language employed by Judge Coxe, *supra;* second, what degree of participation in the prosecution or defense of a suit on letters patent will make a stranger to the record privy thereto in such manner as to be bound by the judgment; third, whether there is anything in the nature of a suit upon letters patent, which relieves a complainant from the burden of establishing a *prima facie* case in the same manner as in other equity causes; fourth, whether there is anything in the nature of a claim for infringement of letters patent which will permit a complainant to disregard the usual rules of procedure and evidence, and rely upon the principle that the Court may take judicial notice of its records in other causes relating to the patent, against defendants other than those before the Court, to supplement the complainant's otherwise defective proofs; fifth, whether the Court, in patent causes, should permit the admission in evidence of unauthenticated records or printed transcripts of the depositions of witnesses in other causes, or the introduction of certified copies of decrees entered long

after the inception of the suit, and not referred to in the bill of complaint; sixth, whether the outcome of a suit on letters patent can be regularly proved save by the introduction of the judgment roll or a certified copy thereof in the manner in which other judicial records are proved.

Judge Coxe, having been a member of the Appellate Court which reviewed the decision of Judge Lacombe in the case against the New York Baking Powder Company *et al.*, plainly asserted the right of the Court to take judicial notice of the record in the New York suit, and based the decision of the Circuit Court of Appeals thereon.

On the part of the defendants it is urged that the rules of evidence in patent causes are and should be the same as in all other legal proceedings; that a court of equity should not take judicial notice of matters litigated in a former suit against other defendants, even where the subject-matter of the suit is a patent for an invention; that a court of equity should not permit the irregular admission of unauthenticated records or even certified copies of decrees entered long after the filing of the bill of complaint, unless their admission is prepared for by the filing of a supplemental bill; and in order that these and other important questions may be authoritatively settled by this Court, the defendants have brought the record in the New York suit here for review.

The following brief discusses the questions arising in both causes.

I.

No evidence was introduced to show that the prior suit on the Catlin patent was what is termed a "test case."

The bills of complaint in each case merely allege that a prior suit was brought by the complainant

against the New York Baking Powder Company *et al.* for infringement of the *Catlin* patent, and that the bill was dismissed in the first instance by Judge Lacombe, whose decision was thereafter reversed by the Circuit Court of Appeals for the Second Circuit. Neither bill of complaint alleges that this suit was tried as a test case, or that other suits were brought upon the Catlin patent, whose outcome depended upon the decision of the New York Baking Powder Company case. In the courts below, the complainant's counsel attempted to supplement the complainant's record by statements regarding other infringements of the Catlin patent, and the pendency of other suits. Any such statements, however, are entirely without foundation, so far as the record in these cases is concerned, and should therefore be disregarded. It would be quite as fair for the defendants to assert that the prior case of *Rumford Chemical Works* vs. *Egg Baking Powder Company*, 145 Fed. Rep., 953, was a test case, and that the bill having been there dismissed for failure of proof, a similar procedure should be followed in this case.

This Court has not hitherto defined what is to be regarded as a test case upon a patent, but it would be perilous to declare any litigation to be a test case which has not been made so by a stipulation or by some agreement between the parties so declaring. The statement of Judge Coxe, therefore, that whether intended to be so or not, the suit against the New York Baking Powder Company *et al.* was a test case, is likely to produce confusion unless this Court so restricts the definition of a test case as to make it depend upon the actual stipulation, intention or agreement of the parties.

II.

Privity was not shown between any of the defendants in either suit and the defendants in the prior suit against New York Baking Powder et al.

No evidence was regularly introduced by the complainant in either the New York or the New Jersey suit regarding the prior litigation on the Catlin patent against New York Baking Powder *et al.* Not even the names of all the defendants to that suit were shown, nor what relation they bore to each other. Neither the record nor the judgment roll was introduced in evidence.

Judge Cross, in the New Jersey suit, called attention to the complainant's failure to prove these matters. After declaring that the New Jersey Hygienic Company was not a privy to the prior litigation in New York, Judge Cross proceeds:

> "Assuming that the issues in the two cases are substantially the same, although the record was not offered and there is no evidence that they are, still the evidence (*i. e.*, the Clotworthy deposition) would only be admissible in a subsequent suit between the same parties or their privies, a situation which we have found does not exist" (*Record,* No. 149, p. 20).

The Court of Appeals for the Third Circuit affirmed Judge Cross' decision that no privity was shown as to the New Jersey Hygienic Company (*Record,* No. 149, p. 38).

In the New York suit, Judge Holt also held that there was no privity as to the New York defendants (*Record,* No. 339, p. 80).

The Court of Appeals for the Second Circuit, however, reached a different conclusion. Judge

Coxe, in his opinion, stated that "whether intended to be so or not," the prior suit on the Catlin patent was a "test case," and that the Court could if there was any doubt as to the questions there decided take judicial notice of its own records (*Record*, No. 339, p. 91).

It is, of course, elementary that privity must be affirmatively shown:

"It is for those who assert this privity," said Mr. Justice Grier in Stacy *v.* Thrasher, 6 How., 44, "to show wherein it lies."

And it is also well settled that a judgment *in personam* binds only parties and privies.

Johnson v. *Powers*, 139 U. S., 156.

In the cases at bar, the defendants were certainly not parties to the prior suit on the Catlin patent, and the only evidence connecting any of them with that prior suit was the statement of Heller, referred to by Judge Coxe, that he was interested in the defense "financially and otherwise." There is no evidence that any of these defendants had any direction or control over, or any active participation in, that prior litigation.

The question of what constitutes privity was very fully considered by this Court in the case of

Litchfield vs. *Goodnow's Administrator*, 123 U. S., 549.

This was a suit brought by Goodnow as assignee of the Iowa Homestead Company against Grace H. Litchfield, to recover the amount of taxes for the years from 1864 to 1871 both inclusive, paid by the Homestead Company on certain tracts of land owned by the defendant Litchfield. As defenses to the action, the prior adjudication in *Homestead Company* vs. *Valley Railroad*, 17 Wallace, 153, was pleaded, and also the statute of limitations based on the decision as to title in *Wolcott* vs. *Des Moines Company*, 5 *Wallace*, 681. Both of these defenses

were overruled by the Supreme Court of the State of Iowa, and judgment was entered in that Court for the amount of the taxes paid and interest.

In affirming the decision of the Supreme Court of Iowa, this Court held, Chief Justice Waite writing the opinion, that the defense of prior adjudication was disposed of—

> "by the fact that Mrs. Litchfield was not a party to the suit in which the adjudication relied on was had. At the time of the commencement of the suit she was the owner of her lands, and they were described in the bill, but neither she nor any one who represented her was named as a defendant. She interested herself in securing a favorable decision of the questions involved as far as they were applicable to her own interests, and paid part of the expenses; but there was nothing to bind her by the decision. If it had been adverse to her interest, no decree could have been entered against her personally either for the lands or the taxes. Her lands were entirely separate and distinct from those of the actual parties. A decree in favor of or against them and their title was in no legal sense a decree in favor of or against her. She was indirectly interested in the result, but not directly."

And after quoting with approval the discussion contained in *1 Greenleaf, 528*, he then proceeds:

> "In the condition of parties to the record during the whole course of the litigation between the Homestead Company and those who were named as defendants, Mrs. Litchfield had no right to make a defence in her own name, neither could she control the proceedings, nor appeal from the decree. She could not in her own right adduce testimony or cross-examine witnesses. Neither was she identified in interest with any one who was a party. She owned her lands; the parties to the suit owned theirs; her rights were all separate and distinct from the rest, and

> there was no mutual or successive relationship between her and the other owners. She was neither a party to the suit, nor in privity with those who were parties; consequently she was in law a stranger to the proceedings and in no way bound thereby."

Applying the doctrine of this decision to the case at bar, it is obvious that none of these defendants was privy to the prior litigation on the *Catlin* patent. The utmost that can be said in support of the claim of privity is that the witness Heller testified that the New York Hygienic Company had contributed to the defense of the prior suit "financially and otherwise." It did not appear, however, that any of the defendants had any control of the proceedings or was represented by counsel. None of these defendants had any right to adduce testimony or cross-examine witnesses. The rights of these defendants were all separate and distinct from the defendants in the suit against the New York Baking Powder Company *et al.*, and therefore, if the rules laid down in *Litchfield* vs. *Goodnow*, *supra*, are not to be changed radically as regards cases arising upon letters patent, the conclusion is irresistible that no privity was shown.

It is true that there are a number of decisions in the Circuit Courts and Circuit Courts of Appeal, in which this matter of privity is discussed in somewhat different terms, as it arises in the course of litigation upon letters patent. One of the leading cases is

Theller v. *Hershey*, 89 Fed. R[illegible], 575.

where the rule is stated as follows:

> "The law is well settled that parties and privies include all who are directly interested in the subject-matter, and who had the right to make defense, control the proceedings, examine and cross-examine witnesses, and appeal from the judgment."

Other decisions in which the subject of estoppel in patent causes is discussed, are the following:

United States and Foreign Salamander Felting Co. vs. *Asbestos Felting Co.*, 4 Fed. Rep. 816.

Miller vs. *Tobacco Co.*, 7 Fed. Rep., 91.

American Bell Telephone Co. vs. *National Improved Telephone Co.*, 27 Fed. Rep., 663.

Eagle Manufacturing Co. vs. *David Bradley Mfg. Co.*, 50 Fed. Rep., 193; 57 Fed. Rep., 980.

National Folding Box and Paper Co. vs. *Dayton Paper Novelty Paper Co.*, 95 Fed. Rep., 991.

Lane vs. *Wells*, 99 Fed. Rep., 286.

An examination of each of these cases will show that the test of privity lies in the fact, first, of the existence of a test case, and, second, of the contribution to its prosecution or defense in pursuance of an agreement to that effect.

No case has been cited by the learned counsel for the complainant, which goes to the length of holding that a mere contributor to the defense of a suit upon a patent, in the absence of clear proof that such action was a test case, and that a stranger to the record therein made a contribution to the defense in pursuance of an agreement and assumed control of the litigation, is bound by the decree therein. In

Miller vs. *Tobacco Company* (*supra*),

the Court said:

> "A person to be concluded by a judgment must be privy to the proceeding in such a sense that he may control the litigation in so

> far as making motions in the case, offering evidence, cross-examining witnesses, or taking an appeal is concerned; that is, it is not reasonable to say that a man shall be bound by an adjudication, unless he has all the rights of a litigant with respect to the adjudication."

It will be apparent from an examination of the foregoing cases, that they are each clearly distinguishable from the cases at bar. In all of them the defendant either controlled the earlier litigation, or else suit had been brought against his agent, or else the alleged infringing article was the very same article which had been the subject of the previous litigation. In none of them was it held that a person or corporation which merely assisted in the defense of an earlier case, not controlling the defense or having any direct interest in the outcome of the suit, and deemed merely a manufacturer of an article called by the same name as an ingredient of the alleged infringing article, is bound by the previous judgment on the patent. There is no evidence, in the cases at bar, of any agreement between these defendants and the defendants in the earlier case, with respect to the control of the case or an agreement to contribute to the expense of the litigation. All that appears is that the New York Hygienic Company was interested in the defense financially and otherwise, but it does not appear that any of these defendants was represented by counsel in that case or had any right to cross-examine witnesses or take any part in the actual conduct of the defense.

No adjudications have been found in this court bearing on this question of privity in patent causes. Within the doctrine, however, of

Litchfield vs. *Goodnow*, 123 U. S., 549, it is clear that the decree in the suit against the New York Baking Powder Company does not bind these de-

fendants, because, in the language of that opinion, they had "no right to make a defense in their own "name, neither could they control the proceedings "nor appeal from the decree. They could not in "their own right adduce testimony or cross-examine "witnesses, neither were they identified in interest "with any one who was a party."

III.

The Circuit Court of Appeals for the Second Circuit erred in taking judicial notice of matters outside of the record, and as its reversal was based on such matters such reversal is erroneous.

Judge Coxe, in the New York case, took judicial notice of the earlier case between Rumford Chemical Works and the New York Baking Powder Company *et al.*, in which he had written the opinion of the Circuit Court of Appeals for the Second Circuit. It is well settled, however, that while courts will take notice of their own orders or prior proceedings *in the same case*, they will not take notice of the pendency of another action in the same or another court, nor will they take notice of a former judgment or a decree between the same or other parties in the same or in another court, unless the same be properly offered in evidence.

Stanley vs. *McElrath*, 86 Cal., 449.
Downing vs. *Howlett*, 6 Colo. App. 291, 40 Pac., 505.
Adler vs. *Lang*, 26 Mo. App. 226.
Grace vs. *Ballou*, 4 S. D., 333.
In re Manderson, 51 Fed. Rep., 501.

Streeter vs. *Streeter*, 43 Ill., 155.
Taylor vs. *Adams*, 115 Ill., 570.
Loomis vs. *Griffin*, 78 Ia., 482.
Granger vs. *Griffin*, 78 Ia., 759.
Banks vs. *Burnam*, 61 Mo., 76.
Spurlock vs. *Mo. Pac. Rway.*, 76 Mo., 67.
Daniel vs. *Bellamy*, 91 N. C., 78.
People vs. *De La Guerra*, 24 Cal., 73.
State vs. *Edwards*, 19 Mo., 674.
Baker vs. *Mygatt*, 14 Ia., 131.
Allison vs. *Fid. Mutual Fire Ins. Co.*, 104 N. W., 753.
In re Osborne, 115 Fed., 1.
Bank of Montreal vs. *Taylor*, 86 Ill. App., 388.
Ralphs vs. *Hensler*, 97 Cal., 296.
McCormick vs. *Herndon*, 67 Wis., 648.
Enix vs. *Miller*, 54 Ia., 551.
Eyster vs. *Gaff*, 91 U. S., 521.
State vs. *Wilson*, 39 Mo. App., 114.
In Wharton on Evidence, Vol. I, Sec. 326.
Lake Merced Water Co. v. *Cowles*, 31 Cal., 215, and many others.

These cases merely apply the well-known rule of evidence laid down in

Wharton on Evidence, Vol. I, Sec. 326, where the learned author says:

"While a court takes notice of its own records, it cannot travel for this purpose out of the records relating to the particular case. Thus, in one case the Court cannot take notice of the proceedings in another case, unless such proceedings are put in evidence."

1 Jones on Evidence, Sec. 124 (1896), where the learned author says:

> "The Court in which a cause is pending will take judicial notice of *all its own records* in such cause and of the proceedings in the Court relating thereto. * * * But in a given case the Court is not held to have judicial knowledge of the pendency of *proceedings in other causes* in the same Court, much less of those in other courts, for example that there has been a former adjudication; nor does the Court take notice of the contents of a record in another action then pending; nor that the pending case has connection with another formerly decided by the Court; nor that in another action there has been a conviction or an acquittal; nor that another action is pending involving similar questions."

A glance at the authorities above cited will show how universal this rule of evidence is, for these cases are taken from the reports of the courts of a large number of the States of the United States. In reaching the conclusion that the decree of the Circuit Court in the New York case should be reversed, as appears from the opinion of Judge Coxe, the learned Judge declared that the case theretofore pending in the Circuit Court of the United States for the Southern District of New York, between the Rumford Chemical Works, complainant, and the New York Baking Powder Company and others, defendants, was a test case, and discussed the matter as follows:

> "The defendants charged with infringement are Hygienic Chemical Company of New York, James E. Heller and Adolph Hirsh, the first two defendants contributing to the defense in the so-called test case against the New York Baking Powder Company in which the validity of the Catlin patent was upheld by this Court. In that case Heller testified that he was interested in the

> defense financially and otherwise and that the Hygenic Chemical Company located at Elizabethport, New Jersey, manufactured acid phosphate for baking powder and other purposes. He testified further as follows: 'We are manufacturers of granulated acid phosphate, and are selling it to the trade in the same way as the parties who are sued in this case, the Provident Chemical Works of St. Louis.' Heller was sworn in the case at bar, and says his answers in the former case were true."

(*a.*) As to the rule that judicial notice will not be taken by a court of matters previously pending in the same Court in the absence of proper proof, see

McCormick vs. *Herndon,* 67 Wis., 648.

This was an action of ejectment, and the Court said:

> "It is claimed that the questions of title and possession here involved had been adjudicated by the same Court in a former action in ejectment, in which this plaintiff recovered from this defendant the possession of another piece of land of twenty acres as to which the title was the same as to the land in question except as to the tax deed. But as no such former adjudication was either pleaded or proved, we do not regard the question before us for consideration. It is said that records of the Court in such other case were present and that the Court took judicial notice of them; and besides that the facts shown by such records stood admitted. We fail to find in the record any such admission or that the Court took such judicial notice; besides, we are not aware of any rule of law authorizing such judicial notice. If plaintiff relied upon such former adjudication she should at least have proved it as a fact in the case."
>
> *Downing* vs. *Howlett,* 6 Colo. App., 291.

Here the Court said:

> "There is some suggestion in the record that the trial Court was referred to a case in the Supreme Court of the State which would throw some light on the controversy and tend to show Howlett had been guilty of the acts complained of. While the decisions of that Court are matters of which all tribunals in the State take notice, we do not understand that there is any rule of evidence or any rule of practice which would make the record in any other suit evidence in a cause without its production and offer. Nor do we understand how the record in any other suit can be resorted to by any Court for the purposes of proof or the ascertainment of facts essential to charge defendant with a liability, unless in some one of the ways known to the law the record is produced and legitimately brought to the Court's attention."

Spurlock vs. *Missouri Pacific Ry.*, 76 Mo., 67 (1882).

Here the trial Court decided for the defendant on the ground that that case had been decided in favor of defendant in a former suit between same parties. That judgment did not, however, appear in the record. The Court said:

> "It may be that the former judgment is a "bar to recovery in the present action, but a "plea of *res adjudicata* should be supported "by proof that the matters in issue and de- "cided in the first suit are the same as that "presented for determination in the second, "as neither the Circuit Court nor this Court "can take judicial notice of such matters."

(*b*) As to the rule that judicial notice will not be taken by a judge in a case *pending be-*

fore him of matters in an earlier case, previously pending before him, see

State vs. *Edwards*, 19 Mo., 674 (1854).

where the Court said:

> "Defendant's counsel * * * contends in this Court, that the Court below ought to have admitted these persons as witnesses because the fact of the conviction of one and a *nolle prosequi* as to the other were known to the Court before which the trial was going on; the Judge thereof having been the same Judge before whom, as a court in another county, these proceedings were had. To state this proposition is enough to make the absurdity thereof apparent."

Ralphs vs. *Hensler*, 97 Cal., 296 (304).

> "Appellant further contends that the evidence does not justify the findings that Hardy died before the commencement of this action, that his will was admitted to probate, that letters testamentary were issued to plaintiff or that plaintiff ever qualified to act as executor." There is no evidence of these facts; nor is it claimed by counsel for respondent that there is. "But it is claimed that the Court took judicial notice of them, inasmuch as the probate proceedings in the matter of the estate of Hardy were in the same Court. In the first place, there is no evidence of any such proceedings in any court; and in the second place, it is too clear to admit of question that the judicial knowledge of the Court does not extend to the contents of its records in former actions or proceedings."

Baker vs. *Mygatt*, 14 Iowa, 131.

In this case the plaintiff sought to have an affidavit admitted in evidence, and insisted that the

Court ought to take judicial notice of it, because it had been used in a previous case. The Court said:

> "The Court could not take judicial notice of the fact that the affidavit had been admitted in another case, nor could it be properly admitted on the ground that the Judge of the Court recollected that it was on that case and stated that it would be evidence against Mygatt in this case."

Lake Merced Water Co. vs. *Cowles*, 31 Cal., 216.

In this case the Judge of the lower Court refused to appoint commissioners to condemn land, on the ground that there was another petition pending before him for the condemnation of the same land at the suit of another water company. The Court said:

> "The pendency of the Clear Lake petition seems to have become known to the County Judge incidentally. No allusion was made to it in the petition filed by the Lake Merced Company, nor was its pendency proved at the hearing, and we apprehend that the Court could not under any circumstances take judicial notice of the fact, except it were for mere calendar purposes."

As will be seen from the report of the decision in the case of *Rumford Chemical Works* vs. *New York Baking Powder et al.*, 134 Fed. Rep., 385, the opinion was written by Judge Coxe, and was concurred in by Judges Wallace and Townsend.

In the cases at bar, there was a failure by the complainant to prove anything whatsoever regarding the former litigation against the New York Baking Powder Company *et al.* It did not even appear who the parties were to that litigation, or what was involved therein, or what the outcome of it was. Judge Coxe, however, held that the Circuit Court of Appeals could supply these omissions

by examining the records of the Court, and taking judicial notice of such essential matters as the complainant had omitted to prove. On behalf of the petitioners, it is urged that this was error, in view of the decisions cited above, and error of such a nature that this Court should reverse the decision of the Circuit Court of Appeals. If, in a cause between private suitors, the complainant's failure to prove a cause of action can be cured by permitting the Court to take judicial notice of the records in another suit between private suitors, it would obviously be quite impossible for a defendant to know in advance what matters will be considered by the Court in rendering a decision, and such loose procedure will inevitably lead to endless confusion.

IV.

The complainant failed to make out a prima facie case in both the New York and New Jersey cases.

It will appear from a most cursory examination of the pleadings, and from the evidence, that most of the substantial allegations of the bills of complaint which are denied by the answer, are entirely unsupported by proof.

Thus, the complaint failed to show a single sale by the defendants of any baking preparation or powder whatever, at any time or in any place. Even the transaction described in the Clotworthy deposition, and which will be adverted to more fully hereafter, was a purchase made in Baltimore in 1901, of a barrel of phosphate (not a baking powder). It is not shown that the barrel of special phosphate which was claimed to have been purchased by the Clotworthy Company at Balti-

more at that time, or the sample sought to be introduced in evidence in this Court, was manufactured or sold by the defendants. There is no proof that the case which was brought by the complainant herein against the New York Baking Powder Company and others, in the United States Circuit Court for the Southern District of New York, was a "test" case or was intended to be such. The bills of complaint merely allege that such a suit was brought. There is nothing in the record in these causes to show who the parties were to that former litigation, or to show what was involved therein other than that letters patent No. 474,811 were involved in it. There is nothing in the records herein, to show the outcome of that litigation. After the record in the New York case was printed in the Court below, the complainant's solicitor gave notice that he would present to the Court at final hearing, a certified copy of a final decree which was said to have been entered in the Circuit Court of the United States for the Southern District of New York, in a cause entitled "Rumford Chemical Works *vs.* New York Baking Powder Company and others," but no order was made by the Court below making it a part of the record and it is printed in the record here merely because complainant's counsel chose to cause it to be filed with the papers in this case. Moreover, the bill of complaint in the New York cause was filed August 27, 1904, and according to the notice of the complainant's solicitor, the final decree in the action in the United States Circuit Court for the Southern District of New York was not made or entered until May 10, 1905. The entry of such a decree in the suit against the New York Baking Powder Company is not pleaded by any supplemental or amended bill herein, and was, therefore, in any case clearly inadmissible under the issues raised by the original bill and answer.

It is elementary that the only proper evidence of what was adjudicated in another suit or action is the judgment roll itself, or a certified copy thereof. In its absence, a court cannot go outside the record to ascertain who the parties were, their relationships one to another, the issues raised therein, or the effect of the decision, whatever it may have been.

Moreover, the bill of complaint in the New York case alleged the joint infringement of the Letters Patent in suit, by the defendants, within the Southern District of New York, and alleged specifically the sale by the defendants of "baking powder substantially as described in said letters patent numbered 474,811, and embodying the invention therein set forth, and that the defendants still continue so to do" (Rec., No. 339, p. 3).

Not only is there no evidence to support either of these allegations, but it is perfectly plain that there was and could be no attempt to prove them. The utmost that was contended, was that said defendant or another corporation of a similar name, organized in the State of New Jersey, had, some time in the year 1901, sold to the Clotworthy Chemical Company of Baltimore, at Baltimore, a barrel of special phosphate which is said to have been capable of being used in a baking powder preparation, which baking powder preparation, *if* made, *might* have infringed the complainant's patent. Even the fact of this sale to the Clotworthy Chemical Company is not shown by any competent evidence. The nature of the acid phosphate which was the subject of that sale, is not shown by any competent evidence. The purpose for which that special phosphate was made and sold, is not shown by any competent evidence. The baking powder preparation in which that special phosphate *might* have been used as an ingredient, is not shown by any competent evidence.

The allegations of the bills of complaint which are above referred to, relating to the alleged infringement by the defendants, are denied by the answers. The burden of showing infringement thereupon rested upon the complainant, and still rests there. For it is elementary, that infringement is a tort which must be shown by clear and satisfactory evidence, adduced on behalf of the complainant:

> "Infringement being denied, the burden of proof is upon the complainant, to establish the charge."
>
> *Bates* vs. *Coe*, 98 U. S., 31-49.

> "It is incumbent upon the plaintiff to prove clearly and satisfactorily that there has been an infringement. It is an affirmative fact, which it is incumbent on the plaintiff to prove."
>
> *Royer* vs. *Chicago Mfg. Co.*, 20 Fed. Rep., 853, 856.

The only witnesses called on behalf of the complainant, were James E. Heller, the president of the defendant corporation, and Mr. W. E. Wadman, the superintendent or manager of the Hygienic Chemical Company of New Jersey, and one Newton D. Arnold, treasurer of complainant, who undertook to testify under objection regarding evidence given by Mr. Clotworthy, a deceased witness, in the New York suit, but gave no evidence whatever as to the testimony, except that Mr. Clotworthy received one or more barrels of acid phosphate from the Hygienic Chemical Company and from the Provident Chemical Works, and bills or receipts for the same.

No expert witness was called or examined on behalf of the complainant, and there is no expert testimony in the case of any nature or description to explain the subject-matter of the patent or the

various forms of acid phosphates which are in general use, or their relations to the manufacture of baking powder preparations such as that described in the complainant's patent.

It will clearly appear from the records, that no *prima facie* case was made out by the complainant in either case, calling for any answering proofs on the part of the defendants.

V.

The complainant introduced no evidence whatever of any sale of an infringing substance by the defendants, in either case.

Both records will be searched in vain for evidence of any sale by the defendants, either jointly or severally, of any baking powder similar to that described in the Catlin patent, or of any acid phosphate of the character described in the specification and claims of that patent. The learned counsel for the complainant endeavored to cover this branch of his proof by calling as a witness one Newton D. Arnold, treasurer of the complainant, who testified that he was familiar with the testimony given by one W. P. Clotworthy in the New York suit brought by the complainant herein against the New York Baking Powder Company (Rec. No. 339, p. 47); that Clotworthy was the president and general manager of the Clotworthy Chemical Company, and that he remembered that Mr. Clotworthy testified in the New York suit that he, Clotworthy, had purchased from the Hygienic Chemical Company a barrel of acid phosphate (Rec., p. 48), and that he, Arnold, received from Clotworthy a bill and receipt received

in such purchase (Rec., p. 48, fol. 82); that Mr. Heller was present on one day of Mr. Clotworthy's examination (Rec., p. 48), and that he, Arnold, was present during the entire examination; that he had read the transcript of the Clotworthy testimony in the case and that to the best of his recollection it was correct (Rec., p. 49).

Thereupon complainant's counsel gave notice that he would print for the convenience of the Court "the Clotworthy deposition referred to, or at least so much thereof as relates to the barrel of special acid phosphate referred to."

All this was taken under the objection of the defendants' counsel, as calling for the testimony of a deceased witness in a previous action, which is not admissible under the rules of evidence, as not being between the same parties.

Following this notice, and subject to this objection, the complainant's counsel has printed on Rec., pp. 55-6 six questions and answers, and two cross-questions and answers, which the complainant's counsel describes as "extracts from Clotworthy deposition."

The extracts were not authenticated in any way. Upon the face of the record it is apparent that only a small fragment of Mr. Clotworthy's deposition was read, and there is nothing whatever to show that even this small fragment contained all that was relevant to the supposed issues.

Moreover, there is nothing whatever in the record in either case to show who or what the Clotworthy Chemical Company is, or was, except that it was presumably a corporation, and that Mr. Clotworthy was its president and general manager. Even the evidence as to this, however, rests upon the statement of Mr. Newton D. Arnold, and not upon the records of the Clotworthy Company, which would have been the best evidence. There is nothing whatever in the record in this case to

show that the Clotworthy Chemical Company was engaged in the manufacture of baking powders of any kind, or that, if engaged in such manufacture, the baking powders made by it employed as an element acid phosphates.

Against the strenuous objection of defendants' counsel, lithographed copies of the bill and receipt which were said to have been delivered to the Clotworthy Chemical Company at the time of purchase of the barrel of acid phosphate, in March, 1901, were offered in evidence by the complainant.

Judge Cross, in the New Jersey suit, after holding that it had not been shown by any evidence that the defendant was privy to the litigation in the Southern District of New York, and was consequently not concluded thereby, ruled that the evidence of the deceased witness, in the manner in which it was undertaken to be proved, was improper. The learned Judge very properly states his conclusion in the following language:

> "I think the introduction of the testimony into the record in this manner was improper, and, as objection was made thereto, it should be stricken out. The witness (that is, the witness Arnold) should himself have testified into the record what the deceased witness swore to, or the substance thereof, and it should not have been left to counsel to dig out and introduce such portions only as he might deem relevant or important to his case. It is for the Court to say whether the testimony or any part of it was relevant. Counsel has evidently incorporated in this record, as appears by the numbered questions and cross-questions, only fragmentary and disjoined selections from the testimony of the deceased witness."

It is difficult to see how the Judge could have reached any other conclusion. There is nothing whatever to show that this Clotworthy deposition,

or the extract from it, given at Record pages 55-56, was taken in the alleged test case, and nothing to show that even the extracts and fragments, which the complainant's counsel has printed as part of the record, were true copies of the original transcript. The witness Arnold has never identified or authenticated these extracts, or certified to their accuracy, and they are not evidence in any sense of the word.

VI.

There is no evidence whatever that the complainant's exhibit, "Catlin Exhibit, Hygienic Special," was made or sold by the defendants.

The original offer of this exhibit, which was a sealed bottle containing a whitish substance, was made at Rec. No. 339, page 20, and objected to by the defendants' counsel as being insufficiently identified. The only attempt at subsequent identification was made by printing in the record in this case the above mentioned extract or extracts from the so-called Clotworthy deposition, which related to a purchase from the Hygienic Chemical Company of a barrel of so-called special phosphate, and a stipulation that Charles A. Catlin, if called, would testify that he examined a barrel of acid phosphate which he received from Clotworthy, and put the sample in a sealed bottle, which he delivered to counsel for the complainant, and that the sealed bottle is that offered in evidence as complainant's exhibit "Catlin Exhibit, Hygienic Special" (Rec., p. 46), to all of which defendants' counsel entered objection (Rec., p. 47).

The Clotworthy deposition or the extracts from it, in the form in which the complainant undertook

to make it proof, being clearly inadmissible, it is apparent that the identification of the complainant's sample is incomplete, and that in any case it is not shown to be the substance made or sold by the defendant herein. Both Mr. Heller and Mr. Wadman were asked to examine the sample. Mr. Heller testified:

> "It seems to me that this is nothing like the material that has been put out by the Hygienic Chemical Company of New Jersey, as that product contained a very large percentage of extremely fine material which seems to have been screened out of this sample. It does not resemble any of the product manufactured by the Hygienic Chemical Company of New Jersey, to my best recollection, as all of the product made by them, as near as I can remember, contained very large percentage of extremely fine material" (R., p. 20, fol. 35).

Mr. Wadman, in answering a similar enquiry, stated:

> "In so far as this is a white powdered material, it was similar. I would further say that the material in the bottle appears to be a mixture of various substances. There are particles of many colors, shapes and apparent sizes. In this respect, as consisting of particles of different colors, it is quite different" (Rec. No. 339, p. 37).

And again, in describing the acid phosphate made by the Hygienic Chemical Company of New Jersey, Mr. Wadman testified as follows:

> "Q. 15. Is the Hygienic Chemical Company, the New Jersey concern, at this time manufacturing an acid phosphate containing some finely powdered material and some in a coarser condition? A. Yes, and at no time did it make any other" (Rec., p. 37).

So not merely is the identification of the contents of the bottle, with the barrel of phosphate said to have been purchased by Mr. Clotworthy from the Hygienic Chemical Company of New York, in March, 1901, entirely unsupported by proper legal evidence, but both the witnesses called by the complainant when shown the sample offered in evidence by the complainant's counsel, stated that the substance contained in the bottle appeared to be different from that sold by the defendant corporation at any time.

VII.

There is no evidence whatever in either case that the Complainant's Exhibit "Catlin Exhibit Hygienic Special" was a substance which infringed the Catlin Patent, or was capable of being used in a baking powder which infringed such patent.

No witness was called by the complainant to testify regarding the nature of the whitish substance contained in the sealed bottle which was offered in evidence over defendant's objection. The only attempt made by complainant's counsel to show the nature of this substance is contained in a stipulation (Rec., p. 46), which declares that, if called as a witness, Mr. Catlin would testify that the substance was "an acid granular phosphate such as is used in the manufacture of baking preparations" (Rec., p. 46), and that "he found that the quantity of pulverulent phosphatic material that would pass through a No. 16 silk bolting cloth was less than five per cent. (5%) of the whole mass" (Rec., p. 46). These facts were objected to as immaterial and irrelevant,

Mr. Catlin does not say, nor does the stipulation state, that the substance in the bottle was capable of being used as an infringing element of his patent. Nor does it anywhere appear that the substance was identical with or similar to any acid phosphate which was held by the Circuit Court of Appeals in the case against the New York Baking Powder Company to be an infringement or an infringing element of the Catlin patent.

VIII.

There is no evidence whatever in the record of any contributory infringement by the defendants.

The claims of the Catlin patent are not for an acid phosphate or any form of phosphoric acid, but both claims are for a baking preparation which contains as an element an acid phosphate or form of phosphoric acid. It is not even pretended by the learned counsel for the complainant that the defendants ever made or sold a baking preparation of any nature or description. It is not shown by any competent evidence that the defendant corporation ever sold an acid phosphate or form of phosphoric acid to any manufacturer of a baking preparation with the intent that it was to be used in any infringing combination. As was well said by Judge Cross in his opinion in the New Jersey case:

> "The specific sale sought to be proven by the above testimony was of a barrel of acid phosphate, a constituent element in the manufacture of baking powder, and the claim is made that it was knowingly sold for the purpose of being used in the manufacture of baking powder; that it was designed and intended for that use solely, and that conse-

quently the defendant by the sale became guilty of contributory infringement. Assuming that the article in question was sold by the defendant to Clotworthy or others, there is no evidence showing for what purpose it was sold or used, nor that it was only useful when combined in the manner provided in the patent in suit; on the contrary, there is evidence that it was an article of commerce in general and common use for a number of specific purposes; it is true it could be combined and used as claimed in the patent, but it could likewise be used, and sold and used, for a variety of other purposes, and I find no evidence in the case to show that there was any agreement, knowledge or understanding that any acid phosphate sold by the defendant was to be combined with other articles to infringe the complainant's patent. The complainant made Heller his own witness, and his testimony, corroborated by Wadman to some extent as to the variety of uses for which acid phosphate is manufactured, adapted and sold, is uncontradicted."

Even if the final decree in the case against the New York Baking Powder Company be considered it appears that the only things adjudicated by the decree were the validity of the Catlin patent and the infringing character of the baking powder made by the New York Baking Powder Company. Under no circumstances could the acid phosphate sold by the defendant in this case have geen adjudicated in that case to be an infringement, as it does not appear that it was a party to the case.

Contributory infringement can only be established:

(*a*) when it is proved by competent evidence that the article made by the contributing per-

son can have no other use than as a part of the infringing article.

American Graphophone Co. v. *Hawthorne* (92 Fed. Rep., 516);

(*b*) or when it is proved that the person making the article has knowledge of the fact that its use forms a part of the infringing article.

Edison Electric Light Co. vs. *Peninsular Light, Power and Heat Co.* (95 Fed. Rep., 669).

That one who manufactures an essential part of an infringing structure which is adapted to no other use, and sells it to another to complete the structure, is contributory to and liable for the infringement is well established.

See

Canda v. *Michigan Malleable Iron Co.* (124 Fed. Rep., 486).

In *Bullock Electric & Mfg. Co.* v. *Westinghouse Electric & Mfg. Co.* (129 Fed. Rep., 105), the Court says:

"The intent and purpose that the element made and sold shall be used in a way that shall infringe the combination in which it is an element constitutes the necessary concert of action between him who furnishes the single part and he who actually does the injury by the assembling and using of all the parts in such a way as to be an infringement. This principle runs through all the cases upon contributory infringement."

To the same effect are—

Thomson-Houston Electric Co. v. *Ohio Brass Works* (80 Fed. Rep., 712).

Standard Computing Scale Co. v. *Computing Scale Co.* (126 Fed. Rep., 639).

See also *Snyder* v. *Bunnell* (29 Fed. Rep., 47).

Let us now see what the evidence as to the character of the articles sold by the defendant company, and as to the knowledge on its part that it was to enter an infringing article.

James E. Heller was called by the complainant under a subpœna (R., p. 11, fol. 20); by so doing the complainant made Heller its own witness, and took the chances of being prejudiced by anything that he might say. He testified that he was connected with the defendant company (R., p. 12, fol. 29); that this company sold an acid phosphate which was manufactured by the New Jersey Company and which contained a large percentage of very fine powdered material and some percentage of coarser material (R., p. 37 and p. 46, A. 80); that the New Jersey Company manufactured and sold acid phosphate for use by candy manufacturers, sugar boilers, sugar planters and druggists and suppliers of soda water fountains, and that the proportion for these latter uses as distinguished from the use for the manufacture of baking powders was quite large (R., p. 30); thereafter, Mr. Heller was subjected to redirect-examination by complainant's counsel as to these various other uses, and testified (R., pp. 31-32, inclusive) as to the various other uses to which acid phosphate can be put other that the manufacture of baking powder; all of this was spread upon the record by

omplainant's counsel and stands as evidence of-
red on complainant's behalf. It is obvious from
e foregoing that the article in question, namely,
id phosphate as sold by the defendant company,
capable of a great many other uses than the mere
e of serving as an ingredient in the manufacture
baking powder.

This evidence was corroborated by Walter E.
adman, Superintendent of the factory of the Hy-
enic Chemical Company of New Jersey, who was
lled as a witness by the complainant.

It is further apparent that the New Jer-
y company manufactured, and the defendant
ew York company sold, acid phosphate pure-
for commercial purposes without any knowl-
lge or intent that the same was to be used
a baking powder, or for one purpose any
ore than for another, it being equally adapted
various uses. There is absolutely no evi-
ence to show any concert of action between
ese defendants and the defendants in the
ior action. Even if the evidence as to the sale
the Clotworthy barrel is allowed to stand over
efendants' objections, and such sale be sufficiently
roven, yet there is no evidence to show that the
efendants intended this barrel to be used in a
aking powder, that it ever was so commercially
sed, or that defendants ever had any knowledge
hatever that it was to be so used. The claims
the patent in suit are for a baking preparation
ontaining phosphoric acid or its compound in
anular condition, essentially free from pulveru-
nt phosphatic material. There is no claim what-
er on such acid phosphate alone, and except in
onjunction with other material. There is no al-
gation whatever in the bills of complaint that
e defendants combined with any baking powder
anufacturer to infringe the patent, nor is there
nywhere any evidence tending in the least to

show this, and the only ground on which the complainant seeks to hold the defendants is the claim that they participated in the former suit. This does not constitute contributory infringement under any decisions which can be found, and in fact is lacking in all of the essential elements of contributory infringement as laid down in the cases.

It is well settled that infringement is a tort which must be proved, and it cannot rest only upon conjecture.

King v. *Anderson*, 90 Fed. Rep., 500.
Electric Light Co. v. *Kaelber*, 76 Fed. Rep., 804.

In the former case, the Court said:

> "One may occupy the same room, or, in-
> "deed, the same bed, with an infringer and
> "yet not be guilty of infringement. Infringe-
> "ment is not contagious."

In the second case the Court said:

> "The burden of proving the infringement
> "is upon the complaint, and that even un-
> "der a *quia timet* suit there must be 'well
> " 'grounded proof of an apprehended inten-
> " 'tion to violate the plaintiff's right.' "

See also the recent decision of Judge Hazel in *Rumford Chemical Works* v. *Egg Baking Powder Co.*, 145 Fed. Rep., 953.

There is absolutely no proof that the Clotworthy sample, even if capable of being used in such a manner as to infringe the patent in suit, was sold by the defendants for the purpose of being so used.

IX.

The extract from the Clotworthy deposition was clearly inadmissible as against the defendants.

As already stated, the complainant's counsel has printed (R. No. 339, pp. 55-6), an incomplete extract from the deposition of one W. P. Clotworthy in the prior suit of the Rumford Chemical Works against the New York Baking Powder Company in the Circuit Court of the United States for the Southern District of New York, with proof that the witness Clotworthy had died subsequent to the taking of his testimony. None of the defendants to this action were parties to the suit in which Clotworthy's deposition was taken, or that any of them had any opportunity of cross-examining Clotworthy, or otherwise participated in the trial of that suit.

There is no provision of the Revised Statutes of the United States which makes the deposition of a deceased witness admissible in a later suit between other parties. The complainant's offer, therefore, of Clotworthy's deposition is entirely unsupported by any statutory provision.

Moreover, the Federal courts have decided that the testimony of a deceased witness given in another action will not be admitted in a subsequent action, unless the parties in the subsequent action were identical with those in the action in which the deposition of the deceased witness was taken, or unless there is such privity to the judgment as to make the deposition admissible on that ground. This was clearly held in the United States Circuit Court of Appeals in the Second Circuit, in the case of the *Metropolitan Street Railway Company* v. *Gumby* (99 Fed. Rep., 192).

The defendants have obviously had no opportunity of meeting or cross-examining such witness. The defendants cannot be deprived of their constitutional right by any such indirect offer as the plaintiff's counsel has resorted to in the case at bar, and the Clotworthy deposition was properly excluded. See also the clearly rule laid down in the text books.

> *Chase's Stephen's Digest of the Law of Evidence*, 2d Ed., Art. 32.
> *Greenleaf on Evidence*, §§ 163 and 168, and the cases there cited.

If the complainant's contention of the continued and repeated infringement of the complainant's patent by the defendants had any foundation, it would surely have been easy for the complainant to adduce evidence in support of this allegation by producing some witness, or by proving some transaction in which the defendant herein was concerned.

Moreover, as we have seen, there is no evidence that the issues before the Court in the case of *Rumford Chemical Works* against *the New York Baking Powder Company*, in the Circuit Court of Appeals, Second Circuit, included in any way the question as to whether this Clotworthy sample did or did not infringe the patent. As was said by the Circuit Court of Appeals in

> *Ætna Life Insurance Co.* vs. *Board of Commissioners, etc.*, 117 Fed. Rep., 82:

> "In that class of cases in which the second action presents a material issue or matter which may not have been raised, litigated or decided in the former action, it is undoubtedly essential to the estoppel to show what issue was litigated and decided and what question was determined in the earlier case, in order to determine whether

or not the issue there determined embraced the matter in litigation in the second action."

X.

In cause No. 339, the decree of the Circuit Court of Appeals for the Second Circuit should be reversed, and the case remanded with directions to enter a decree affirming the dismissal of the bill of complaint, with costs.

In cause No. 149, the decree of the Circuit Court of Appeals for the Third Circuit should be affirmed, with costs.

WHITRIDGE, BUTLER & RICE,
Solicitors for the Defendants.

WILLARD PARKER BUTLER,
EDWIN T. RICE,
Of Counsel.

2/

Supreme Court of the United States.

OCTOBER TERM, 1909.

Nos. 9 AND 121.

Office Supreme Court, U. S.
FILED.
DEC 15 1909
JAMES H. McKENNEY,
Clerk.

No. 9.

RUMFORD CHEMICAL WORKS,
Petitioner,
vs.
HYGIENIC CHEMICAL COMPANY (OF NEW JERSEY).

On Writ of Certiorari to the United States Circuit Court of Appeals for the Third Circuit.

No. 121.

HYGIENIC CHEMICAL COMPANY (OF NEW YORK), JAMES E. HELLER and ADOLPH HIRSH,
Petitioners,
vs.
RUMFORD CHEMICAL WORKS.

On Writ of Certiorari to the United States Circuit Court of Appeals for the Second Circuit.

Notice of Motion, Motion, and Petition for Leave to Reopen Proofs in Circuit Courts,

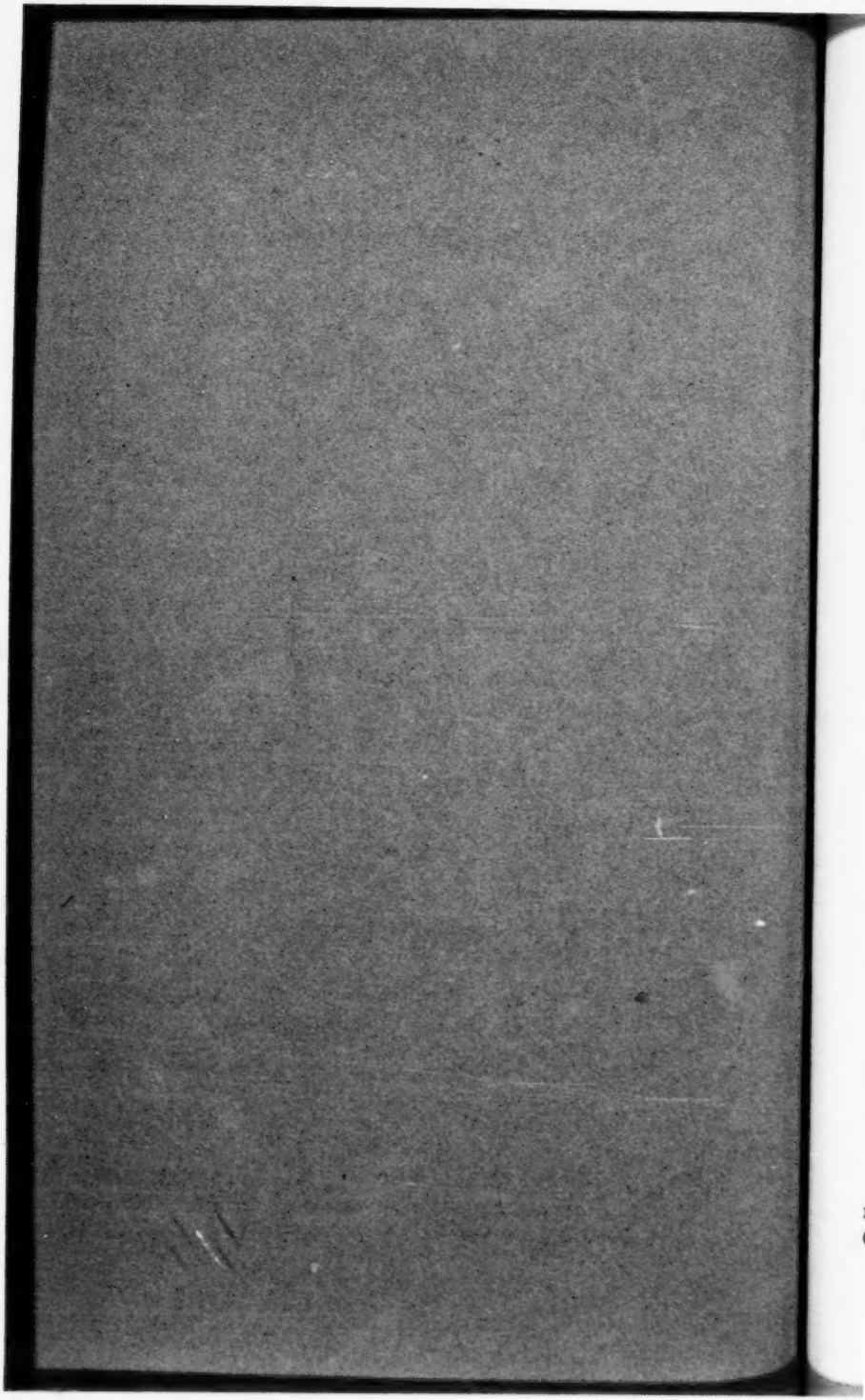
AND

Brief in Support of Petition.

PHILIP MAURO,
Attorney for Rumford Chemical Works.

C. A. L. MASSIE,
Of Counsel.

C. G. Burgevin, 72 to 78 Spring Street, New York.



Supreme Court of the United States,

NOS. 9 AND 121. OCTOBER TERM, 1909.

No. 9. RUMFORD CHEMICAL WORKS, Petitioner, vs. HYGIENIC CHEMICAL COMPANY OF NEW JERSEY.	On Writ of *Certiorari* to the United States Circuit Court of Appeals for the Third Circuit.
No. 121. HYGIENIC CHEMICAL COMPANY OF NEW YORK, JAMES E. HELLER and ADOLPH HIRSH, Petitioners, vs. RUMFORD CHEMICAL WORKS.	On Writ of *Certiorari* to the United States Circuit Court of Appeals for the Second Circuit.

Notice of Motion.

To MESSRS. WILLARD PARKER BUTLER, EDWIN T. RICE,
Attorneys for Hygienic Chemical Company (of New York), Hygienic Chemical Company (of New Jersey), James E. Heller, and Adolph Hirsh,
59 Wall Street,
New York City.

Please take notice that on Monday, ~~Dec. 20, 1909~~ Jany. 3, 1910, the annexed Motion and Petition will be submitted to the Supreme Court of the United States at the Court Room thereof in

the City of Washington, D. C., at the opening of Court on that day or so soon thereafter as counsel can be heard.

PHILIP MAURO,
Attorney and of Counsel for the Rumford Chemical Works.

Due service of the foregoing Notice, Motion and annexed Petition and Brief is hereby admitted this 9th day of December, 1909.

WILLARD PARKER BUTLER,
EDWIN T. RICE,
Attorneys for Hygienic Cos., Heller, and Hirsh.

SUPREME COURT OF THE UNITED STATES,

NOS. 9 AND 121—OCTOBER TERM, 1909.

No. 9. RUMFORD CHEMICAL WORKS, Petitioner, vs. HYGIENIC CHEMICAL COMPANY OF NEW JERSEY.	On Writ of *Certiorari* to the United States Circuit Court of Appeals for the Third Circuit.
No. 121. HYGIENIC CHEMICAL COMPANY OF NEW YORK, JAMES E. HELLER and ADOLPH HIRSH, Petitioners, vs. RUMFORD CHEMICAL WORKS.	On Writ of *Certiorari* to the United States Circuit Court of Appeals for the Second Circuit.

Motion.

And now comes the RUMFORD CHEMICAL WORKS, the above-named Petitioner, a corporation organized and existing under and by virtue of the laws of the State of Rhode Island by its attorney, Philip Mauro, Esq., upon the Transcripts of Record herein, and upon the single Opinion of this Court rendered herein on November 29, 1909, and other proceedings already had herein, and upon the annexed Petition, and moves this Honorable Court for leave to reopen its proofs in the two Circuit Courts below, and for such other proceedings and relief to your Petitioner as to this Court may seem just.

PHILIP MAURO,
Attorney for Rumford Chemical Works.

SUPREME COURT OF THE UNITED STATES.

NOS. 9 AND 121—OCTOBER TERM, 1909.

No. 9. RUMFORD CHEMICAL WORKS, Petitioner, vs. HYGIENIC CHEMICAL COMPANY OF NEW JERSEY.	On Writ of *Certiorari* to the United States Circuit Court of Appeals for the Third Circuit.
No. 121. HYGIENIC CHEMICAL COMPANY OF NEW YORK, JAMES E. HELLER, and ADOLPH HIRSH, Petitioners, vs. RUMFORD CHEMICAL WORKS.	On Writ of *Certiorari* to the United States Circuit Court of Appeals for the Second Circuit.

Petition.

The Petition of the Rumford Chemical Works, Petitioner in No. 9 and Respondent in No. 121, respectfully shows to your Honors as follows:

1. Recently, on or about November 29, 1909, this Honorable Court rendered in these two cases a single written Opinion.

2. From said Opinion it appears that an important and controlling issue in this controversy is the question whether or not the parties defendant in the two Circuit Courts below, (viz: Hygienic Chemical Co. of New York, Hygienic Chemical Co. of New Jersey, James E. Heller, and Adolph Hirsh), or any of them, were privies in the defense

of a certain prior suit by your Petitioner, formerly depending in the Circuit Court of the United States for the Southern District of New York, against *New York Baking Powder Co., Provident Chemical Works, and Franklin P. Gordon* (reported in 134 Fed. Rep., 385, 67 C. C. A., 367, and 136 Fed. Rep., 873).

3. Your Petitioner has all along contended that the said defendants were in fact privies to the defense of the said prior suit, and were and are therefore under all the liabilities of privies to prior litigation; and this Honorable Court, in its said Opinion says:

> "It would seem, from a late case, that the plaintiff [meaning your Petitioner] was correct in point of fact. *Provident Chemical Works v. Hygienic Chemical Co.*, 170 F. R., 523";

but your Honors have declined to consider said case reported in 170 Fed. Rep., because the facts *there* established were not properly in evidence in this present litigation; and this Honorable Court has therefore decided these two cases against your Petitioner, by reason of the want of satisfactory evidence *herein* upon that question of privity.

4. It now appears, from said recently reported decision in Vol. 170 of the Federal Reporter, page 523, that there was in fact a formal Agreement or Contract made on May 17, 1900, by and between the Provident Chemical Works (one of the avowed defendants in the prior litigation above referred to) and one or more of the defendants in this present litigation (to wit, "Hygienic Chemical Co."), under and by virtue of which Agreement or Contract the said "Hygienic Chemical Co." (and perhaps others of the defendants herein) obligated themselves to conduct and control the defense of said prior litigation through attorneys appointed by themselves, and to bear half the expenses and costs thereof; and that said "Hygienic Chemical Co." (and perhaps others of the defendants herein) did in fact carry out that Agreement or Contract, and were in fact privies to that prior litigation.

5. The existence of said Agreement or Contract of May 17, 1900, and of the stipulated state of facts set forth in the re-

port of the recent case aforesaid (170 Fed. Rep., 523) became known to your Petitioner about August 19, 1909, when it was learned by reason of the publication, on or about that date, of the "advance sheets" of the Federal Reporter; and said evidence was therefore not available to your Petitioner until more than three years after its proofs herein had been closed (about February, 1906), and more than a year after this Honorable Court has assumed jurisdiction over both suits (in May–June, 1908).

6. The evidence aforesaid, relating to said Agreement or Contract of May 17, 1900, is now of record and on file in the Circuit Court of the United States for the Southern District of New York; and, in view of the Opinion of this Honorable Court herein, said evidence and said Agreement or Contract are highly material, and (your Petitioner believes) will be conclusive in your Petitioner's favor if introduced into this litigation.

WHEREFORE, your Petitioner, the Rumford Chemical Works, respectfully prays that it may have leave to reopen its proofs herein, in the Circuit Court of the United States for the Southern District of New York, and also in the Circuit Court of the United States for the District of New Jersey, in order to establish the existence of the aforesaid formal Agreement or Contract of May 17, 1900, and the privity of the defendants herein with that former litigation; that the Mandates of this Honorable Court issuing to the two Circuit Courts aforesaid may grant your Petitioner permission to reopen its proofs as aforesaid; and that your Honors may grant such other and further relief as the justice of the case may require.

And your Petitioner will ever pray.

RUMFORD CHEMICAL WORKS,
By PHILIP MAURO,
Its Attorney.

Brief in Support of Petition.

It cannot be denied that at least one of the defendants in the present litigation (and probably all of them) defended the prior suit against *New York Baking Powder Co. et al.* (134 Fed. Rep., 385) *as* a "test suit", under a formal written Agreement, having absolute control of that defense, selecting the attorneys, etc. The facts in this regard appear from defendants' own admissions, as reported in the *Provident-Hygienic* decision (170 Fed. Rep., 523).

It is clear that if our proofs in the present litigation contained competent evidence of the foregoing facts, then the testimony given in that "test suit" by the witness Clotworthy (since deceased) would be admissible here against those who took part in defending that "test suit"; and that, *with* such additional evidence, we must prevail on the merits.

It likewise appears from our Petition, that such facts, highly material as they are, constitute "newly discovered evidence" not available to us until years after our proofs had been closed, and not until over a year after this Court had assumed jurisdiction.*

Here, then, is a situation where, upon the *real facts*, the complainant is entitled to a decree; and such facts, peculiarly within the knowledge of defendants, have only *now* become available to complainant. Under these circumstances the ends of justice require that complainant be permitted to re-open its proofs in order to establish those facts. And, since this Court has now decided the cases as on appeal, the proper procedure requires that leave to re-open be obtained from this Court.

> *In re Potts, Petitioner*, 166 U. S., 263, and cases cited on page 267.

In that very Potts litigation, this Court did in fact subsequently grant the party leave to re-open its proofs and obtain a re-hearing. See:

> *C. & A. Potts & Co. v. Creager*, 97 Fed. Rep., 78, top of page 79.

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* It is true that, at the opening of the present Term of this Court, we *might* have moved to remand the cases to the Circuit Courts; but we were then in a fair way to be reached here at a comparatively early date, and were justified in relying upon the favorable decision obtained in the Court of Appeals for the Second Circuit.

We therefore ask for relief and for leave to re-open our proofs to establish the Agreement of May 17, 1900, referred to in the *Provident-Hygienic* decision (170 Fed. Rep.), and by means of that Agreement to establish that some or all of the present defendants were privy to the former litigation. We suggest that leave be granted by means of a proviso incorporated into the two Mandates to be sent down to the respective Circuit Courts.

Respectfully submitted,

PHILIP MAURO,
C. A. L. MASSIE,
Attorneys and of Counsel for Rumford Chemical Works.

New York City, December 9, 1909.

FILED

DEC 31 1908

JAMES H. MCKENNEY

Clerk

Supreme Court of the United States.

OCTOBER TERM, 1908.

No. 4 and 5.

RUMFORD CHEMICAL WORKS,

Petitioner,

Against.

HYGIENIC CHEMICAL COMPANY OF NEW JERSEY.

No. 4.

On Writ of Certiorari to the United States Circuit Court of Appeals for the Third Circuit.

HYGIENIC CHEMICAL COMPANY OF NEW YORK, JAMES C. HELLER AND ADOLPH HELLER,

Petitioners,

Against.

RUMFORD CHEMICAL WORKS.

No. 5.

On Writ of Certiorari to the United States Circuit Court of Appeals for the Second Circuit.

REPLY OF HYGIENIC CHEMICAL COMPANY OF NEW JERSEY, HYGIENIC CHEMICAL COMPANY OF NEW YORK, JAMES C. HELLER AND ADOLPH HELLER, AND EACH OF THEM IN OPPOSITION TO PETITION FOR LEAVE TO ISSUE PEREMPTORY WRIT OF MANDAMUS.

WHITEFORD, HUTTON & RICE,

Attorneys for Hygienic Chemical Co. of N. J.

WILLARD PARKER HUTTON,

EDWARD T. RICE,

Of Counsel.

Supreme Court of the United States.

Nos. 9 AND 121—OCTOBER TERM, 1909.

RUMFORD CHEMICAL WORKS, Petitioner, AGAINST HYGIENIC CHEMICAL COMPANY OF NEW JERSEY.	No. 9. On Writ of Certiorari to the United States Circuit Court of Appeals for the Third Circuit.
HYGIENIC CHEMICAL COMPANY OF NEW YORK, JAMES E. HELLER and ADOLPH HIRSH, Petitioners, AGAINST RUMFORD CHEMICAL WORKS.	No. 121. On Writ of Certiorari to the United States Circuit Court of Appeals for the Second Circuit.

Answer.

The answer of HYGIENIC CHEMICAL COMPANY OF NEW JERSEY, respondent in No. 9, and of HYGIENIC CHEMICAL COMPANY OF NEW YORK, JAMES E. HELLER and ADOLPH HIRSH, petitioners in No. 121, to the petition of RUMFORD CHEMICAL WORKS, respectfully shows to this Honorable Court:

I.—The above causes came on for hearing at the October Term, 1909, of this Honorable Court, and

on November 29th, 1909, decisions were rendered affirming the decree in No. 9, and reversing the decree in No. 121. The opinion of the Court was delivered by Mr. Justice Holmes.

II.—The Rumford Chemical Works has filed a petition herein for leave to reopen its proofs in the two Circuit Courts below, in order to establish the existence of a formal agreement of May 17, 1900, alleged to have been executed between the Provident Chemical Works and the Hygienic Chemical Company. Said petition states that the Provident Chemical Works was a defendant in a prior litigation instituted by the Rumford Chemical Works against New York Baking Powder Company *et al.*, in the Circuit Court of the United States for the Southern District of New York. Said petition also states that the alleged agreement of May 17, 1900, is referred to in a decision of the United States Circuit Court for the Southern District of New York, reported in 170 Fed. Repr., p. 523. It is claimed that such agreement is newly discovered evidence, and the petitioner desires to reopen its proofs solely in order to establish such agreement.

III.—As appears from the record on file in each of the above causes, the petitioner, Rumford Chemical Works, failed entirely to establish by any sufficient legal evidence, who were the parties to the prior suit of Rumford Chemical Works *v.* New York Baking Powder Company *et al.*, or what the issues in such suit were. The judgment roll was not put in evidence and the complainant did not show, in accordance with the established rules of evidence, what was involved in said prior litigation, what was adjudicated therein, or who the parties to such litigation were. It further appears that its omissions in this regard were drawn to the attention of the Rumford Chemical Works and its counsel by an exhaustive opinion filed by Judge Cross in the New Jersey litigation in December, 1906, prior to the

argument of the case against the Hygienic Chemical Company of New York *et al.*, in the United States Circuit Court for the Southern District of New York. It further appears from the records in each of said causes that the so-called Clotworthy deposition was not proved by the Rumford Chemical Works in accordance with the established rules of evidence, and that all the irregularities and insufficiencies of the complainant's evidence were drawn to its attention by the decision of the Circuit Court of the United States for the District of New Jersey. It was plainly held by such decision of Judge Cross that no privity had been shown or established as between the defendants in the prior suit against the New York Baking Powder Company *et al.* and the defendant in the New Jersey case. This decision of the New Jersey court was followed in every respect by the Circuit Court of the United States for the Southern District of New York.

No application was made by the Rumford Chemical Works to reopen either the New York or the New Jersey case for the purpose of supplying these manifold and very obvious deficiencies of proof, or any of them, but appeals were taken by the Rumford Chemical Works to the Circuit Courts of Appeal in the Second and Third Circuits, respectively, from the decrees of dismissal. More than three years have now elapsed since Judge Cross' opinion was filed in the New Jersey cause and upwards of two years and a half since Judge Holt dismissed the bill in the New York case.

IV.—The sole evidence of infringement relied upon by the Rumford Chemical Works in both the New York and the New Jersey causes was the alleged sale to the Clotworthy Chemical Company of a single barrel of acid phosphate by the Hygienic Company of New York. Whether such sale, if properly proved, and if the nature of the acid phosphate sold

by the Hygienic Company of New York had been established, amounted to infringement, was not decided by this Court. The opinion of Mr. Justice Holmes declares in this regard:

> "Whether if it had been admitted infringement could have been inferred from the sale of a barrel of granular acid phosphate to a manufacturer of baking powder, need not be considered."

V.—It thus appears that, even if the agreement referred to in 170 Fed. Repr., 523, were put in evidence, either in the New York or the New Jersey cause, the Rumford Chemical Works would not in any case establish a *prima facie* case as regards any of the defendants. Moreover, it appears affirmatively, from the record of the case reported in 170 Fed. Repr., 523, that the litigation therein referred to, brought by the Rumford Chemical Works against the New York Baking Powder Company, was under the control of the Provident Chemical Works, and that none of the defendants in the New York or New Jersey causes herein had any control of such litigation in any such way as to make any of them privies thereto within the rules laid down by this Court in *Litchfield* v. *Goodnow*, 123 U. S., 549.

WHEREFORE, your respondents pray that the application of the Rumford Chemical Works, petitioner, for leave to reopen its proofs in the Circuit Court of the United States for the Southern District of New York, and also in the Circuit Court of the United States for the District of New Jersey, in order to establish the existence of the alleged formal agreement of May 17, 1909, be denied; and your respondents pray that the mandates of this Honorable

Court issue to the said two Circuit Courts of Appeal, directing in No. 9 that the decree appealed from be affirmed, and that the decree in No. 121 be reversed in accordance with the decision filed herein on November 29, 1909.

HYGIENIC CHEMICAL CO. OF N. J.
per JAMES E. HELLER
Prest.

HYGIENIC CHEMICAL CO. OF NEW YORK
per JAMES E. HELLER,
Prest.

JAMES E. HELLER
ADOLPH HIRSH

WILLARD PARKER BUTLER
of Counsel

STATE OF NEW YORK,
Southern District of New York, } ss.:
County of New York.

JAMES E. HELLER, being duly sworn, says:

I am the President of the Hygienic Chemical Company of New Jersey, the respondent named in No. 9, and the President of Hygienic Chemical Companyof New York, one of the petitioners in No. 121; I have read the foregoing answer and know the contents thereof, and the same is true of my own knowledge except as to the matters therein stated to be alleged on information and belief, and as to those matters I believe it to be true.

The reason why this verification is made by deponent and not by the Hygienic Chemical Company of New Jersey and the Hygienic Chemical Company of New York, is that they are corporations and deponent is the president thereof.

Sworn to before me this 30th day of December, 1909. } JAMES E. HELLER

CHARLES ENGEL
Notary Public,
[L. S.] Kings County.
Certificate filed in N. Y. Co.

Due service of three copies of the foregoing answer is hereby admitted this 30th day of December, 1909.

Philip Mauro

Attorney for Rumford Chemical Works.

U. S. Supreme Court.

RUMFORD CHEMICAL WORKS, Petitioner, v. HYGIENIC CHEMICAL COMPANY OF NEW JERSEY, Respondent.	October Term, 1909. No. 9, former No. 149.

HYGIENIC CHEMICAL COMPANY OF NEW YORK, Petitioner, v. RUMFORD CHEMICAL WORKS, Respondent.	October Term, 1909. No. 121, former No. 339.

BRIEF IN OPPOSITION TO THE PETITION OF RUMFORD CHEMICAL WORKS.

Statement.

On November 29th, 1909, this Court, Mr. Justice Holmes writing the opinion, affirmed the decision of the Circuit Court of Appeals for the Third Circuit in No. 9, and reversed the decision of the Circuit Court of Appeals for the Second Circuit, in No. 121. The

effect of these decisions is to direct a dismissal of the bill of complaint in each cause.

The Rumford Chemical Works, complainant in each cause, has now filed a petition for leave to reopen its proofs in the Circuit Court of the United States for the Southern District of New York, and in the United States Circuit Court for the District of New Jersey, for the purpose of establishing the existence of an agreement dated May 17th, 1900, alleged to have been made between the Provident Chemical Works and the Hygienic Chemical Company of New York, referred to in 170 Fed. Rep., 523. The petition merely alleges that the agreement was not known by the petitioner to exist until August 19, 1909, at the time of the publication of the advance sheets of the Federal Reporter. It is not stated, and could not be truthfully stated that the existence of such agreement could not have been ascertained by the exercise of due diligence on the part of the petitioner. The answer of the Hygienic Companies and of James E. Heller and Adolph Hirsh denies the materiality of the alleged newly discovered evidence and shows laches on the part of the petitioner. It also prays that the mandates of this Court issue in due course in accordance with the decisions filed on November 29, 1909.

I.

The evidence sought to be introduced by the petitioner cannot establish privity as against the defendants in either the New York or the New Jersey suit.

The sole purpose for which the alleged agreement of May 17, 1900, is sought to be introduced is to

establish privity between the Hygienic Companies and the Provident Chemical Works, which is said—but not proved—to be one of the defendants in Rumford Chemical Works *vs.* New York Baking Powder Co. *et al.*

But no proof has ever been made in these causes of the precise issues involved in the suit against the New York Baking Powder Co. *et al.*, of the names and other particulars of the parties thereto, or of what was adjudicated therein as between the parties. The complainant's omissions in this regard were commented on by Judge Cross in the New Jersey case in his opinion filed three years ago, and Mr. Justice Holmes in his opinion observes that the record in the New York Baking Powder case was not put in evidence.

Inasmuch as there was no evidence before either of the Courts below regarding the prior litigation on the Catlin patent, the introduction of the alleged agreement of May 17, 1900, cannot establish privity as against the defendants in either of these causes, for there is nothing to show who or what the Provident Chemical Works was, or what was adjudicated as against it. This subject was fully discussed upon Point II of the principal brief filed in these causes on behalf of the defendants, and we refer to the cases therein cited.

II.

The petition does not allege or show that the existence of the agreement of May 17th, 1900, could not have been ascertained by the exercise of reasonable diligence.

The matter of the relations between the Hygienic Companies and the Provident Chemical Works was

inquired into by the counsel for the petitioner in the original litigation against the New York Baking Powder Company *et al*, and also in the present suits. Mr. Heller, president of Hygienic Companies was called and examined as a witness for the complainant the Rumford Chemical Works in both the New York and New Jersey suits. Certain questions and answers given by him in the former litigation against the New York Baking Powder Company *et al.* were read upon the record, and Mr. Heller was asked if his answers were true. He then stated that the Hygienic Chemical Company of New York had assisted in the burden of the defense of the prior suit, and in that suit he had testified to substantially the same effect (No. 339, p. 21).

No inquiry was made of this witness as to the existence of any agreement between the Hygienic Companies and the Provident Chemical Works, but as the examination took place in December, 1905, it is obvious that a proper inquiry of the witness Heller regarding the relations between the two Hygienic Companies and the Provident Chemical Works would have disclosed the existence of the agreement of May 17th, 1900, and its production could have been required by the service of a subpœna *duces tecum*. Thus it appears that there was no effort whatever to obtain proper evidence upon this head, and the Court is now asked for leave to reopen the record in these matters for the purpose of relieving the complainant from the effect of its failure to establish its case by proper evidence, which could have been obtained by the exercise of due diligence.

III.

It is well settled that in order to obtain a rehearing upon the ground of newly-discovered evidence the applicant must show that the evidence is material, that it could not have been discovered at the time of the former trial by the exercise of due diligence, and that its introduction would materially affect the result.

The petitioner has not brought the present application within the settled rules. As stated upon the foregoing point, the existence of the agreement of May 17th, 1900, could have been ascertained by the exercise of due diligence. No investigation or inquiry was made by the petitioner regarding the existence of any agreement between the Hygienic Chemical Companies and the Provident Chemical Works, although such an inquiry, properly conducted, would have inevitably disclosed its existence.

In the case of

Carr v. Gale, 1 Curtis, 384, 5 Fed. Cas., 116,

Mr. Justice Curtis states the rules regarding diligence in these matters as follows:

> "It cannot be considered as the use of due diligence to suffer a trial to proceed, and after a verdict against him, proceed to make the inquiries which he might and ought to have made before."

This doctrine is cited with approval by Hammond, *J.*, in

Wright v. *Southern Express Company, 80 Fed. Rep., 85.*

To the same effect is

Fuller v. *Harris, 29 Fed. Rep., 814.*

See also

Washburn v. *Gould, 3 Story, 122.*
Codman v. *Railroad Co., 17 Blatch., 1.*

It has been already pointed out that, even if this alleged newly discovered evidence were introduced, it would be insufficient to change the result, because of the manifest insufficiencies of proof in other branches of the petitioners' case. This Court approved of a decision of the Court of Claims, refusing to grant a new trial, because the newly discovered evidence would not change the result in

Williams v. *United States, 137 U. S., 113.*

The rules applicable to these applications are also well stated by Martin, *J.*, in

Glassford v. *Lewis, 82 Hun, 46, 48,*

as follows:

> "It must appear that the evidence has been discovered since the trial; that it could not have been obtained upon the former trial by the exercise of reasonable diligence; that it is material to the issue and goes to the merit of the case; that it was not merely cumulative, and that its character is such that it would probably have changed the result. When these facts appear, and the Court is satisfied that the ends of justice will be promoted by allowing the moving party an opportunity to present the newly-discovered evidence, the motion will be granted."

The present application does not satisfy any of these requirements. The agreement of May 17th, 1900, could have been discovered by the exercise of reasonable diligence. It could not, however, in any case have been introduced as evidence until the foundation had been laid by the introduction of the judgment awarded in the prior suit against the

New York Baking Powder Co. *et al.* Moreover, so far as appears, the conduct of the defense in that suit was entirely under the control of the Provident Chemical works, and not under the control of either of the Hygienic Companies. The agreement of May 17th, 1900, does not in any case go to the merits, but simply tends to throw additional light upon the relations existing between the Chemical Companies and the Provident Chemical Works.

Moreover, this Court has not decided that the sale of the barrel of acid phosphate to the Clotworthy Chemical Company amounted to an infringement of the Catlin patent (see Opinion of Mr. Justice Holmes).

IV.

The petition should be denied, and it is requested that the mandates of this Court issue to the Circuit Court of Appeals in the Second and Third Circuits in accordance with the decisions filed herein on November 29th, 1909.

New York, December 30th, 1909.

Respectfully submitted,

WILLARD PARKER BUTLER,
EDWIN T. RICE,
Of Counsel for Respondents.

RUMFORD CHEMICAL WORKS *v.* HYGIENIC CHEMICAL COMPANY OF NEW JERSEY.

CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE THIRD CIRCUIT.

HYGIENIC CHEMICAL COMPANY OF NEW YORK *v.* RUMFORD CHEMICAL WORKS.

CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

Nos. 9, 121. Argued November 1, 1909.—Decided November 29, 1909.

Although in subsequent cases a party may have proved his facts, the question when here must be decided on the evidence below in the particular case.

Although one not a party may have contributed to the expenses of a former suit by reason of business or indirect interest, if it is not shown he had any right to participate in the conduct of the case he is not bound as a privy.

Where the Circuit Court and Circuit Court of Appeals of the same circuit agree on certain facts this court will not reverse the finding in a case coming from that circuit notwithstanding the same fact may not have been found by the courts of another circuit.

154 Fed. Rep. 65, affirmed; 157 Fed. Rep. 436, reversed.

THE facts are stated in the opinion.

Mr. Philip Mauro, with whom *Mr. C. A. L. Massie* was on the brief, for Rumford Chemical Works:

A *prima facie* case against both Hygienic companies is made out by the admissions without the aid of other proof regardless of the Clotworthy deposition. *Hutter* v. *Stopper Co.*, 128 Fed. Rep. 283; *United Shirt & Collar Co.* v. *Beattie*, 149 Fed. Rep. 736, 742.

There was no denial or explanation by either infringing company: cases *supra* and *Signal Co.* v. *Electric Co.*, 97 Fed. Rep. 810; aff'd 107 Fed. Rep. 284; *Hemolin* v. *Dyewood Co.*,

131 Fed. Rep. 483; aff'd 138 Fed. Rep. 54; certiorari denied, 199 U. S. 608.

The Clotworthy deposition should have been received. A court may take judicial cognizance of its own records in a former litigation, especially one in which present parties were privies. *Butler* v. *Eaton*, 141 U. S. 240; *Aspen Mining Co.* v. *Billings*, 150 U. S. 31, 38; *Crœmer* v. *Washington*, 168 U. S. 124, 129; *Re Boardman*, 169 U. S. 39, 44; *Bresnahan* v. *Tripp Co.*, 72 Fed. Rep. 920; *Cushman Box Co.* v. *Goddard*, 97 Fed. Rep. 664; *Des Moines Nav. Co.* v. *Homestead Co.*, 123 U. S. 552; *United States* v. *Des Moines Nav. Co.*, 142 U. S. 510; *National Co.* v. *Dayton Co.*, 95 Fed. Rep. 991, 996. Both the Hygienic companies were "parties" to the test suit. 3 Robinson on Patents, § 1176; *Robbins* v. *Chicago*, 4 Wall. 657; *Penfield* v. *Potts*, 126 Fed. Rep. 475, 480; *Cromwell* v. *Sac County*, 94 U. S. 351.

Mr. Edwin T. Rice, with whom *Mr. Willard Parker Butler* was on the brief, for the Hygienic Chemical Companies:

Privity was not shown between either of the Hygienic companies and the defendant on the test suit. Privity must be affirmatively shown. *Johnson* v. *Powers*, 139 U. S. 156; *Litchfield* v. *Goodnow*, 123 U. S. 549; *Theller* v. *Hershey*, 89 Fed. Rep. 575; *Felting Co.* v. *Asbestos Co.*, 4 Fed. Rep. 816; *Telephone Co.* v. *Telephone Co.*, 27 Fed. Rep. 663; *Miller* v. *Tobacco Co.*, 7 Fed. Rep. 91; *Eagle Co.* v. *Bradley Co.*, 50 Fed. Rep. 193; *S. C.*, 57 Fed. Rep. 980; *Box Co.* v. *Paper Co.*, 95 Fed. Rep. 991; *Lane* v. *Wells*, 99 Fed. Rep. 286.

The Circuit Court of Appeals of the Second Court erred in taking judicial notice of matters outside the record. *Stanley* v. *McElrath*, 86 California, 449; *Downing* v. *Howlett*, 6 Colo. App. 291; *Adler* v. *Lang*, 26 Mo. App. 226; *Grace* v. *Ballou*, 4 S. D. 333; *Re Manderson*, 51 Fed. Rep. 501; *Streeter* v. *Streeter* 43 Illinois, 155; *Taylor* v. *Adams*, 115 Illinois, 570; *Loomis* v. *Griffin*, 78 Iowa, 482; *Granger* v. *Griffin*, 78 Iowa, 759; *Banks* v. *Burnam*, 61 Missouri, 76; *Spurlock* v. *Mo. Pac. Ry.*,

76 Missouri, 67; *Daniel* v. *Bellany*, 91 N. C. 78; *People* v. *De La Guerra*, 24 California, 73; *State* v. *Edwards*, 19 Missouri, 674; *Baker* v. *Mygatt*, 14 Iowa, 131; *Allison* v. *Insurance Co.*, 104 N. W. Rep. 753; *Re Osborne*, 115 Fed. Rep. 1; *Bank* v. *Taylor*, 86 Ill. App. 388; *Ralphs* v. *Hensler*, 97 California, 296; *McCormick* v. *Herndon*, 67 Wisconsin, 648; *Enix* v. *Miller*, 54 Iowa, 551; *Eyster* v. *Gaff*, 91 U. S. 521; *State* v. *Wilson*, 39 Mo. App. 114; *Water Co.* v. *Cowles*, 31 California, 215; 1 Wharton on Evidence, § 326.

The chemical company failed to make out a *prima facie* case. *Bates* v. *Coe*, 98 U. S. 31, 49; *Royer* v. *Chicago Mfg. Co.*, 20 Fed. Rep. 853.

The extract from the Clotworthy deposition was inadmissible as against the Hygienic companies. *Street Railway Co.* v. *Gumby*, 99 Fed. Rep. 192; Chase's Stephen's Evidence, 2d ed., Art. 32; Greenleaf on Evidence, § 163; *Insurance Co.* v. *Commissioners*, 117 Fed. Rep. 82.

MR. JUSTICE HOLMES delivered the opinion of the court.

These are two suits in equity brought by the Rumford Chemical Company for the infringement of a patent for baking powders; one, No. 9, brought in the Third Circuit, New Jersey, against the Hygienic Chemical Company, a corporation of that State; the other, No. 121, brought in the Second Circuit, New York, against a New York corporation of the same name. The two cases were tried on substantially the same record and evidence, with the result that in New Jersey the bill was dismissed by the Circuit Court of Appeals, 154 Fed. Rep. 65; 83 C. C. A. 177, but in New York the bill was sustained. 159 Fed. Rep. 436; 86 C. C. A. 416. Writs of certiorari were granted by this court.

The defendants rested on the plaintiff's evidence, and the question in both suits was whether a *prima facie* case had been made out. It did not appear that the defendants made or sold baking powders as such, but the New Jersey Company did make acid phosphates for baking powders and other pur-

poses, and the New York Company sold the great part of its products. The plaintiff contended that this acid phosphate had the characteristics described in its patent, and was made and sold for use in baking powders, and that the manufacture and sale were an infringement of its rights. A previous decision, *Rumford Chemical Works* v. *New York Baking Powder Co.*, 134 Fed. Rep. 385; 67 C. C. A. 367, establishing the patent, was relied upon as a test case by which the defendants were bound, but, except the final decree, entered after the beginning of the present suits, the record was not put in. It would seem, from a late case, that the plaintiff was correct in point of fact, *Provident Chemical Works* v. *Hygienic Chemical Co.*, 170 Fed. Rep. 523, but the question here must be discussed, of course, on the evidence before the court below. The question is material as bearing upon the admissibility of the evidence of one Clotworthy, since dead, given in the suit against the New York Baking Powder Company, upon which the plaintiff relied.

Clotworthy was the president and general manager of the Clotworthy Chemical Company and was a manufacturer of baking powder. He testified to the purchase from the Hygienic Company of New York of a barrel of granular acid phosphate, shown to be similar to that described in the plaintiff's patent. A bill from the New Jersey Company and a receipt from the New York Company also were produced and put in. The courts in both circuits rightly regarded this as the most important, if not the only evidence to make out the infringement alleged. Therefore it was necessary that the plaintiff should prove that the defendants were privy to the New York Baking Powder Company's case.

To prove privity Heller, the president of the defendant companies, was called and asked as to his testimony on the former occasion. He admitted that he then had testified that "we are manufacturers of granulated acid phosphate and are selling to the trade in the same way as" the former defendants; also that he had testified that "we have [undertaken to assist in bearing the burdens of this defence and have contributed to

the defence] financially and otherwise." By the natural interpretation of the word in the connection in which it was used 'we' embraced the New Jersey company, and fairly may be argued to have meant both. Heller swore that these answers were true, but with the qualification that he did not think that the New Jersey corporation contributed financially, and that he did not remember whether it did otherwise. All the courts agree that the privity of the New Jersey corporation was not made out. Probably all, and at least the Circuit Court of Appeals and the Circuit Court for the Third Circuit, 148 Fed. Rep. 862, agree that if Clotworthy's testimony is excluded infringement is not proved. We should not revise this finding of both courts on the facts, and therefore it follows that the New Jersey decree must be affirmed. The evidence on both sides is discussed in 148 Fed. Rep. 862.

It appears that the New York company contributed to the expenses of the former case. But that fact alone is not enough to warrant a different result. The agreement disclosed in 170 Fed. Rep. 523, was not before the court. We may reject as extravagant the suggestion that the contribution may have been made from charitable motives, and assume that it was induced by reasons of business and indirect interest, but it was not shown that as between the present and former defendants either Hygienic company had the right to intermeddle in any way in the conduct of the case. The Hygienic Companies would have been glad to see the Rumford patent declared void and were willing to pay something to that end. That was all and that did not make them privies, and therefore the Clotworthy deposition was not admissible against them. *Litchfield* v. *Goodnow*, 123 U. S. 549, 550. Whether if it had been admitted, infringement could have been inferred from the sale of a barrel of granular acid phosphate to a manufacturer of baking powder need not be considered. There was other evidence in the case.

Decree in No. 9 affirmed.
Decree in No. 121 reversed.